

# Design Patent Validity Challenges

## Rejected Application Appeals

\_\_\_% Affirmed  
\_\_\_% Reversed

## Reexamination

\_\_\_% unpatentable  
\_\_\_% patentable

## Inter Partes Review

\_\_\_% unpatentable  
\_\_\_% patentable

## Post Grant Review

\_\_\_% unpatentable  
\_\_\_% patentable

# Design Patent Validity Challenges

## Rejected Application Appeals\*

**47% Affirmed**  
**53% Reversed**

## Reexamination\*\*

**21% unpatentable**  
**79% patentable**

## Inter Partes Review

**28% unpatentable**  
**72% patentable**

## Post Grant Review

**20% unpatentable**  
**80% patentable**

## Post Grant Review

**1 of 5 invalid**  
**1 pending fwd**

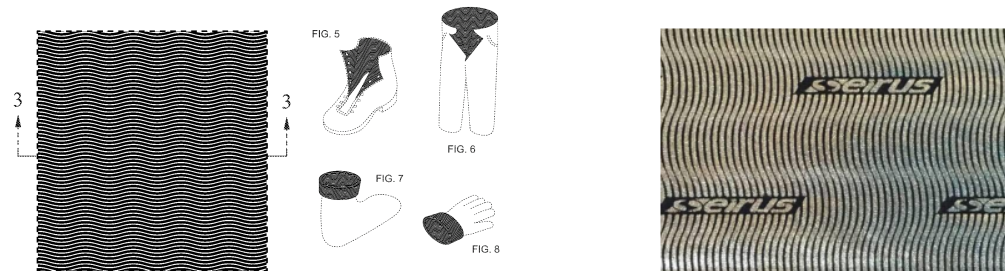
\*USPTO data

\*\*Updated in August 2019

# ***Columbia Sportswear v. Seirus Innovative Accessories***

2018-1329 (November 13, 2019)

**D657,093**



- District Court granted SJ infringement
- Case went to trial on utility patent infringement and profit was awarded under 35 U.S.C. 289 for design patent infringement
- Federal Circuit determined that the district court “improperly declined to consider the effect of defendant’s logo in its infringement analysis”
- Plaintiff filed a request for rehearing on January 13th, 2020
- Patent survived reexamination (90/014,113)



# Inter Partes Review

## Institution

Utility Institution: 66% (5,500/8,412)

**59% Denied**      **41% Granted**

43 IPRs have been filed for design patents. Institution has been decided for 39: denied in 23 and granted in 16; 4 are pending

## Final Written Decision

Utility Outcome: 63% all claims unpatentable  
18% mixed  
20% all claims survived

**31% Survive**      **69% Unpatentable**

Of the 16 instituted IPRs with FWD, 11 found the claimed design unpatentable and 5 found the claimed design not unpatentable. Notice of Appeal filed for 7, 5 affirmed, 2 reversed.



***Johns Manville Corp. v. Knauf Insulation, Inc.***

2017-1807 (IPR2015-01453)

2018-1260 (IPR2016-00130)

**IPR Final Decision:  
NOT UNPATENTABLE**

**affirmed (rule 36)**



**D631,670**



**Prior Art**

# ***Kolcraft Enterprises, Inc. v. Graco Children's Products, Inc.***

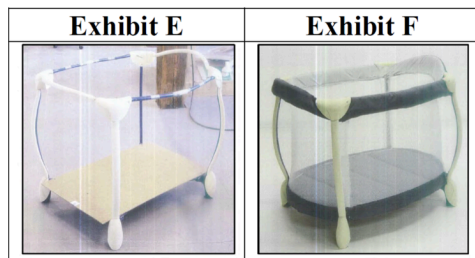
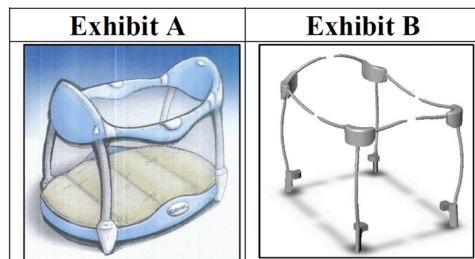
2018-1259 (IPR2016-00816)

2018-1260 (IPR2016-00826)

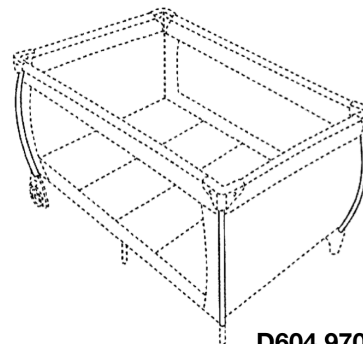
July 2, 2019

**IPR Final Decision:  
UNPATENTABLE**

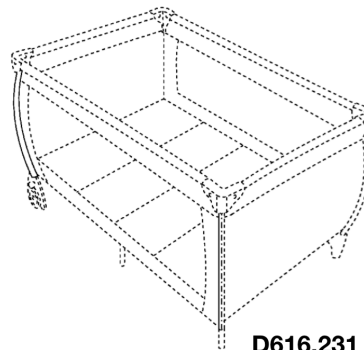
**affirmed**



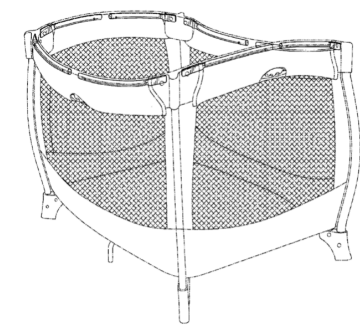
**prior conception  
was uncorroborated**



D604,970



D616,231



D494,393

**prior art  
(103)**

# ***Campbell Soup Co. v. Gamon Plus***

2018-2029 (IPR2017-00091)

2018-2030 (IPR2017-00094)

September 26, 2019

**IPR Final Decision:  
NOT UNPATENTABLE**

**reversed**

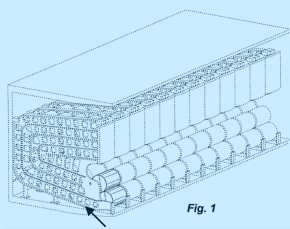
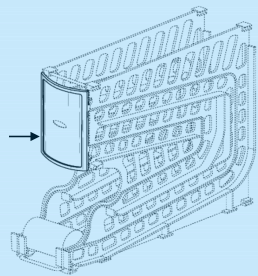
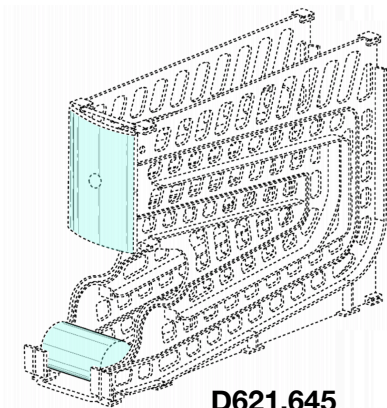


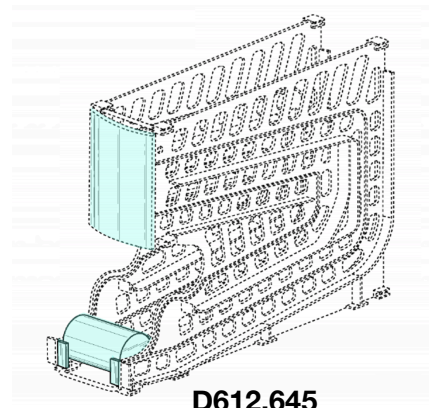
Fig. 1



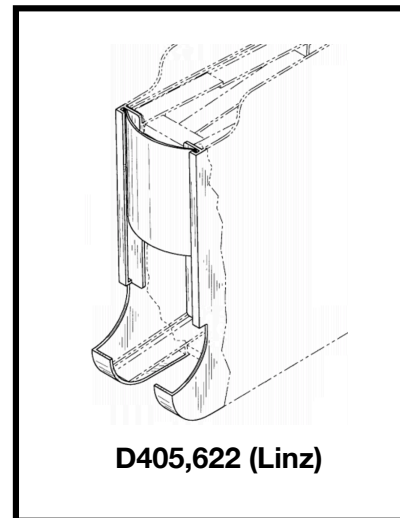
previously invalidated by IPR



D621,645

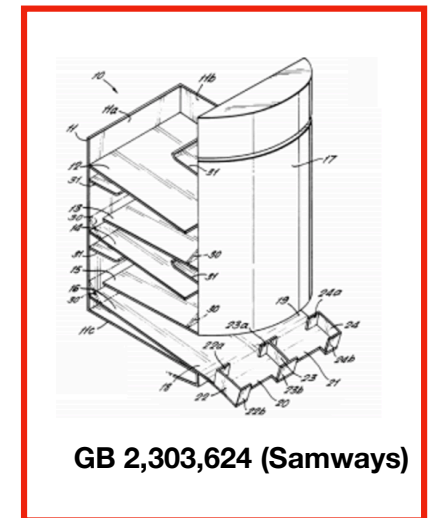


D612,645



D405,622 (Linz)

OK to be Primary Reference



GB 2,303,624 (Samways)

Not a Primary Reference

## ***Campbell Soup Co. v. Gamon Plus***

2018-2029 (IPR2017-00091)

2018-2030 (IPR2017-00094)

September 26, 2019

Accordingly, in light of the remand from the Federal Circuit and the Supreme Court's decision in *SAS*, we hereby modify our Decisions on Institution in each proceeding (IPR2017-00091, Paper 12; IPR2017-00094, Paper 13) to include each of the non-instituted grounds challenging the design claim of each patent. Thus, the grounds to be addressed in the post-remand phase of this proceeding are as follows:<sup>3</sup>

Reference(s)	Basis
Linz	§ 102
Linz alone or in view of Samways <sup>10</sup> or Knott	§ 103(a)
Samways	§ 102
Abbate in view of Samways and/or Linz	§ 103(a)
Primiano in view of Samways or Knott	§ 103(a)

### **I. PRECISE RELIEF REQUESTED**

Pursuant to 37 C.F.R. §§ 42.5, 42.71 and as authorized by the Board, Petitioners' Campbell Soup Company, Campbell Sales Company and Trinity Manufacturing LLC request limiting the petition for *inter partes* review case IPR2017-00091 to the following grounds on remand:

Reference(s)	Basis
Linz alone, or in view of Samways or Knott	§ 103
Abbate in view of Samways and/or Linz	§ 103
Primiano in view of Samways or Knott	§ 103

The Petitioners respectfully request the Board remove the following grounds from this proceeding:

Reference(s)	Basis
Linz	§ 102
Samways	§ 102

Patent Owner Gamon Plus, Inc. does not oppose so long as its cooperation in no way constitutes waiver of any rights or revives any otherwise unavailable arguments to Petitioners.

***LKQ Corp. v. GM Global Tech. Oper.***

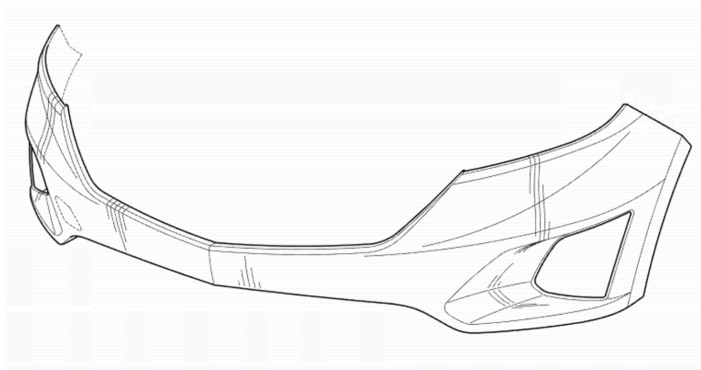
IPR2020-00062 (D811,964)

IPR2020-00063 (D828,255)

IPR2020-00064 (D823,741)

IPR2020-00065 (D813,120)

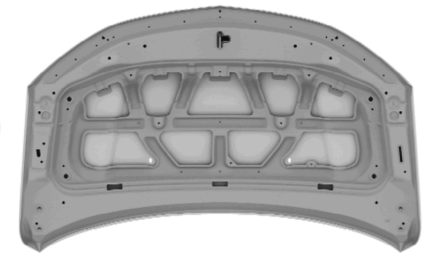
Filed October 17, 2019



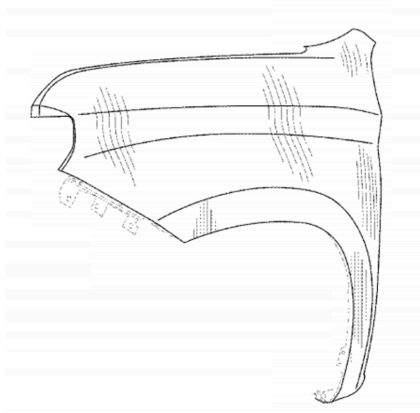
D811,964



D828,255



D813,120



D823,741



# Post Grant Review

## Institution

Utility Institution: 59% (85/143)

**4 Denied**

**3 Granted**

**57% Denied**

**43% Granted**

12 requests for PGR of a design patent. One settled before institution; Institution was denied in 4 and granted in 3; 4 pending institution decision.

1 Pending trial:

*Man Wah Holdings Ltd. v. Raffel Systems* (PGR2019-00029, instituted 7/10/19).

1 Terminated before FWD: Adverse judgement request by Patent Owner

*Sattler Tech v. HumanCentric Ventures* (PGR2019-00030, instituted 7/26/2019).

## Final Written Decision

Utility Outcome: 68% all claims unpatentable  
20% mixed  
12% all claims survived

**1 Unpatentable**

*C&D Zodiac, Inc. v. B/E Aerospace, Inc.* (PGR2017-00019)

***LKQ Corp. v. GM Global Tech. Oper.***

PGR2020-00002 (D847,043)

PGR2020-00003 (D847,703)

PGR2020-00004 (D840,306)

PGR2020-00005 (D841,532)

Filed October 17, 2019

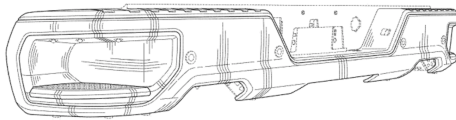


FIG. 1

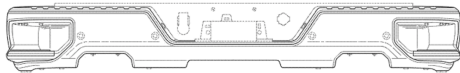


FIG. 2

D847,043

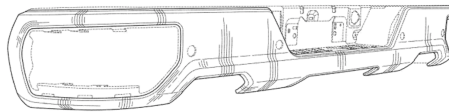


FIG. 1

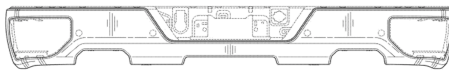


FIG. 2

D847,703

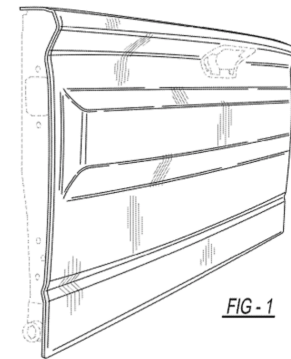


FIG-1

D840,306

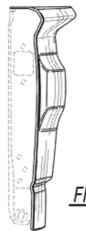


FIG-2

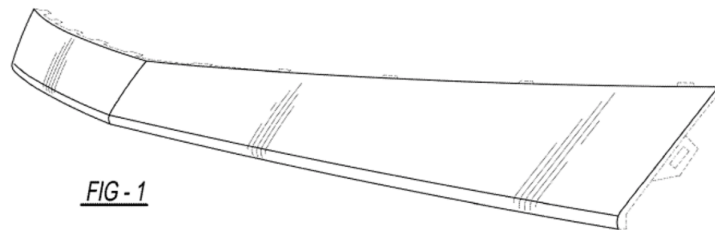
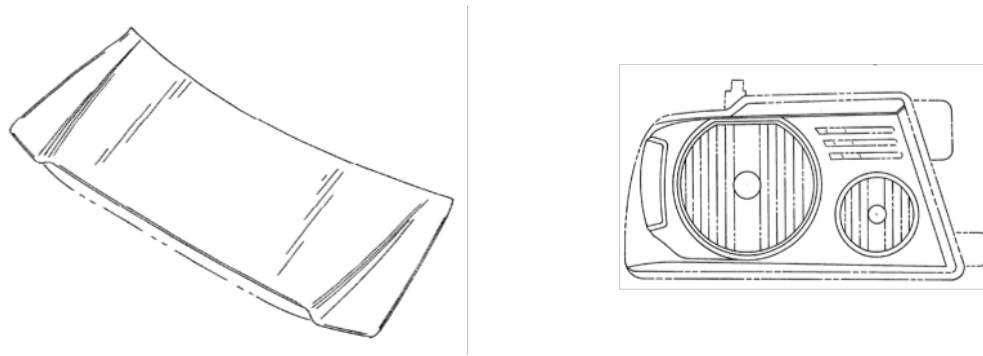


FIG-1

D841,532

***Automotive Body Parts Assoc. v. Ford Global Tech.***  
Fed. Cir. 2018-1613 (July 23, 2019)



**validity of design patents for replacement parts affirmed**

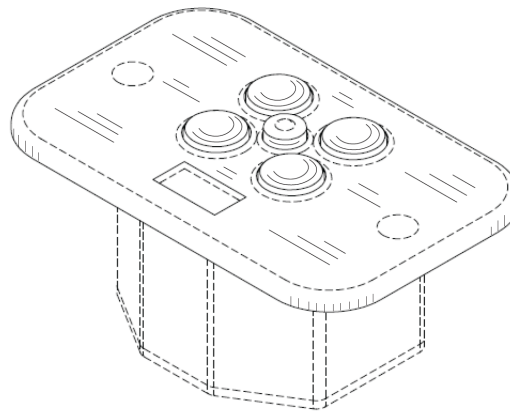


***Man Wah Holdings Ltd. v. Raffel Sys., LLC***  
PGR2019-00029 (pending, instituted July 10, 2019)

**PTAB found it readily discernible that email attachment illustrated a design “identical in all material respects” to the patented design, more than one year before its filing date.**



**instituted under 102 based on  
image accompanying  
alleged offer for sale**



**D821,986**



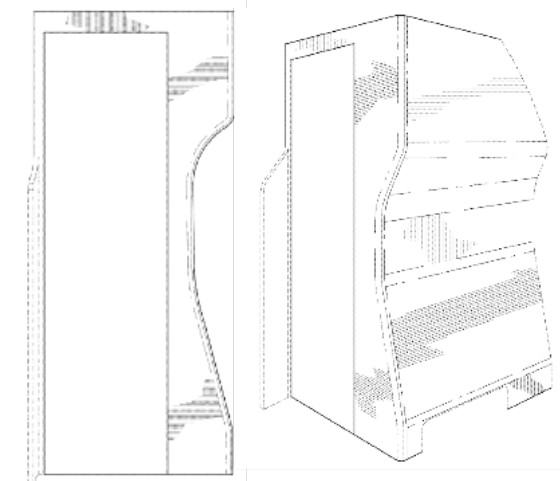
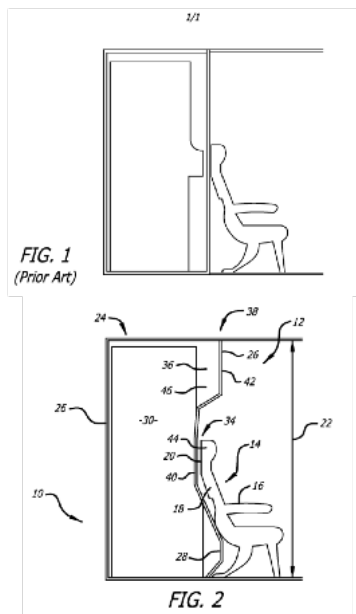
**not instituted under 103**

# ***C&D Zodiac v. B/E Aerospace***

PGR2017-00019 (final written decision October 23, 2018)

**DECISION IN FIRST DESIGN PATENT PGR TRIAL:**

**UNPATENTABLE**



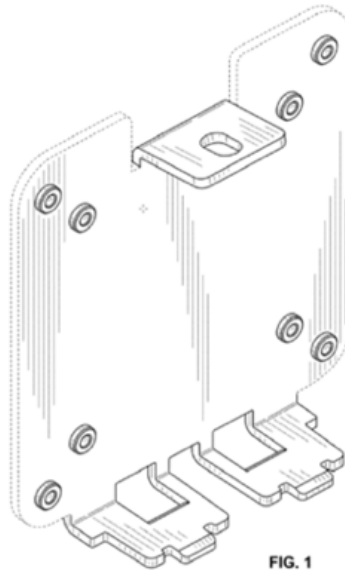
UTILITY APP

PATENTED DESIGN

priority denied

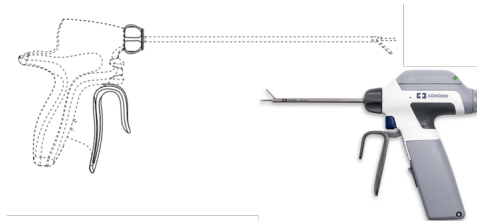
# ***Sattler Tech v. HumanCentric Ventures***

PGR2019-00030 (instituted July 26, 2019)

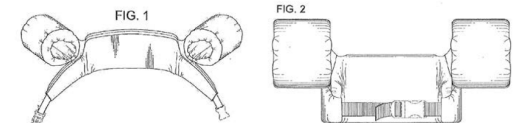


**D823,093**

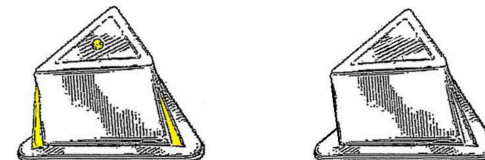
***Ethicon Endo-Surgery v. Covidien***  
796 F.3d 1312 (Fed. Cir. 2015)



***Sport Dimension v. The Coleman Company***  
820 F.3d 1216 (Fed. Cir. 2016)



***Elmer v. ICC Fabricating***  
67 F.3d 1571 (Fed. Cir. 1995)



- First PGR Trial Instituted on the invalidity ground of Lack of Ornamentality
- Requester argued that the design is dictated by its use as a VESA mount adapter
- Patent owner requested adverse judgment
- Trial terminated before FWD

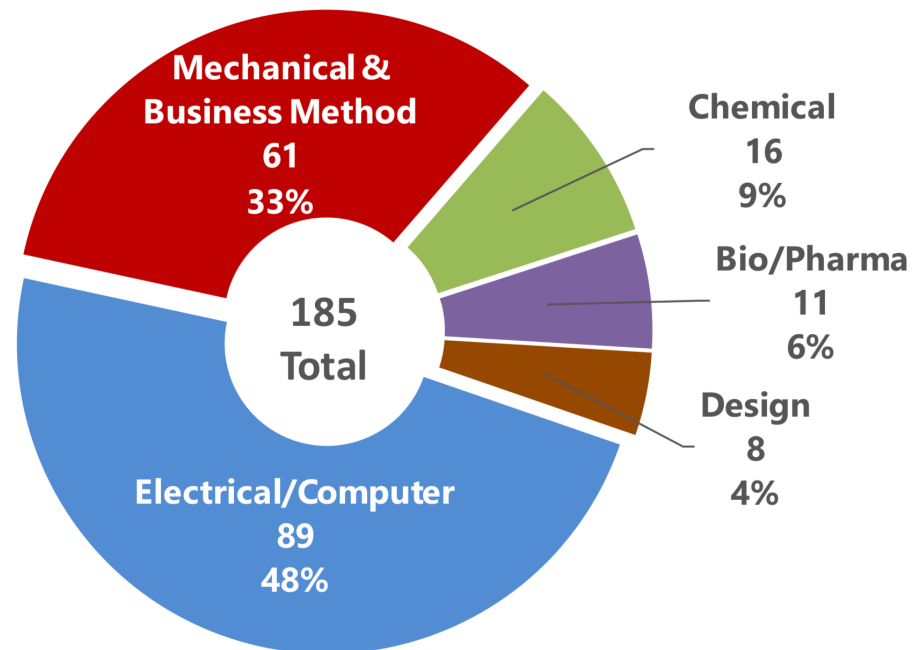
**Thank You!**

**Suggestions?**

**Questions?**

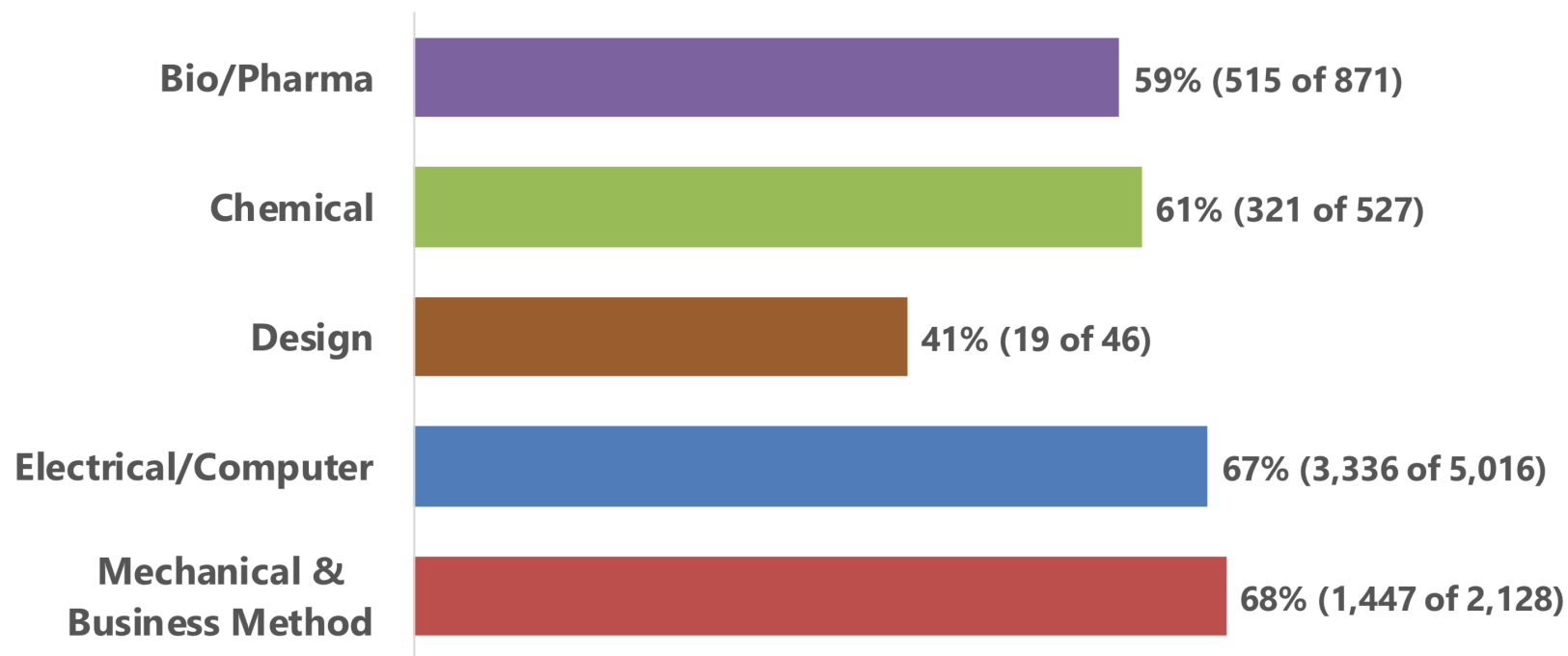
## Petitions Filed by Technology in FY20

(FY20: Oct. 1, 2019 to Nov. 30, 2019)



# Institution Rates by Technology

(All Time: Sept. 16, 2012 to Nov. 30, 2019)



Institution rate for each technology is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.

