

Keywords: design patent, anticipation, prior art, validity, article of manufacture

General: A design claim is limited to the article of manufacture identified in the claim.

In re SurgiSil, LLP

United States Court of Appeals for the Federal Circuit

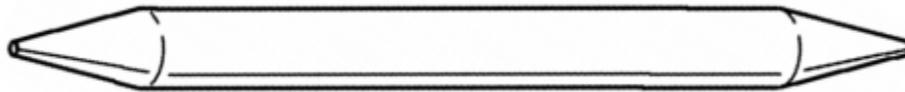
No. 2020-1940

Decided: October 4, 2021

I. Facts

SurgiSil appeals a decision from the Patent Trial and Appeal Board (PTAB) affirming an Examiner’s rejection of SurgiSil’s design patent (App. No. 29/491,550, hereinafter “the ‘550 application”). The ‘550 application includes only one claim and one figure directed at a lip implant.

The ‘550 application claims an “ornamental design for a lip implant.” The figure is reproduced below.



During prosecution, the Examiner rejected the sole claim of the ‘550 application as anticipated by a Dick Blick catalog (“Blick”). Blick discloses an art tool called a stump, which is made of tightly spiral-wound, soft gray paper used for smoothing and blending large areas of pastel or charcoal. A figure of the stump is reproduced below.



SurgiSil’s argued that Blick could not anticipate because it disclosed a ‘very different’ article of manufacture than a lip implant. However, the Board affirmed the Examiner’s finding. The Board stated that the differences in shape between the ‘550 application and Blick are minor. The Board reasoned that “it is appropriate to ignore the identification of the article of manufacture in the claim language.” Further, 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, 1478 (Fed. Circ. 1997)). SurgiSil appeals this decision.

II. Issue

Did the Board err in holding that the claimed design is not limited to lip implants?

III. Discussion

Yes. The Federal Circuit reversed the Board’s decision on the grounds that the Board erred in holding that the claimed design is not limited to the particular article of manufacture identified in the claim. A design claim is limited to the article of manufacture *identified* in the claims; it does not broadly cover a design in the abstract. The Patent Act permits the grant of a design patent only to “[w]hoever invents anything new, original and ornamental design *for an article of manufacture.*” 35 U.S.C. 171(a) (Emphasis added.) In *Gorham Co v. White*, the Supreme Court explained that “[t]he acts of Congress which authorize the grant of patents for designs” contemplate “not an abstract impression, or picture, but an aspect given to *those objects mentioned in the acts.*” (Emphasis added.) Further, in *Curver Luxembourg, SARL v. Home Expressions Inc.*, the Court held that the issue was *limited to the particular article of manufacture identified in the claim*, such as a chair. (Emphasis added). Consistent with this, the Patent Office’s examination guidelines state that a “[d]esign is inseparable from the article to which it is applied and cannot exist alone.” M.P.E.P. § 1502.

With the foregoing in mind, the ‘550 application claims “an ornamental design for a lip implant.” As such, the court stated that “the claim is limited to lip implants and does not cover other articles of manufacture.” The court further noted that, “[t]here is no dispute that Blick discloses an art tool rather than a lip implant.” Accordingly, the court held that “the Board’s anticipation finding rests on erroneous interpretation of the ‘550 application’s claim scope.”

IV. Conclusion

The Board erred in holding that the claimed design is not limited to lip implants, and the Court reverses. Indeed, the claim scope of a design patent is limited to the article of manufacture.