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Fed. Circ. Ruling May Allow Some Designers Broad Patents

By **Matthew Bultman**

Law360 (September 7, 2018, 6:11 PM EDT) -- The Federal Circuit's recent decision that a single drawing of a shoe sole met the requirements for a design patent could allow some designers to obtain broader protections, making it more difficult for copycats to avoid infringement — although experts say the ruling has its limitations.

In an Aug. 20 opinion, the appeals court reversed a Patent Trial and Appeal Board decision rejecting an application for a patent on the design of a shoe bottom. The court said a two-dimensional drawing of a three-dimensional object can, in some circumstances, meet the enablement and definiteness requirements for a design patent.

The ruling could open some new doors for design patent applicants, who attorneys said have faced pushback from the U.S. Patent and Trademark Officeabout whether a single plan view — which is essentially a head-on view — is sufficient for a 3D object.

"Here comes the Federal Circuit saying they're okay, which is really new," said Perry Saidman of Saidman Design Law Group.

For designers, this is more than just a matter of being able to file fewer drawings with their application, attorneys said. With a single plan view, a patent can have a broader scope of protection, making it more difficult for copycats to design around.

"Less is more in the design patent world," Saidman said. "The less that is shown in the drawings, the broader the claim."

Design patents, which protect the way a product looks, are much less common than utility patents, which protect processes and the way products operate. The instant ruling came in an appeal brought by inventor Ron Maatita, who filed an application in 2011 for the design of the bottom of an athletic shoe.

The application was rejected by a USPTO examiner who found the scope of protection Maatita sought couldn't be understood from the single drawing. The examiner said the 2D drawing left the design open to multiple interpretations about the depth and contours of the design.

The examiner's rejection was affirmed by the PTAB in March 2017.

The purpose of the definiteness requirement, the Federal Circuit said, is to ensure the disclosure is clear enough to give competitors an idea of what would infringe. In this case, the court said an "ordinary observer" would understand the claimed design and have no doubt how to determine infringement.

"Design patents do have some scope, and I think this opinion clarifies that by saying, just because you can interpret what the patent covers in more than one way, like … with the depth of the grooves, that doesn't mean that the patent is indefinite," said Tracy-Gene Durkin of Sterne Kessler Goldstein & Fox PLLC.

How this case turned out at the USPTO wasn't unusual, attorneys said, noting that over time the patent office has drifted toward the idea that it doesn't care much for single-view applications.

Examiners interpret the enablement and definiteness requirements strictly and prefer to see multiple drawings, with side views and the like, even for something that doesn't have appreciable depth. Saidman said this can result in a fairly narrow patent.

"If the depth of the elements is not part of the claim, as it now does not have to be, then the infringers couldn't so easily escape infringement if they want to use the same layout as used in the view," he said.

The Federal Circuit's ruling brings the U.S. more in line with Europe, where single views can be acceptable, attorneys said. Other places, like China and Japan, require the entire product to be shown. And the ruling creates some opportunities for patent applicants to potentially get creative.

Jon Birmingham of Fitch Even Tabin & Flannery LLP noted designers already use broken lines in patent drawings to show parts of the product that are not being claimed. This can help others understand what the object looks like, without narrowing the scope of protection.

The Maatita case "just gives another avenue to be creative with what people are doing as far as trying to claim broad," Birmingham said.

But the ruling is not without its limits. The Federal Circuit's opinion said that the design for an entire shoe or a teapot, for example, could not adequately be disclosed with a single plan view drawing. These types of large, 3D designs will still likely require multiple drawings.

"If its a spherical design, you're going to have a hard time getting a lot of the detail of that design into a single view," Durkin said.

Where the impact will most be noticeable is with designs that are fully visible from a single head-on view. This could work for designs that are on a single surface of a product, like the bottom of a shoe, but attorneys said there aren't many things like that.

"Does it broaden a small subset [of patent applications]? Perhaps," said Elizabeth Ferrill of Finnegan Henderson Farabow Garrett & Dunner LLP. "But I think there are other reasons why applicants might not take advantage of this opportunity to have their application be broader."

Even when the design is fully visible from a single plan view, there is no guarantee the examiner will find that view is sufficient, she said. The Federal Circuit ruling stated that a single view isn't necessarily indefinite — it did not say that view always meets that requirement.

“Generally speaking, you don’t want to be in a situation where the examiner says your single view is indefinite and you can’t add any more views because that would be new matter,” Ferrill said. “I think this is a small minority of cases where the applicant is willing to take the risk that they may get a very broad patent but they may also not get anything.”

Another reason applicants might be hesitant to pursue a broad patent is that it can open the door to more validity challenges, attorneys said.

“It’s the same in the utility context where if you have a very broad claim, sure it might be easier to establish infringement, but the trade-off is its harder to defend the validity,” said Derek Dahlgren of Rothwell Figg Ernst & Manbeck PC.

--Editing by Jill Coffey and Emily Kokoll.