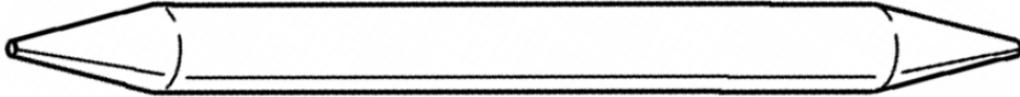


## Design Patent Claim Limits the Scope of the Analogous Prior Art

A recent Federal Circuit decision has held that the claimed article of manufacture in a design patent application is limiting for the purposes of the scope of the relevant prior art.<sup>1</sup> SurgiSil applied for an ornamental design for a lip implant in U.S. design patent application serial no. 29/491,550 (representative figure pictured immediately below).



The U.S. Patent Examiner of the SurgiSil application rejected the claim as anticipated by (i.e., lacking novelty in view of) a prior art paper stump product used for drawing (pictured below).



SurgiSil appealed the final rejection of the Examiner to the Patent Trial and Appeal Board (PTAB), which affirmed the Examiner's rejection. The PTAB found that the particular article of manufacture set forth in the sole claim of the design patent application was not limiting when considering the scope of the analogous prior art. SurgiSil appealed the PTAB decision to the Court of Appeals for the Federal Circuit.

In reversing the PTAB, the Federal Circuit cites its recent case of *Curver Luxembourg, SARL v. Home Expressions Inc*<sup>2</sup> which found that the claim of a design patent must be limited to a particular article of manufacture, and that the claim cannot be directed toward a design in the abstract. In that case, the patentee asserted a design patent for a pattern for a chair having an interwoven Y-shape against a defendant selling storage bins having an identical pattern. The defendant successfully moved to dismiss the infringement action on the grounds that the scope of the design patent was limited to a chair and could not read on a different article of manufacture.

Accordingly, in the SurgiSil case, the Federal Circuit found that the PTAB improperly disregarded the scope of the claimed lip implant when it found that a paper stump drawing tool to be analogous prior art that could support an anticipation rejection.

It will be interesting to see if the SurgiSil application at issue is ultimately allowed following the decision, or if the Examiner will reopen prosecution to consider the obviousness of the claimed design. Even if SurgiSil is granted a design patent on the lip implant at issue, the primarily functional design of the lip implant, which is ultimately concealed within the pouty lips of a patient, may limit the usefulness

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<sup>1</sup> In re SurgiSil, L.L.P., 14 F.4th 1380 (Fed. Cir. 2021). Available at: [https://cafc.uscourts.gov/opinions-orders/20-1940.opinion.10-4-2021\\_1843781.pdf](https://cafc.uscourts.gov/opinions-orders/20-1940.opinion.10-4-2021_1843781.pdf).

<sup>2</sup> 938 F.3d 1334 (Fed. Cir. 2019).

of such a design patent. SurgiSil has been granted at least one U.S utility patent on the general shape of the lip implant at issue, which may be relevant when considering the functionality of the design.

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