
UNITED STATES
PATENT AND TRADEMARK OFFICE
uspto

Federal Circuit Decisions: *Maatita*, *Curver*, and *SurgiSil*

Technology Center 2900
FY 2023-Q1

Note

- The examples in this training have been updated since the original delivery, but the teaching points and analysis remain the same.

Learning outcomes

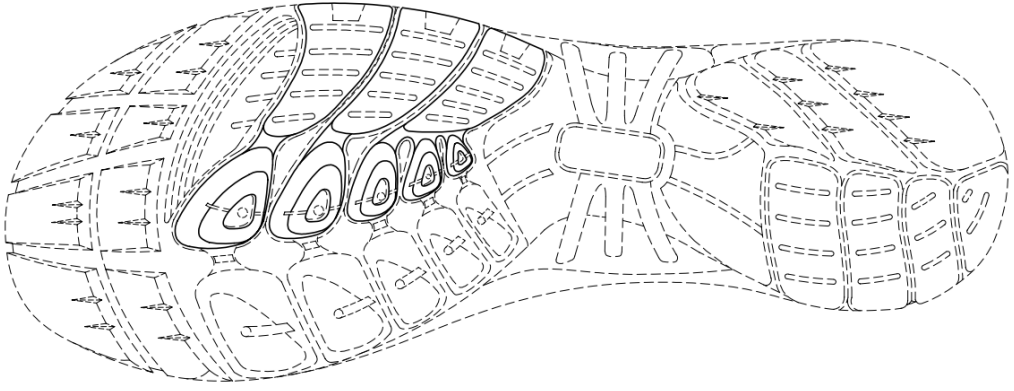
- Determine whether a design meets the enablement and definiteness requirements for a design claim under 35 U.S.C. 112 when only a single view of the design is provided as illustrated by ***In re Maatita***.

- Determine considerations relating to the title of the design application on the claim scope as illustrated by ***Curver Luxembourg v. Home Expressions***.

- Determine how a design claim is limited to the article of manufacture recited in the claim language and depicted in the figure(s) as illustrated by ***In re SurgiSil***.

In re Maatita – Background

Applicant sought protection for the design of an athletic shoe bottom, disclosing the claimed design from a single, two-dimensional plan view, as shown:



In re Maatita, 900 F.3d 1369 (Fed. Cir. 2018).

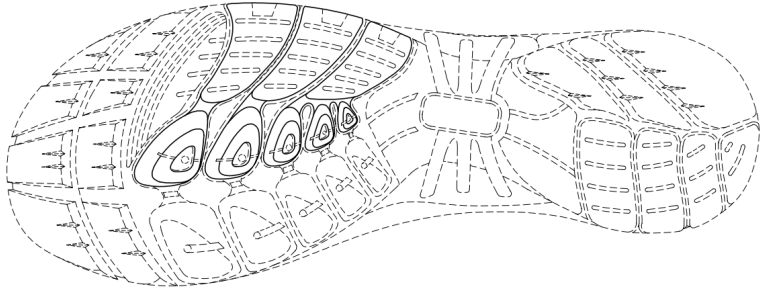
In re Maatita – Background

The examiner rejected the design claim as failing to satisfy the enablement and definiteness requirements of 35 U.S.C. 112.

The examiner's position was that the application's use of a single, two-dimensional plan view to disclose a three dimensional shoe bottom design left the design open to multiple interpretations regarding the depth and contour of the claimed elements, therefore rendering the claim nonenabled and indefinite.

The applicant appealed the Examiner's rejection.

The Patent Trial and Appeal Board (PTAB) affirmed the examiner's position, and the applicant appealed to the Court of Appeals for the Federal Circuit (CAFC or Federal Circuit).



In re Maatita, 900 F.3d 1369 (Fed. Cir. 2018).

In re Maatita – Decision

The Federal Circuit Court **reversed** the PTAB decision, finding that, Maatita's claim for a shoe bottom satisfied the enablement and definiteness requirements of 35 U.S.C. 112, explaining:

- "Ultimately, a [design] patent is indefinite for § 112 purposes whenever its claim, read in light of the visual disclosure (whether it be a single drawing or multiple drawings), 'fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention.'" *Id*. at 1376 (citation omitted).

- "The purpose of § 112's definiteness requirement, then, is to ensure that the disclosure is clear enough to give potential competitors (who are skilled in the art) notice of what design is claimed and therefore what would infringe." *Id*. at 1376.

- "Given that the purpose of indefiniteness is to give notice of what would infringe, we believe that in the design patent context, one skilled in the art would assess indefiniteness from the perspective of an ordinary observer. Thus, 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." *Id*. at 1377.

In re Maatita – Decision

The Federal Circuit also:

- Distinguished designs of a rug or a placemat from the design for an entire shoe or teapot, which "are inherently three-dimensional and could not be adequately disclosed with a single, plan- or planar-view drawing." *Id*. at 1378.
- Acknowledged that "many shoe bottom designers choose to claim their designs in a three dimensional fashion. But the fact that shoe bottoms can have three-dimensional aspects does not change the fact that their ornamental design is capable of being disclosed and judged from a two-dimensional, plan- or planar view perspective—and that Maatita's two-dimensional drawing clearly demonstrates the perspective from which the shoe bottom should be viewed." *Id*. at 1378.
- Explained that "Maatita's decision not to disclose all possible depth choices would not preclude an ordinary observer from understanding the claimed design, since the design is capable of being understood from the two-dimensional, plan- or planar-view perspective shown in the drawing." *Id*. at 1378.

In re Maatita – Takeaways

- *Maatita* reminds us that "[t]he drawings and photographs should contain a sufficient number of views to disclose the complete appearance of the design claimed." (MPEP 1503.02).
  - Some designs may be capable of being understood from a single, two dimensional plan view perspective. For example, a single 2D plan view may sufficiently disclose a design that does not claim three dimensional aspects.
  - There is no *per se* rule that a design claim will, or will not, always meet the enablement and definiteness requirements of 35 U.S.C. 112 when the claimed design is visually disclosed using a single, two dimensional plan view.

In re Maatita – Takeaways

- The following information in the patent application may indicate that three dimensional aspects are being claimed and therefore, a single plan view may not be sufficient to disclose the complete appearance of the claimed design:
  - The article identified in the claim language and shown in solid lines in the figures is inherently three-dimensional;
  - The application includes multiple figures showing the claimed design from various points of view; and/or
  - The application includes a figure(s) with surface shading to show the contour of 3D aspects.

**Note that these are exemplary considerations; they may not all apply in every situation, and/or there may be additional considerations beyond the ones listed here that indicate whether three dimensional aspects are being claimed.*

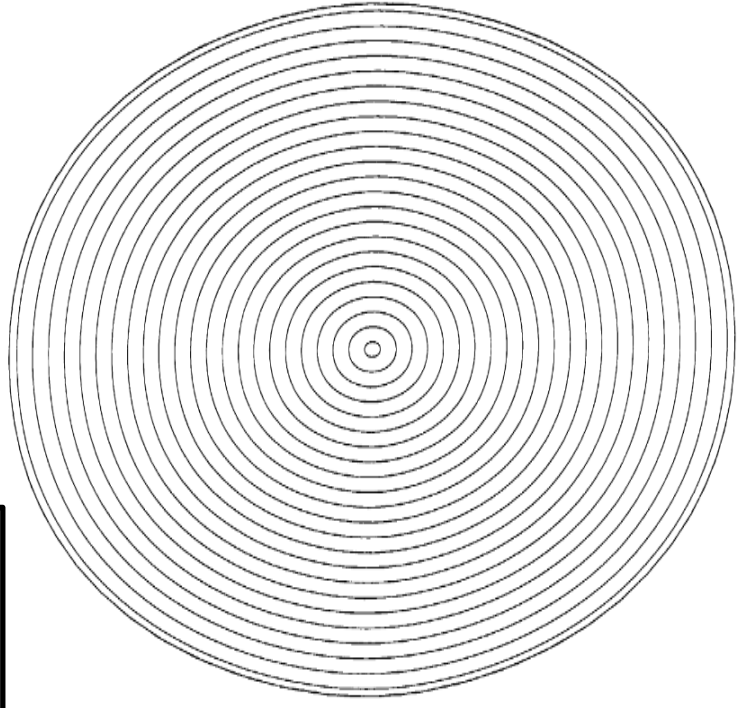
In re Maatita – Example 1

Title of the application: Bath mat

Claim: The ornamental design for a bath mat as shown and described.

Description: The sole figure is a plan view of a bath mat showing my new design.

Figure (all features are shown in solid lines):

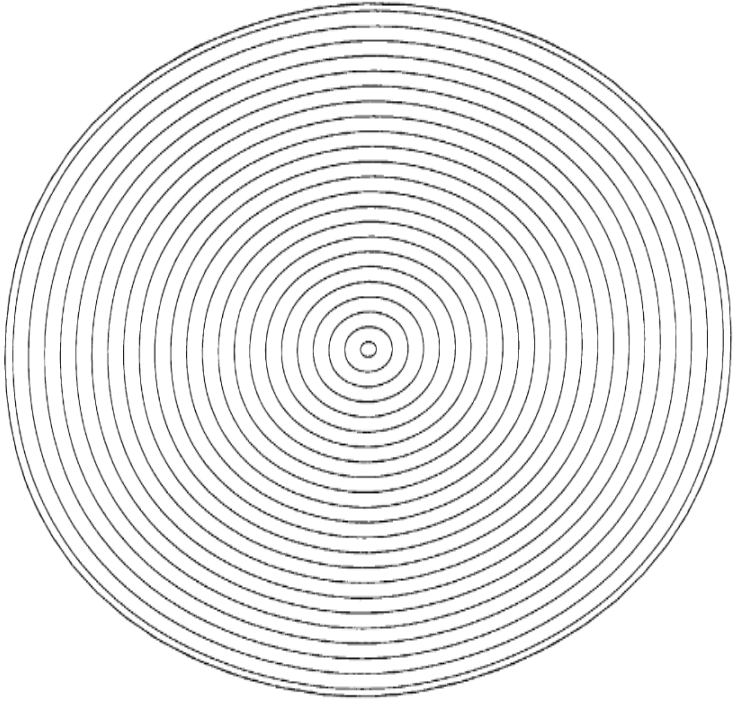


Does the claimed design for a bath mat, visually disclosed using a single plan view, meet the enablement and definiteness requirements of 35 U.S.C. 112?

In re Maatita – Example 1

Things to consider:

- The design does not claim three dimensional aspects of the bath mat;
- The application does not include multiple figures showing the claimed design from various points of view; and
- The figure does not include surface shading.



The single plan view sufficiently discloses the claimed design for a bath mat under the enablement and definiteness requirements 35 U.S.C. 112.

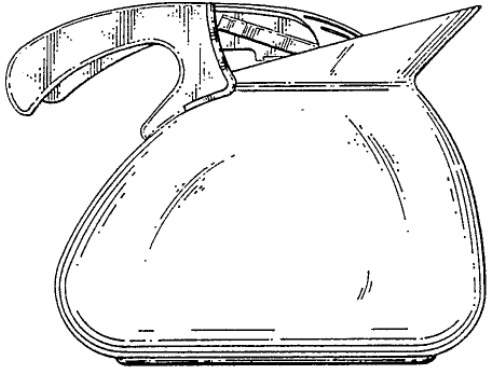
In re Maatita - Example 2

Title of the application: Tea Kettle

Claim: The ornamental design for a tea kettle as shown and described.

Description: The sole figure is an elevational view of a tea kettle showing my new design.

Figure (all features are shown in solid lines):

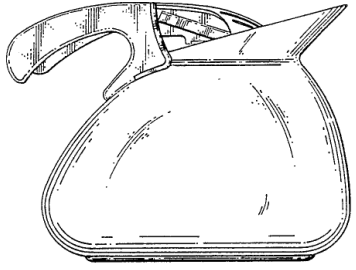


Does the claimed design for a tea kettle, visually disclosed using a single elevational view, meet the enablement and definiteness requirements of 35 U.S.C. 112?

In re Maatita - Example 2

The contents of the application indicate that three-dimensional features are being claimed. For example:

- The article recited in the claim, i.e., “tea kettle”, is inherently three-dimensional;
- The application includes a single figure disclosing a design claiming three dimensional aspects from an elevational view perspective (for example, the curved surface of the claimed body of the kettle); and
- The figure includes surface shading showing the contour of three dimensional aspects of the kettle.



It would be reasonable for the examiner to make a rejection for lack of enablement and indefiniteness under 35 U.S.C. 112, on the basis that the claimed design for a tea kettle is not capable of being understood from the single elevational view perspective.

Curver – Background

Curver Luxembourg, SARL v. Home Expressions Inc. 928 F.3d 1334 (Fed. Cir. 2019).

Curver patent

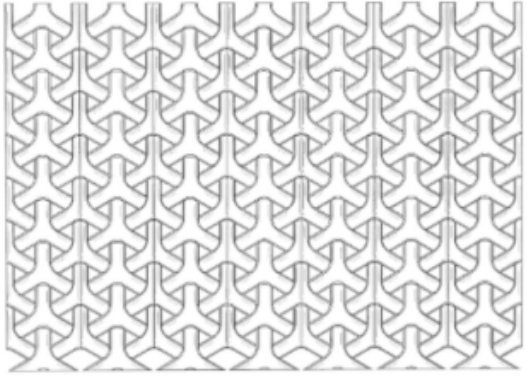


FIG. 1

Title: Pattern for a chair

Claim: The ornamental design for a pattern for a chair, as shown and described.

Accused Home Expressions basket

Curver – Background

Curver filed a complaint against Home Expressions in district court accusing the Home Expressions' basket of infringing the Curver patent.

The district court dismissed the complaint, and Curver appealed to the Federal Circuit.

The question on appeal was whether the district court correctly construed the scope of the design patent as limited to the illustrated pattern applied to a chair, or whether the design patent covers any article, chair or not, with the surface ornamentation applied to it.

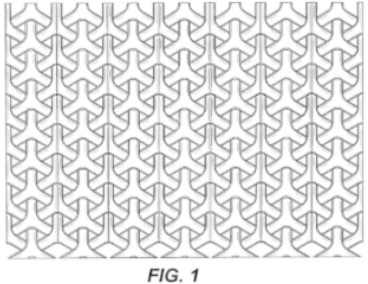


FIG. 1

Curver patent

Accused Home Expressions basket

Curver – Decision

The Federal Circuit found that the accused Home Expressions basket **did not infringe** on Curver's patent:

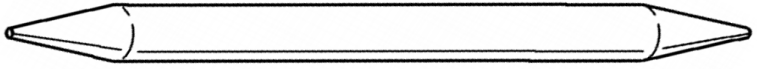
- "…[L]ong standing precedent, unchallenged regulation, and agency practice all consistently support the view that design patents are granted only for a design applied to an article of manufacture, and not a design per se…" *Id* at 1340.
- Claim language can limit the scope of a design patent in litigation where the claim language is the only instance in the patent where the article of manufacture is identified – the article of manufacture appears nowhere in the figures of the patent. For example, Curver's patent was found to be limited by the language reciting a "Pattern for a chair".
- No ordinary observer could be deceived into purchasing defendant's baskets believing they were the same as the patterned chairs claimed in assignee's patent.

Curver – Takeaways

- Curver reminds us that the title of the design identifies the article in which the design is embodied by the name generally known and used by the public and may contribute to defining the scope of the claim (MPEP 1503.01(II)).
- Curver also reminds us that a design is inseparable from the article to which it is applied, and cannot exist alone merely as a scheme of surface ornamentation (MPEP 1502).
- During examination, where the article of manufacture does not appear anywhere in the figures, examiners should consider whether to reject the claim under 35 U.S.C. 112 for being nonenabled and indefinite, and/or under 35 U.S.C. 171 for not establishing an article of manufacture.

In re SurgiSil – Background

SurgiSil applied for a design patent:

- Title: Lip Implant
- Claim: The ornamental design for a lip implant as shown and described.
- Figure: 

The examiner rejected the claim under 35 U.S.C. 102(a)(1) as being anticipated by the Dick Blick art tool:

Prior art stump tool

In re SurgiSil, L.L.P., 14 F.4th 1380 (Fed. Cir. 2020)

In re SurgiSil – Background

Applicant appealed the rejection to the PTAB.

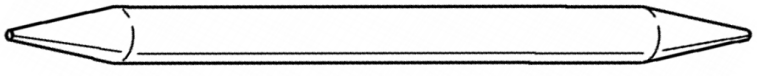
Applicant argued that the art tool reference could not anticipate because it disclosed a "very different" article of manufacture than a lip implant. The argument was rejected by the Board.

The PTAB affirmed the examiner's rejection.

The Board reasoned that "it is appropriate to ignore the identification of the article of manufacture in the claim language."

The Board explained that "whether a reference is analogous art is irrelevant to whether that reference anticipates" (quoting *In re Schreiber*, 128 F. 3d 1473, 1479 (Fed. Cir. 1997)).

Applicant appealed to the Federal Circuit.

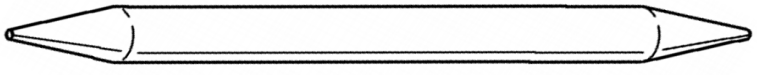


SurgiSil application: lip implant

In re SurgiSil – Decision

The Federal Circuit Court **reversed the PTAB's finding** as resting on an erroneous interpretation of claim scope**.**

- "A design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract."
- "The claim identifies a lip implant. The claim language recites 'a lip implant,'…and the Board found that the application's figure depicts a lip implant… As such, the claim is limited to lip implants and does not cover other articles of manufacture."



SurgiSil application: lip implant

Blick reference: art stump tool

In re SurgiSil – Takeaways

- *SurgiSil* reminds us that design is inseparable from the article to which it is applied (MPEP 1502).
- A design claim covers the article of manufacture recited in the claim language and depicted in the figures; it does not cover other articles of manufacture.
- Examiners should not disregard the claim language when applying prior art in an anticipation rejection under 35 U.S.C. 102.
- Examiners should clearly identify and compare the claimed article of manufacture and the prior art article of manufacture when making any rejection under 35 U.S.C. 102 or 103.

In re SurgiSil – Example 1

Title of the application: Cookie

Claim: The ornamental design for a cookie as shown and described.

Figures*:

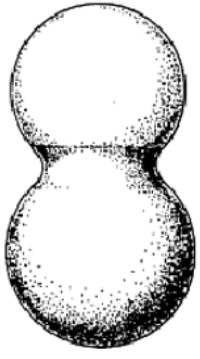


Fig. 1
(top view)

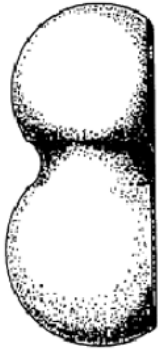
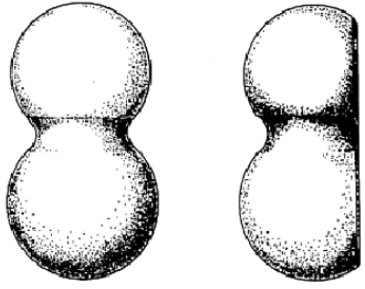


Fig. 2
(side view)

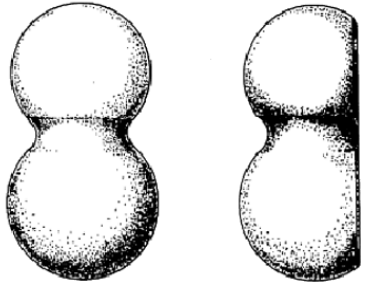
*Assume these two views are sufficient to disclose the claimed design under 35 U.S.C. 112.

In re SurgiSil – Example 1

The examiner finds a shoe deodorizer that looks similar to the claimed design:



Applicant's figures



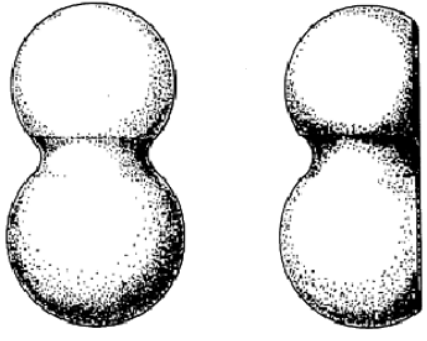
Prior art figures

Would it be appropriate for the examiner to make an anticipation rejection under 35 U.S.C. 102 against the claimed cookie design using the prior art deodorizer?

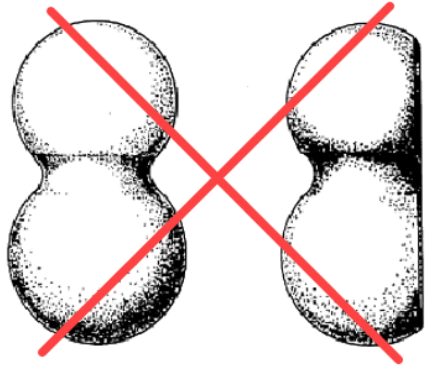
In re SurgiSil – Example 1

The article of manufacture recited in the claim language and depicted in the figures is a cookie. The claim does not cover other articles of manufacture.

The drawings, in isolation, may look substantially the same. However, the prior art deodorizer is not the same article of manufacture recited in the claim (that is, a cookie). Therefore, it would **not** be appropriate for the examiner to apply the deodorizer as an anticipatory reference against the claimed cookie design under 35 U.S.C. 102.



Applicant's design for a cookie



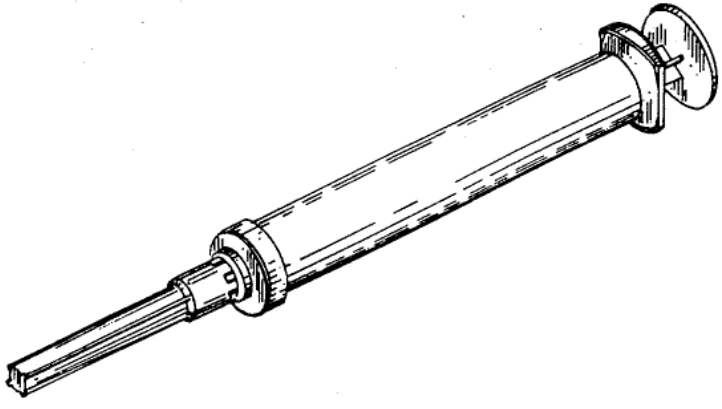
Prior art shoe deodorizer

In re SurgiSil – Example 2

Title of the application: Syringe

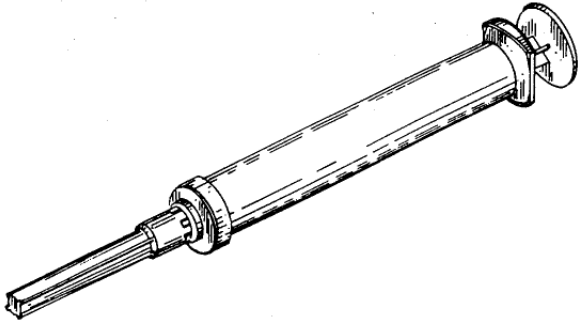
Claim: The ornamental design for a syringe as shown and described.

Figure:

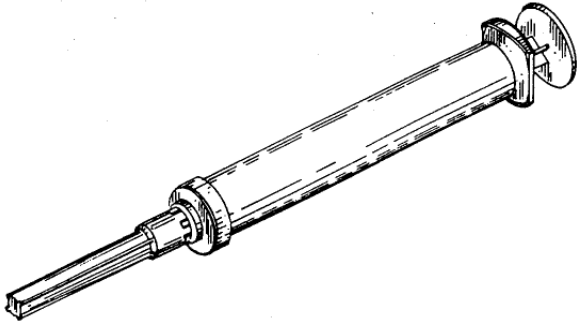


In re SurgiSil – Example 2

The examiner finds prior art that looks substantially the same as the claimed design. The reference is called “Medical Device”.



Applicant’s design for a syringe

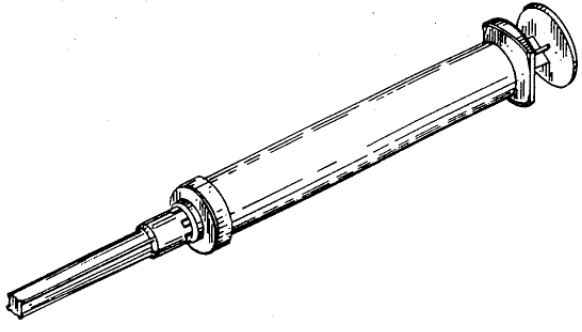


Prior art medical device

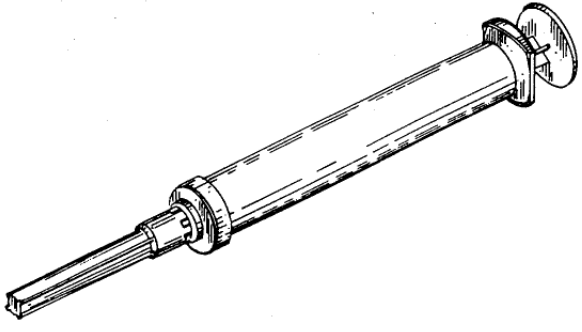
Would it be appropriate for the examiner to make an anticipation rejection under 35 U.S.C. 102 against the claimed syringe design using the prior art medical device?

In re SurgiSil – Example 2

The article of manufacture recited in the claim language and depicted in the figure is a syringe. The phrase "medical device" can be reasonably considered a generic term encompassing a syringe. Given these facts, it would be reasonable for the examiner to make a rejection under 35 U.S.C. 102 using this reference, since the application and prior art appear substantially the same and are reasonably considered to be the same article.



Applicant's design for a syringe



Prior art medical device

In re SurgiSil – Example 3

Title of the application: Mop Handle

Claim: The ornamental design for a mop handle as shown and described.

Figure:

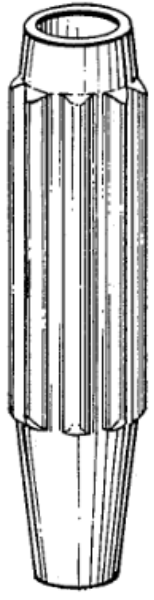
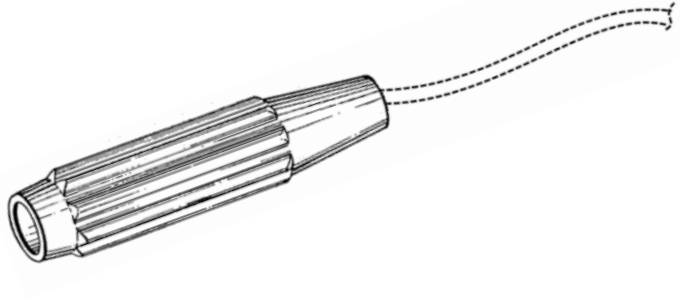


Fig. 1

In re SurgiSil – Example 3

The examiner finds a handle for a jump rope, the appearance of which is substantially the same as the applicant's design:

Applicant's design for a mop handle



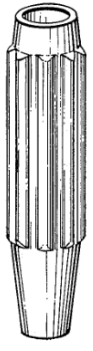
Prior art handle, disclosed for a jump rope

Would it be appropriate for the examiner to make an anticipation rejection under 35 U.S.C. 102 against the claimed handle using the prior art handle from a jump rope?

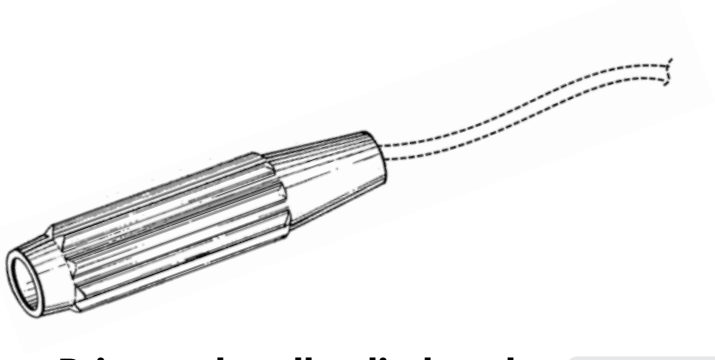
In re SurgiSil – Example 3

The article of manufacture is a handle, specifically a mop handle as identified in the claim. The prior art is also a handle, specifically a jump rope handle. Given the facts in this example, it would be reasonable for the examiner to interpret the article of manufacture recited in the claim as a handle intended to be used as part of a mop. Therefore, it would be reasonable for the examiner to consider the prior art handle to anticipate the claimed design as both design are drawn to handles. The applicant's intended use of the handle - being intended for a mop - does not limit the claimed article of manufacture to anything more specific than a handle. Note that patentability of a design cannot be predicated on utility (*In re Zonenstein*).

Given these facts, **it would be reasonable for the examiner to make a rejection under 35 U.S.C. 102 using this reference**, since the applicant's and prior art's articles of manufacture appear substantially the same and can be reasonably considered as the same article (that is, a handle).

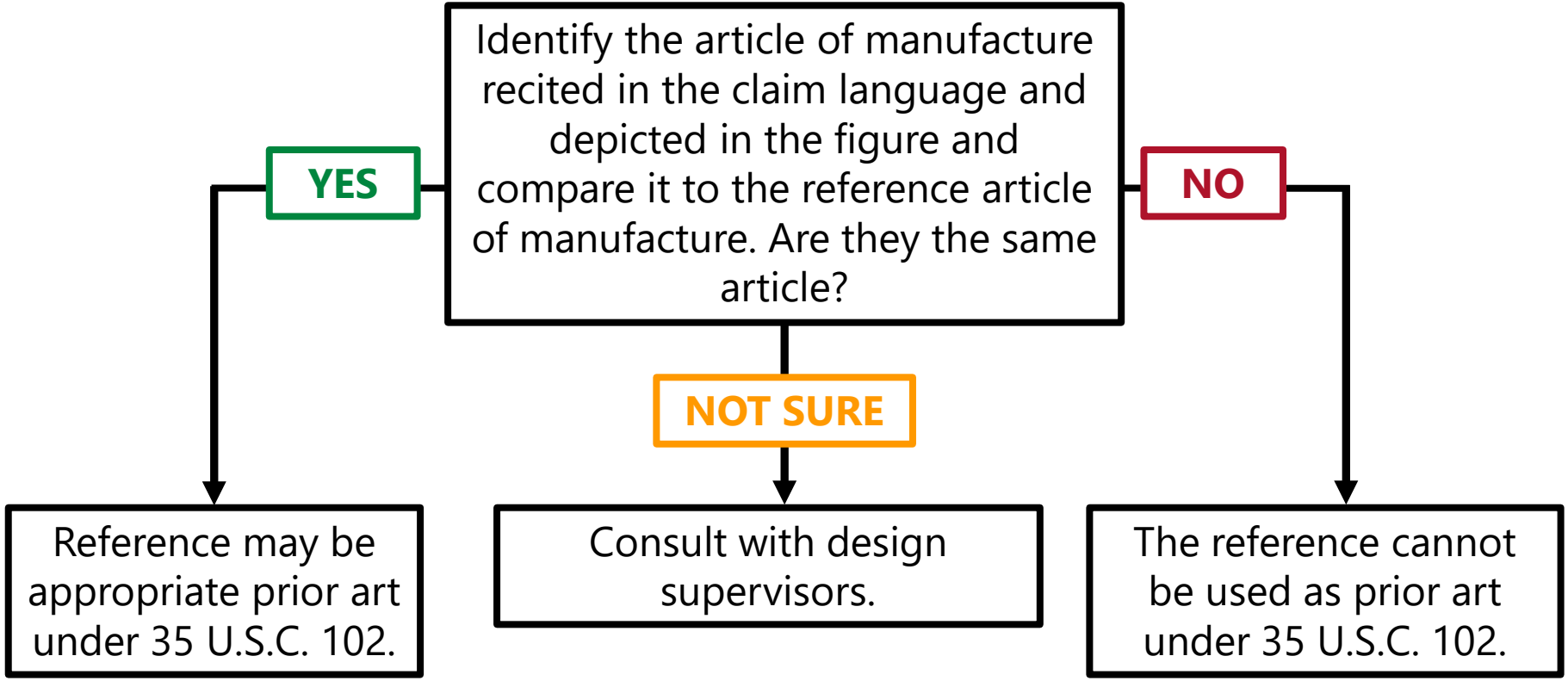


Applicant's design for a mop handle



Prior art handle, disclosed for a jump rope

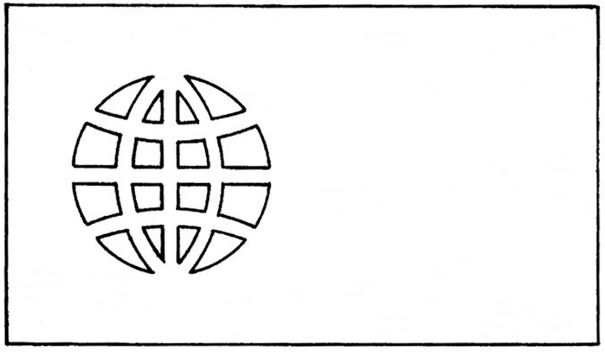
In re SurgiSil – Decision tree for examiners



Knowledge Check 1

You are examining the following design application:

Title of the application: Flag
Claim: The ornamental design for a flag as shown and described.
Description: The sole figure is a plan view of a flag showing my new design.
Figure (all features shown in solid lines):



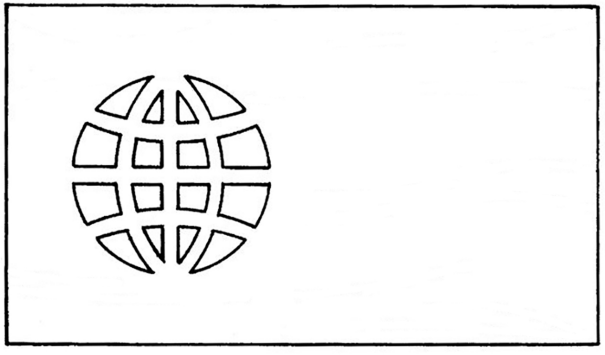
Which Federal Circuit decision illustrates how to determine whether this single plan view sufficiently meets the enablement and definiteness requirements of 35 U.S.C. 112?

A. *In re SurgiSil*
B. *In re Maatita*
C. *Curver Luxembourg v. Home Expressions Inc.*

Knowledge Check 1: Answer

You are examining the following design application:

Title of the application: Flag
Claim: The ornamental design for a flag as shown and described.
Description: The sole figure is a plan view of a flag showing my new design.
Figure (all features shown in solid lines):



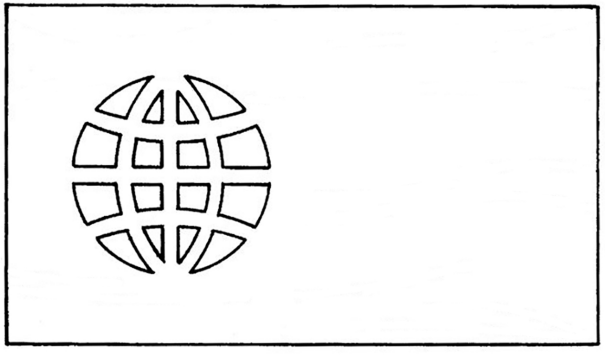
Which Federal Circuit decision illustrates how to determine whether this single plan view sufficiently meets the enablement and definiteness requirements of 35 U.S.C. 112?

A. *In re SurgiSil*
B. *In re Maatita*
C. *Curver Luxembourg v. Home Expressions Inc.*

Knowledge Check 2

You are examining the following design application:

Title of the application: Flag
Claim: The ornamental design for a flag as shown and described.
Description: The sole figure is a plan view of a flag showing my new design.
Figure (all features shown in solid lines):



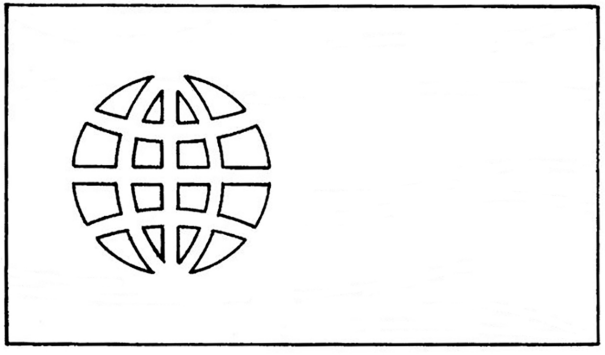
True or False: Since only a single plan view of the claimed design is provided, this claim is *per se* indefinite and nonenabled (that is, it can reasonably be rejected under 35 U.S.C. 112 on the basis of the single plan view alone, without considering any other factors).

A. True
B. False

Knowledge Check 2: Answer

You are examining the following design application:

Title of the application: Flag
Claim: The ornamental design for a flag as shown and described.
Description: The sole figure is a plan view of a flag showing my new design.
Figure (all features shown in solid lines):



True or False: Since only a single plan view of the claimed design is provided, this claim is *per se* indefinite and nonenabled (that is, it can reasonably be rejected under 35 U.S.C. 112 on the basis of the single plan view alone, without considering any other factors).

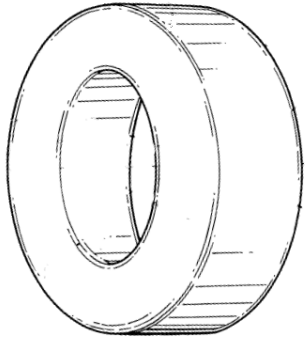
A. *True*

B. *False. There is no per se rule equating a single plan view with indefiniteness and lack of enablement. The examiner also needs to consider factors such as whether the nature of the article is inherently three dimensional.*

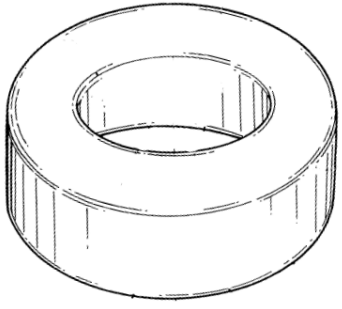
Knowledge Check 3

You are examining the following design application:

Title of the application: Tire
Claim: The ornamental design for a tire as shown and described.
Applicant's figure (all features shown in solid lines) and prior art:



Applicant's design for a tire



Prior art bundt cake

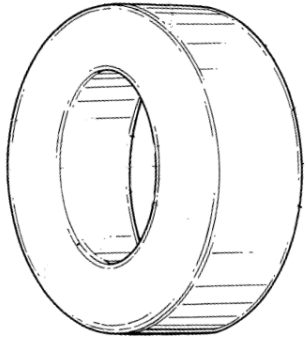
Which recent Federal Circuit decision illustrates how to determine whether the prior art bundt cake can be relied upon to make a proper anticipation rejection under 35 U.S.C. 102?

A. *In re SurgiSil*
B. *In re Maatita*
C. *Curver Luxembourg v. Home Expressions Inc.*

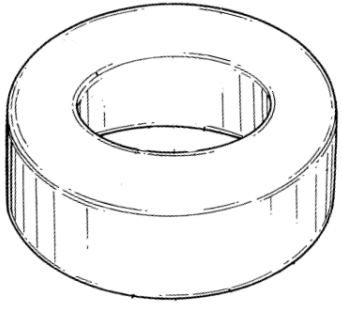
Knowledge Check 3: Answer

You are examining the following design application:

Title of the application: Tire
Claim: The ornamental design for a tire as shown and described.
Applicant's figure (all features shown in solid lines) and prior art:



Applicant's design for a tire



Prior art bundt cake

Which recent Federal Circuit decision illustrates how to determine whether the prior art bundt cake can be relied upon to make a proper anticipation rejection under 35 U.S.C. 102?

A. In re SurgiSil

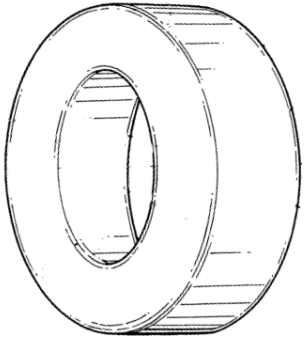
B. In re Maatita

C. Curver Luxembourg v. Home Expressions Inc.

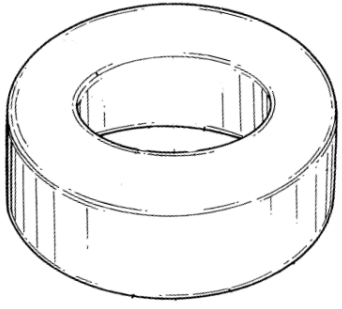
Knowledge Check 4

You are examining the following design application:

Title of the application: Tire
Claim: The ornamental design for a tire as shown and described.
Applicant's figure (all features shown in solid lines) and prior art published 2 years before the application filing date:



Applicant's design for a tire



Prior art bundt cake

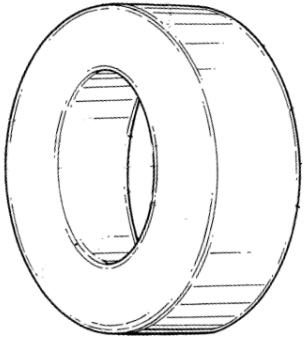
Given these facts, would it be reasonable for you to reject the applicant's design for a tire as being anticipated under 35 U.S.C. 102 by the prior art bundt cake?

A. Yes
B. No

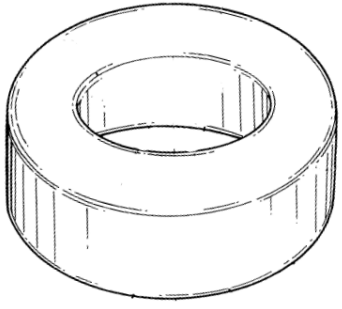
Knowledge Check 4: Answer

You are examining the following design application:

Title of the application: Tire
Claim: The ornamental design for a tire as shown and described.
Applicant's figure (all features shown in solid lines) and prior art published 2 years before the application filing date:



Applicant's design for a tire



Prior art bundt cake

Given these facts, would it be reasonable for you to reject the applicant's design for a tire as being anticipated under 35 U.S.C. 102 by the prior art bundt cake?

A. Yes

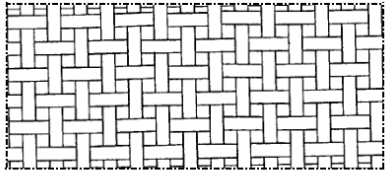
B. No. The prior art bundt cake is not the same article of manufacture as the applicant's tire. This would not be a proper anticipatory reference under 35 U.S.C. 102.

Knowledge Check 5

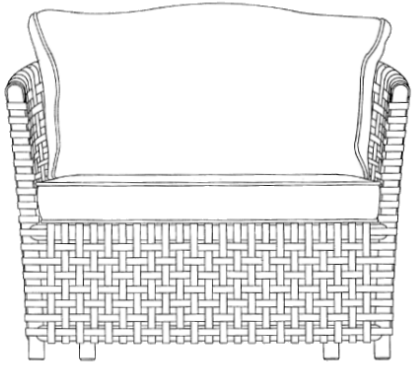
You are examining the following design application:

Title: Basket with rattan pattern

The applicant's drawing does not specifically show the pattern applied to a basket. The examiner finds a reference that appears to show a similar pattern applied to a chair.



Application: Basket with rattan pattern



Prior art chair

Which recent Federal Circuit decision(s) illustrate a related scenario for comparing the claim to the prior art?

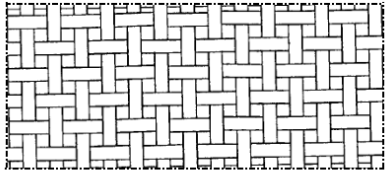
A. *In re SurgiSil*
B. *In re Maatita*
C. *Curver Luxembourg v. Home Expressions Inc.*

Knowledge Check 5: Answer

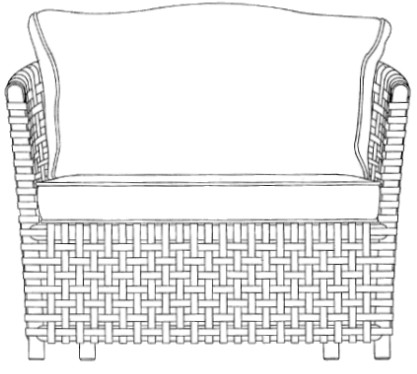
You are examining the following design application:

Title: Basket with rattan pattern

The applicant's drawing does not specifically show the pattern applied to a basket. The examiner finds a reference that appears to show a similar pattern applied to a chair.



Application: Basket with rattan pattern



Prior art chair

Which recent Federal Circuit decision(s) illustrate a related scenario for comparing the claim to the prior art?

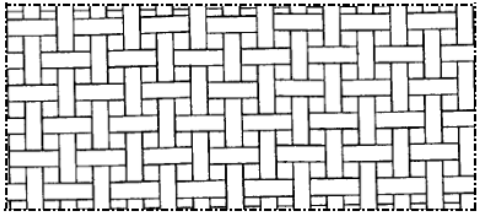
A. *In re SurgiSil*
B. *In re Maatita*
C. ***Curver Luxembourg v. Home Expressions Inc.***

Knowledge Check 6

You are examining the following design application:

Title: Basket with rattan pattern

The applicant's drawing does not specifically show the pattern applied to a basket. The examiner finds a reference that appears to show a similar pattern applied to a chair.



Application: Basket with rattan pattern

Would it be reasonable to make a rejection under 35 U.S.C. 171 in this scenario, given that an article of manufacture has not been illustrated in the figures of the application?

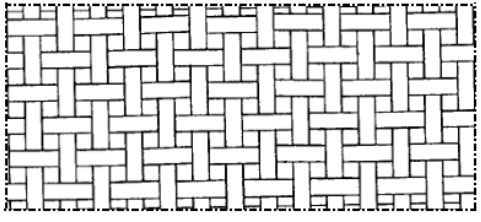
A. Yes
B. No

Knowledge Check 6: Answer

You are examining the following design application:

Title: Basket with rattan pattern

The applicant's drawing does not specifically show the pattern applied to a basket. The examiner finds a reference that appears to show a similar pattern applied to a chair.



Application: Basket with rattan pattern

Would it be reasonable to make a rejection under 35 U.S.C. 171 in this scenario, given that an article of manufacture has not been illustrated in the figures of the application?

A. Yes

B. No


UNITED STATES PATENT AND TRADEMARK OFFICE
DEPARTMENT OF COMMERCE