

## *In re SurgiSil*, 14 F.4th 1380 (Fed. Cir. 2021)

BY DEIRDRE M. WELLS

SurgiSil filed for a design patent on the ornamental design for a lip implant. The sole figure in SurgiSil's application is shown in the top image in the right column. The patent examiner rejected the patent application under 35 U.S.C. § 102 over a Blick prior art catalog that discloses an art tool (referred to as a stump) for smoothing and blending large areas of pastel or charcoal. The similarly-shaped Blick art tool is shown in the bottom image on the right.

SurgiSil appealed the rejection to the Patent Trial and Appeal Board (Board), which affirmed the examiner's rejection. The Board found that the differences in shape between the claimed design and Blick are minor. The Board rejected SurgiSil's argument that Blick could not anticipate because it disclosed a "very different" article of manufacture than the claimed lip implant. The Board stated that for the purposes of determining the scope of the claim "it is appropriate to ignore the identification of the article of manufacture in the claim language."

SurgiSil appealed the Board's affirmance to the U.S. Court of Appeals for the Federal Circuit, which reversed. The court held that the Board's predicate decision, that the article of manufacture identified in the claim is not limiting, was an erroneous legal conclusion. The Federal Circuit stated that "[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 Federal Circuit thus reversed the Board's finding that Blick—which the parties did not dispute discloses an art tool rather than a lip implant—anticipates a claim directed to a lip implant.

**A design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract.**

