

Design Patent Confusion In Fed. Circ. Maatita Ruling

By **Robert Anders and Christopher Rourk** (September 13, 2018)

Lawyers and designers use very different means of communicating their ideas. Lawyers use a verbal language. Designers use the “language of lines,” a nonverbal language that combines the “alphabet of lines ... to give universal meaning to the lines of a drawing”[1] with the grammatical rules established in the standards for drawings issued by the U.S. Patent and Trademark Office. Interpreting and construing the lines in a design patent to determine whether they enable one of ordinary skill to make and use the claimed ornamental design must necessarily be performed by a designer, fluent with the language of lines, rather than a lawyer. Thus a designer joins with lawyer to write this article.



Robert Anders

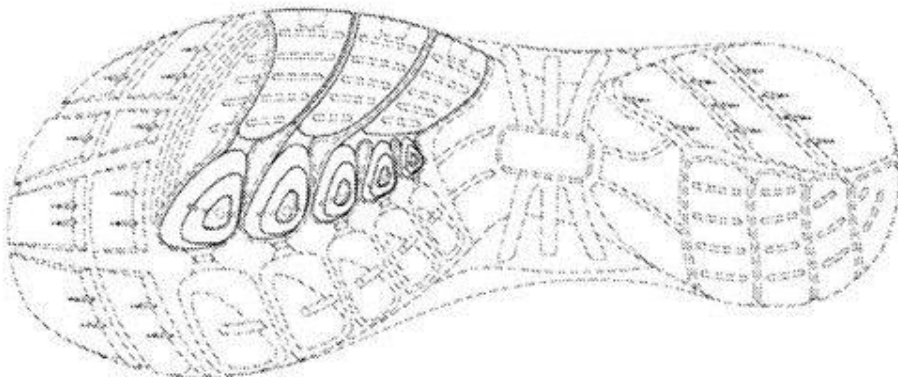
A design patent is unlike a utility patent in many ways, most notably in that the scope of the claims of a design patent is defined by the entirety of the ornamental design disclosed by the drawings of the design patent, and is limited to an article of manufacture. However, the disclosure of a design patent is also the claim of the design patent. As such, the question of enablement under 35 U.S.C. 112(a), which requires the specification to contain “a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains ... to make and use the same,” necessarily overlaps to some extent with question of definiteness under 35 U.S.C. 112(b), which requires that the “specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.”



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The decision in *In re Maatita*[2] effectively eliminates the requirement that the drawings must enable a person of skill in the art to make and use the invention. Rather, the decision conflates these two standards into a single standard, namely, whether an ordinary observer would understand the scope of the claim. Because an ordinary observer is not a person of ordinary skill in the art, and would not know how to make and use a claimed ornamental design, *Maatita* fails to properly apply these statutory standards, leading to an improper result.

“On October 24, 2011, appellant Ron Maatita (“Maatita”) filed design patent application, No. 29/404,677 covering the design of an athletic shoe bottom.”[3] Maatita submitted two drawings in his application. Since the claimed portions of the shoe outsole were identical in both figures and the design differed in the unclaimed areas, the examiner correctly rejected the second figure. Depicted below is Figure 1 of Maatita, the ornamental design for a plan view of the shoe bottom that was examined and rejected.



The two-dimensional solid lines depict a "claimed" ornamental design and represent either edges of elements or surface ornamentation, and are indefinite for a number of reasons. For example, at what elevation are these "edges" in relation to the other design elements depicted? Their location is indeterminate, because there is no surface shading that would give context to their relationship to each other. There is also no surface shading that would indicate any contours or that a surface is in fact a three dimensional surface. From this single drawing, it would be impossible to recognize any three-dimensional protrusions (also called "pistons" or "pads" when referring to athletic shoe designs) above the planar face. Similarly, if there are any narrow recesses or slits in the outsole surface (also referred to as "sipes" when referring to athletic shoe designs) they are not depicted as such.

Accordingly, the examiner correctly rejected the design application, asserting 35 U.S.C. § 112 for both enablement and indefiniteness. In response to the office action, Maatita argued that one of ordinary skill in the art would be capable "of selecting an appropriate depth or contour that would result in the illustrated combination of design features." The flaw in this reasoning is that there is no teaching or disclosure of any dimensionality in the submitted drawing and therefore no "appropriate depth." Also, there is no "illustrated combination of design features." It is merely conjecture that it illustrates anything other than a two-dimensional pattern on a two-dimensional surface. The court also noted that "in Maatita's view, '[o]mission of certain design elements that potentially could have been included merely affects the breadth of the claimed design.'"[4] Our understanding is that a design patent has only a single claim, and that a person of ordinary skill in the art would not understand there are any degrees or "breadth" in the single claim. This concept of "breadth" may be applicable to the claims of a utility patents, which can have "breadth" at least insofar as they can have a functional range or functional equivalents, but design patents are strictly ornamental, and cannot encompass any functional elements.

The court further noted that "Maatita also brought to the examiner's attention Ex Parte Kaufman." [5] [6] That case examined this image:

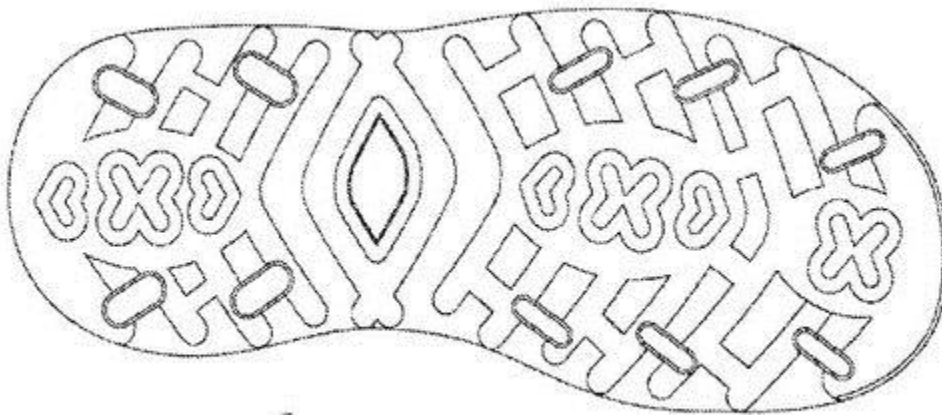


Figure 1 is a top plan view of the shoe sole.

The Patent Trial and Appeals Board wrote in its decision in Kaufman that he "has made clear that the scope of the claim is broad in that it covers an ornamental design for only the portion of the shoe sole as viewed from the top elevation. This claim breadth does not render the claim indefinite." [7] The problem with this holding, though, is that there is no such thing as a "top elevation" in the Kaufman drawing. A "top" or "plan" view is the correct terminology for the view depicted, "as seen in a horizontal plane viewed from above." [8] An "elevation" view is: "a drawing showing the vertical elements of the building, either exterior or interior, as a direct projection to a vertical plane." [9] In Kaufman, the PTAB erred because it failed to correctly determine that a design patent cannot be "broad" unlike a utility patent that may have broad functional claim terms in the language. The ornamental design of a design patent cannot be "broad." It can only claim what is depicted and nothing more.

The Federal Circuit Weighs In

Ultimately, Maatita appealed the rejection to the U.S. Court of Appeals for the Federal Circuit, which determined that the Patent Trial and Appeal Board “misapplied § 112 in the design patent context” in rejecting the design claim.[10] How did they arrive at this decision?

To begin with, the court wrote that “we think that the indefiniteness and enablement inquiries are similar and can be assessed together.” In reaching that result, the court relied not upon a design patent precedent for validity, and instead it relied upon *Carnegie Steel v. Cambria Iron*, a decision from 1902 that discussed infringement of a utility patent “for a method of mixing molten pig metal.” As discussed, though, legal analysis related to functional claim limitations is inapplicable to the single claim of ornamental designs.

The court further stated that “[w]ith this purpose in mind, it is clear that the standard for indefiniteness is connected to the standard for infringement. In the design patent context, one skilled in the art would look to the perspective of the ordinary observer since that is the perspective from which infringement is judged.”[11] However, the court’s reasoning ignores the enablement requirement, which must apply to the same ornamental drawings that the definiteness requirement also applies to. Further, the standard for indefiniteness is based upon the knowledge and experience of one skilled in the art and has nothing to do with the “ordinary observer” or with infringement. “Validity” and “infringement” have long been applied as two completely separate tests and there is no overlap or reason to combine them, just as there is no reason why an ordinary observer is qualified to opine on validity. Also, there is absolutely no reason why a person skilled in the art would look to the “perspective” of an ordinary observer, since the question of validity has nothing whatsoever to do with the question of infringement.

The improper reasoning in *Kaufman* appears to have influenced the court’s decision, and while reference is made to that decision in *Maatita*, there is no discussion by the court regarding whether *Kaufman* (a decision by a lower court) was correct.

The court’s analysis is also internally inconsistent. For example, the court stated on one hand that “the level of detail required should be a function of whether the claimed design for the article is capable of being defined by a two-dimensional, plan- or planar- view illustration,” but then acknowledged that the “design for an entire shoe or teapot, for instance, is inherently three-dimensional and could not be adequately disclosed with a single, plan- or planar view drawing. ... The design of a rug or placemat, on the other hand, is capable of being viewed and understood in two-dimensions through a plan- or planar-view illustration, which clearly defines the proper perspective.”[12] It is difficult to understand how the court can acknowledge the fact that the design for the article of manufacture claimed in *Maatita* — a shoe — is “inherently three-dimensional,” but then conclude that the single two-dimensional design drawing that would only be appropriate for an entirely unrelated article of manufacture such as a rug or place mat would be adequate for a shoe.

This internal inconsistency arises because the court has eliminated the requirement under 35 USC 112(a) for the claimed design to apprise a person of ordinary skill in the art of the manner and process of making and using the claimed design for a specific article of manufacture, and has replaced that statutory requirement with the test of whether the claimed design would be sufficiently definite for an ordinary observer to understand the claimed design, regardless of what type of article of manufacture that design is applied to. A rug designer might be able to make a rug with the claimed design in *Maatita*, but as the examiner found, that two-dimensional design would not allow a shoe designer of ordinary skill in the art to make and use a shoe that has an inherent three-dimensional design.

Additionally if a perspective view of the intended design was developed, which it was not, the variations in the surface would have been discernible and would most likely satisfy the

enablement requirement of 35 USC 112 because they would allow a person of ordinary skill in the art to make a shoe, and not a rug or floor mat. By confusing an ordinary observer conducting an infringement analysis with a validity analysis conducted by one skilled in the art, Maatita will enable design patents on two-dimensional designs for a limited class of articles of manufacture to be asserted against three-dimensional articles that are not enabled by those drawings. This will allow the patent owners to assert that the only enablement that is required is for an ordinary observer to recognize the design, and not for a person of skill in the art to be able to make and use the claimed ornamental design on a specific article of manufacture. Additionally there is no basis for comparing multiple embodiments and multiple drawings to the single drawing in the Maatita application.

The court in Maatita further stated that “[e]ven under the correct test, which looks to how the ordinary observer would interpret the drawing actually included in the application, the government argues that Maatita’s claim is indefinite because the design, as disclosed in the single, two-dimensional plan or planar view, could be applied to a three-dimensional shoe bottom in a number of ways.”[13] However, because the disclosure and the claim of a design patent are identical, the “correct test” for enablement is not how an ordinary observer would interpret the drawing for the purposes of determining infringement, but how one skilled in the art would understand the drawings for making and using the claimed ornamental design.

In addition, the court states that in “situations like this, where the sufficiency of a disclosure for purposes of § 112 depends on whether a drawing adequately discloses the design of an article, we believe that the level of detail required should be a function of whether the claimed design for the article is capable of being defined by a two-dimensional, plan- or planar- view illustration.”[14] A two-dimensional, plan or planar view of a claimed design for a three-dimensional article of manufacture is inadequate and incapable of describing the ornamental design of a three-dimensional product to a designer, and the court not only cites no evidence in support of this factual assertion, but as discussed above, acknowledges that is simply not the case.

In sum, the court erroneously applied the ordinary observer test, the standard in an infringement analysis, with the validity analysis conducted from the perspective of one skilled in the art, the standard for determining whether the disclosure is enabling. The USPTO should seek en banc review by the Federal Circuit, and failing that, should ask the U.S. Supreme Court to reverse the decision.

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[1] Drafting for Industry. Walter C. Brown, Clois E. Kicklighter. The Goodheart-Willcox Company, South Holland, IL. 1995. P.46.

[2] In re Maatita, 2018 U.S. App. LEXIS 23188, __ F.3d __, 2018 WL 3965892

[3] Maatita at [*1].

[4] Maatita at [*3].

[5] Appeal 2012 – 003545, Serial No.. 29/247,378 (P.T.A.B. Mar. 14, 2014).

[6] Maatita at [*3].

[7] Kaufman at pg. 4-5.

[8] Dictionary Of Architecture And Construction. Second Edition, edited by Cyril M. Harris. McGraw-Hill, Inc. New York. 1993.

[9] Ibid

[10] Maatita at [*1].

[11] Maatita at [*9].

[12] Maatita at [*13].

[13] Id.

[14] Id.