

Summer 2022

Mmm, mmm, no good: Refocusing on the Article of Manufacture Requirement for Obviousness of Design Patents

Avery J. Welker

Follow this and additional works at: <https://scholarship.law.missouri.edu/mlr>

Recommended Citation

Avery J. Welker, *Mmm, mmm, no good: Refocusing on the Article of Manufacture Requirement for Obviousness of Design Patents*, 87 MO. L. REV. (2022)

Available at: <https://scholarship.law.missouri.edu/mlr/vol87/iss3/19>

This Note is brought to you for free and open access by the Law Journals at University of Missouri School of Law Scholarship Repository. It has been accepted for inclusion in Missouri Law Review by an authorized editor of University of Missouri School of Law Scholarship Repository. For more information, please contact bassettcw@missouri.edu.

NOTE

Mmm, mmm, no good: Refocusing on the Article of Manufacture Requirement for Obviousness of Design Patents

Campbell Soup Co. v. Gamon Plus, Inc., 10 F.4th 1268 (Fed. Cir. 2021), cert. denied, 142 S. Ct. 1129 (2022).

Avery J. Welker*

I. INTRODUCTION

While Campbell's canned soup is appetizing to many, patent attorneys may not have an appetite for the law of obviousness. In the *Inter Partes* Review ("IPR") process, a petitioner often attempts to invalidate patent claims using the sword of obviousness.¹ When defending a patent in an IPR, a patent owner must apply evidence supporting patent validity to the invention itself. Why even have the requirement to link evidence to a patented invention in the first place? *Campbell Soup Co. v. Gamon Plus, Inc.* attempted to answer this question.²

In *Campbell Soup Co.*, the IPR petitioner, Campbell Soup, appealed a decision by the Patent Trial and Appeal Board ("PTAB") favoring the patent holder, Gamon Plus.³ The PTAB's final written decision notably concluded that Campbell Soup did not prove the challenged design patents obvious even when compared against a similar design found in the prior

*B.S. Petroleum Engineering, Missouri University of Science and Technology, 2016; M.S. Petroleum Engineering, Missouri University of Science and Technology, 2018; J.D. Candidate, University of Missouri School of Law, 2023; Associate Member *Missouri Law Review*, 2021–2022; Lead Articles Editor *Missouri Law Review*, 2022–2023. I am grateful to Professor Dennis Crouch for his mentorship, advice, and assistance throughout the drafting process. Special thanks to my colleagues on *Missouri Law Review* for their assistance and excellent editorial suggestions.

¹ The law of obviousness for patents is discussed in Part III., Section C, *infra*.

² *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268 (Fed. Cir. 2021), cert. denied, 142 S. Ct. 1129 (2022).

³ *Campbell Soup Co.* regards a second appeal to the Federal Circuit after the PTAB, on remand from an earlier Federal Circuit decision in this case, issued another final written decision regarding the same IPR. *Id.* at 1274–75. The procedural posture in this case is detailed in Part II., *infra*.

art.⁴ On appeal, the Court of Appeals for the Federal Circuit first determined that the prior art reference had the same overall visual appearance as the two design patents at issue.⁵ According to the Federal Circuit, such a finding strongly suggested that the designs were obvious and thus unpatentable.⁶ The law permits a patentee to introduce additional objective evidence of non-obviousness, such as commercial success, copying, and industry praise, but the Federal Circuit concluded that the patentee also failed to raise these arguments successfully.⁷ Although Gamon's soup-can dispenser product was commercially successful, the evidence failed to link that success to the particular features claimed in the design patents.⁸

To effectively address patent law's many facets among the different types of patents, this Note highlights how *Campbell Soup Co.* addresses the tension between adjudicating obviousness issues for different types of patents, including design and utility patents.⁹ In addition, this Note describes where *Campbell Soup Co.* fits in with other recent Federal Circuit cases. Part II outlines the underlying facts, procedural history, and holdings in *Campbell Soup Co.* Part III provides the relevant legal background of design patents, *Inter Partes* Reviews, the law of obviousness, and pre-*Campbell Soup Co.* Federal Circuit precedent. Part IV describes the Federal Circuit's decisions in *Campbell Soup Co.* to invalidate the patents at issue and overturn the PTAB's IPR final decisions. And finally, Part V comments on how the Federal Circuit's holding in *Campbell Soup Co.* strengthens design patents and fosters

⁴ *Campbell Soup Co.*, 10 F.4th at 1270.

⁵ *Id.* at 1276. Prior art is defined in 35 U.S.C. § 102(a). This statute reads:

A person shall be entitled to a patent unless

- (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
- (2) the claimed invention was described in a patent [], or in an application for a patent published or deemed published [], in which the patent or invention, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

35 U.S.C. § 102(a). This statute refers to prior art as information known before the inventor filed the patent. *See, e.g.*, *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 15 (1966). Here, the Federal Circuit is referring to a design patent granted before the patents at issue were filed. The prior art reference and the patents at issue are introduced in Part II., *infra*.

⁶ *See Campbell Soup Co.*, 10 F.4th at 1276.

⁷ *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966). *See* JANICE M. MUELLER, *PATENT LAW* 432–33 (6th ed. 2020).

⁸ *Id.*

⁹ Design patents are further described in detail in Part III, Section A, and utility patents are briefly introduced in note 48, *infra*.

design innovation by requiring design patent owners to tie a design directly to an article of manufacture.¹⁰

II. FACTS AND HOLDING

Campbell Soup Company (“Campbell”) sells canned soup nationwide in grocery stores.¹¹ To stock the soup in stores throughout the nation, Campbell used soup can dispensers designed and manufactured by Gamon Plus, Inc. (“Gamon”).¹² Gamon named the dispensers “iQ Maximizers” and sold almost \$31 million of these dispensers to Campbell from 2002 to 2008.¹³ Campbell installed the iQ Maximizers in 17,000 stores during that time.¹⁴ Campbell attributed an increase in soup sales to the iQ Maximizer’s large label area and storage efficiency.¹⁵ However, in 2008, Campbell bought similar dispensers from another manufacturer, Trinity Manufacturing, LLC (“Trinity”).¹⁶

In 2015, Gamon sued Campbell and Trinity for patent infringement.¹⁷ In response to Gamon’s lawsuit, Campbell and Trinity challenged the two design patents owned by Gamon through the *Inter Partes* Review (IPR) process.¹⁸ The patents at issue, U.S. Patent Nos. D612,646 (“D646”) and D621,645 (“D645”) both claim “[t]he ornamental design for a gravity

¹⁰ The article of manufacture requirement is further described in Part III., Section A, *infra*.

¹¹ *Campbell Soup Co.*, 10 F.4th at 1273. Campbell Soup Company includes Campbell Sales Company. *Id.* at 1270.

¹² *Id.* at 1273.

¹³ *Id.*

¹⁴ *Id.*

¹⁵ *Id.*

¹⁶ *Id.*

¹⁷ *Id.* at 1274. Gamon filed suit in the Northern District of Illinois. *Id.* Gamon sued Campbell and Trinity under 35 U.S.C. § 271(a) which provides that “. . . whoever without authority makes, uses, offers to sell, or sells any patented invention . . . infringes the patent.” See Complaint for Patent Infringement at 28–31, 39–43, Gamon Plus, Inc. v. Campbell Soup Co., No. 1:15-cv-08940 (N.D. Ill. filed Oct. 8, 2015).

¹⁸ *Campbell Soup Co.*, 10 F.4th at 1274. *Inter Partes* Reviews (IPRs) are an administrative procedure conducted through the Patent Trial and Appeals Board (PTAB) and allow a third-party petitioner (not the patent owner) to cancel a patent as a whole or parts of the patent. 35 U.S.C. § 311. IPRs are discussed in further detail in Part III. B., *infra*.

feed dispenser display, as shown and described.”¹⁹ Gamon implemented these designs in its iQ Maximizer gravity feed dispensers.²⁰

The patents at issue both claim the front display faceplate of a gravity-fed dispenser display.²¹ Both patents at issue further claim “partial designs,” which are designs “defined to include something less than the entire configuration or surface ornamentation of a particular product.”²² Specifically, ’D646 claims only the front-facing label area, cylindrical object length, edge, and dispenser front stop.²³ Similarly, ’D645 claims only the front-facing label area and part of a cylindrical object length showing curvature.²⁴ The two designs diverge at the cylindrical object edges and front stops, included in ’D646 but not in ’D645, and a small circle omission in ’D645 not present in ’D646.²⁵

¹⁹ *Campbell Soup Co.*, 10 F.4th at 1270 (quoting U.S. Patent Nos. D612,646, issued Mar. 30, 2010, and D621,645, issued Aug. 17, 2010); Gravity Feed Dispenser Display, U.S. Patent No. D612,646 (filed Sep. 25, 2009) (issued Mar. 30, 2010); Gravity Feed Dispenser Display, U.S. Patent No. D621,645 (filed Feb. 9, 2010) (issued Aug. 17, 2010).

²⁰ *Campbell Soup Co.*, 10 F.4th at 1273.

²¹ *Id.* at 1271–72; ’D646 Patent; ’D645 Patent. The figures in ’D646 and ’D645 show the entire display, however, only features drawn with solid lines are part of the design patent claims. *Campbell Soup Co.*, 10 F.4th at 1271–72. Any broken lines shown are solely for overall design context of the entire display. *Campbell Soup Co.*, 10 F.4th at 1271–72. Design patents are described in detail in Part III., Section A.

²² Sarah Burstein, *The “Article of Manufacture” in 1887*, 32 BERKELEY TECH. L.J. 1, 16 n.91 (2017).

²³ *Campbell Soup Co.*, 10 F.4th at 1271; ’D646 Patent.

²⁴ *Campbell Soup Co.*, 10 F.4th at 1272; ’D645 Patent.

²⁵ *Campbell Soup Co.*, 10 F.4th 1271–72; Compare ’D646 Patent fig.1 (showing claimed label area, cylindrical object with small circle ends, and front stops), with ’D645 Patent fig.1 (showing claimed label area with small omission and cylindrical object bounds).

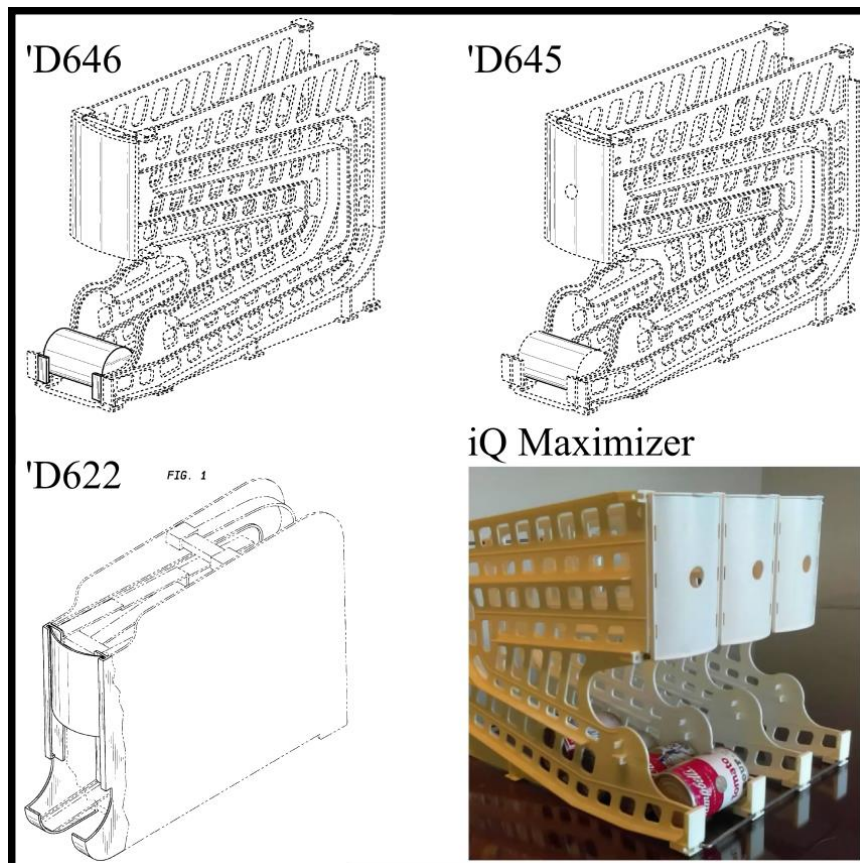


FIGURE 1: COMPARISON OF THE PATENTS AT ISSUE ('D646 AND 'D645) WITH THE CITED PRIOR ART ('D622) AND THE COMMERCIAL EMBODIMENT OF THE PATENTS AT ISSUE (IQ MAXIMIZER).²⁶

Campbell and Trinity’s IPR petitions sought review of the patents at issue.²⁷ They argued that the patents at issue were obvious over U.S. Patent No. D405,622 (“D622”) or U.S. Patent No. 4,909,578 (“578”)—which are other can dispenser designs.²⁸ The PTAB instituted review on

²⁶ At bottom left: Display Rack, U.S. Patent No. D405,622 fig.1 (filed Nov. 5, 1997) (issued Feb. 16, 1999); at top left: 'D646 Patent; at top right: 'D645 Patent; at bottom right: commercial embodiment of the patents at issue (iQ Maximizer) from *Campbell Soup Co.*, 10 F.4th at 1273. In the design patents, solid black lines show areas the design patent claims and the dashed black lines are used to show “visible elemental structure.” 37 C.F.R. § 1.152 (2021).

²⁷ *Campbell Soup Co.*, 10 F.4th at 1274.

²⁸ *Id.* at 1270.

only the 'D622 grounds.²⁹ 'D622, "Display Rack," shares the same perspective view as shown in both patents at issue and claims features related to the front-facing label display, side edges, item holding area, and front stops.³⁰

Initially, the PTAB held that Campbell and Trinity did not prove that the patents at issue were unpatentable.³¹ That is, the PTAB concluded that 'D622 could not serve as a primary reference for proving unpatentability because 'D622 was too different from the claims of the patents at issue.³² Campbell and Trinity appealed this decision to the Court of Appeals for the Federal Circuit.³³ The Federal Circuit's first review of the PTAB's decision vacated and remanded the PTAB's decision because "ever-so-slight differences" were not enough to show that 'D622 was not a proper primary reference.³⁴ The court further instructed the PTAB to consider the obviousness grounds based on '578 previously left behind.³⁵

The PTAB, on remand, again held that Campbell and Trinity did not prove unpatentability, '578 was not a proper primary reference, and the patents at issue would not be obvious over 'D622 either alone or combined with other references.³⁶ Regarding 'D622, the PTAB expanded on its original rationale to note that while 'D622 is visually similar to the patents at issue, objective indicia of nonobviousness were strong enough to outweigh the similarities.³⁷ Specifically, the PTAB found "Gamon's commercial success in selling iQ Maximizers to Campbell[,][] Campbell's praise of, and commercial success in using, the iQ Maximizer[,] and [] Trinity's copying of the iQ Maximizer" as the objective indicia of

²⁹ *Id.* at 1274. (citing both of Appellants' petitions for *Inter Partes* Review, *Campbell Soup Co. v. Gamon Plus, Inc.*, No. IPR2017-00091, 2017 WL 1216049, at *12 (P.T.A.B. Mar. 30, 2017) and *Campbell Soup Co. v. Gamon Plus, Inc.* No. IPR2017-0094, 2017 WL 1216030, at *14 (P.T.A.B. Mar. 30, 2017)); 'D622 Patent; Display Case, U.S. Patent No. 4,909,578 (filed Jun. 21, 1989) (issued Mar. 20, 1990). The PTAB noted that the designs in '578 and 'D645 did not share the same overall impression and decided to not institute an IPR on the '578 grounds. *Campbell Soup Co. v. Gamon Plus, Inc.*, No. IPR2017-00091, 2017 WL 1216049, at *11 (P.T.A.B. Mar. 30, 2017). The law of obviousness is discussed in Part III. C., *infra*.

³⁰ Compare 'D622 Patent with Gravity Feed Dispenser Display, U.S. Patent No. D612,646 fig.1 (filed Sep. 25, 2009) (issued Mar. 30, 2010) and Gravity Feed Dispenser Display, U.S. Patent No. D621,645 fig.1 (filed Feb. 9, 2010) (issued Aug. 17, 2010).

³¹ *Campbell Soup Co.*, 10 F.4th at 1274.

³² *Id.*

³³ *Id.*

³⁴ *Id.* (quoting *Campbell Soup Co. v. Gamon Plus, Inc.*, 939 F.3d 1335, 1340–41 (Fed. Cir. 2019)).

³⁵ *Id.*

³⁶ *Id.*

³⁷ *Id.* at 1274–75. The law of obviousness and objective indicia of nonobviousness are detailed further in Parts III. B. and C., respectively, *infra*.

nonobviousness.³⁸ Further, the PTAB found that Gamon established a nexus between the objective indicia and 'D646 and 'D645 and that there was a presumption of that nexus because the iQ Maximizer is coextensive with the claims in the patents at issue.³⁹

Campbell and Trinity again appealed the PTAB's final written nonobviousness determination.⁴⁰ Reviewing the PTAB's decisions *de novo*, the Federal Circuit re-analyzed the *Graham* obviousness factors.⁴¹ The court affirmed the PTAB's determination as to the first three *Graham* factors, finding that the potential primary reference, 'D622, had the same visual characteristics.⁴² However, the court disagreed with the PTAB's findings of a presumption of nexus and nexus-in-fact between the designs in the patents at issue and the presented evidence of objective indicia – commercial success and praise – as the court determined that there was insubstantial evidence to support either proposition.⁴³ The court held that design patents and utility patents should be held to the same standard in the nexus-in-fact inquiry—and thus, the “objective indicia must be linked to a design patent claim’s unique characteristics.”⁴⁴ Further, the court determined that evidence of copying alone did not overcome the obviousness evidence present in 'D622.⁴⁵ Ultimately, the Federal Circuit reversed the PTAB's decisions, concluding that the patents at issue were obvious in view of 'D622 after weighing the *Graham* factors.⁴⁶

³⁸ *Campbell Soup Co.*, 10 F.4th at 1275.

³⁹ *Id.*

⁴⁰ *Id.*

⁴¹ *Id.* The *Graham* factors help determine whether a patent satisfies 35 U.S.C. § 103. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966). The *Graham* factors are listed and described in Part III., Section C, *infra*.

⁴² *Campbell Soup Co.*, 10 F.4th at 1276.

⁴³ *Id.* at 1277. When the Federal Circuit reversed the PTAB's finding of a presumption of nexus, the Federal Circuit ultimately decided that the PTAB used the incorrect legal standard of coextensiveness from the Federal Circuit's 2019 decision in *Fox Factory, Inc. v. SRAM, LLC* when the PTAB distinguished *Fox Factory* because it involved a utility patent rather than a design patent. *Id.* at 1277 (citing *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1374 (Fed. Cir. 2019)). More detailed looks at the Federal Circuit's discussion regarding coextensiveness and *Fox Factory* are located in Parts III. D. and IV. B., respectively, *infra*.

⁴⁴ *Campbell Soup Co.*, 10 F.4th at 1279.

⁴⁵ *Id.*

⁴⁶ *Id.* at 1274.

III. LEGAL BACKGROUND

In United States patent law, three types of patents are available to secure intellectual property rights for inventions: plant patents,⁴⁷ utility patents,⁴⁸ and design patents.⁴⁹ United States Code Title 35 governs United States patent law.⁵⁰ A patent owner holds a right to exclude others from the use outlined in the patent claims.⁵¹ This Part discusses the legal framework of design patents and how the law of obviousness applies to design patents through the lens of an *Inter Partes* Review.

A. Design Patents Generally

A design patent protects the “new, original and ornamental design of an article of manufacture.”⁵² While 35 U.S.C. Chapter 16 (Sections 171–73) generally governs design patents, Section 171(b) applies the rest of Title 35 to design patents.⁵³ The United States Patent and Trademark Office (“USPTO”) grants design patents for fifteen years from the date of issuance.⁵⁴ Protection is an exclusionary right and extends throughout the United States.⁵⁵

Ornamental features include the shape and configuration of the article of manufacture, a design applied to an article of manufacture, or a

⁴⁷ Plant patents are governed by 35 U.S.C. §§ 161–64. A plant patent grants the owner the right to exclude use and asexual reproduction of plants covered in the patent. *Id.* § 163. Plant patents protect inventors who discover “any distinct and new variety of plant” with the caveat that the plant must be asexually reproduced. *Id.* § 161.

⁴⁸ A utility patent protects inventions that are categorized as: (1) a process; (2) a machine; (3) a manufacture; or (4) a composition of matter, or an improvement to an invention in one of those categories. *Id.* § 101.

⁴⁹ *Id.* §§ 171–73.

⁵⁰ 35 U.S.C.

⁵¹ *Id.* § 154(a).

⁵² 35 U.S.C. ch. 16 (§§ 171–73) governs design patents. Section 171(b) incorporates all the rest of Title 35 to design patents (unless otherwise provided). *Id.* § 171(b). Compare 35 U.S.C. § 171 (design patents require a “new, original and ornamental design of an article of manufacture.”) with 35 U.S.C. § 101 (utility patents require “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.”).

⁵³ *Id.* § 171(b) (Title 35 applies to design patents unless “otherwise provided”). For example, by applying the rest of Title 35 to design patents, design patents must fulfill the requirements of novelty from 35 U.S.C. § 102 and the obviousness requirements of 35 U.S.C. § 103.

⁵⁴ *Id.* § 173. This applies to design patents filed after May 13, 2015. U.S. PATENT & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 1505 Term of Design Patent (9th ed. Rev. Oct. 2019). Design patents filed before May 13, 2015 have only 14-year terms. *Id.*

⁵⁵ 35 U.S.C. § 271(a).

combination of the two.⁵⁶ An article of manufacture includes something made by hand or machine and discrete components of that product.⁵⁷ A design patent protects only ornamental features, and if a claimed design is primarily functional rather than ornamental, a design patent is invalid.⁵⁸ However, design patent law does not preclude a design patent if a claimed functional feature also contains ornamental designs.⁵⁹ In that case, a design patent will protect only the feature's ornamental aspects.⁶⁰

Design patents, unlike utility patents, contain only one claim—the “ornamental design for the article (specifying name) as shown, or as shown and described.”⁶¹ A design patent owner uses several drawings to show the scope of the exclusionary rights in the design patent.⁶² The drawings “must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design.”⁶³ Solid black lines show what a design patent claims, whereas the dashed black lines indicate “visual elemental structure.”⁶⁴

Recent Federal Circuit decisions touched on the article of manufacture requirement.⁶⁵ The Federal Circuit's 2019 decision in *Curver Luxembourg, SARL v. Home Expressions Inc.* reiterated that design patents must be tied to an article of manufacture as opposed to being directed to a design in the abstract.⁶⁶ *Curver Luxembourg* involved a patent titled “Pattern for a Chair,” which claimed an overlapping “Y” design.⁶⁷ The figures in the patent displayed the pattern but did not show the design applied to a chair.⁶⁸ The patent owner noticed that the defendant was manufacturing baskets using the same pattern and filed a complaint in district court, alleging that the defendant's baskets constituted infringement.⁶⁹ The district court dismissed the complaint.⁷⁰ On appeal, the Federal Circuit stated that patents are not to be granted for “designs

⁵⁶ U.S. PATENT & TRADEMARK OFF., MPEP § 1504.01 Statutory Subject Matter for Designs (9th ed. Rev. Oct. 2019).

⁵⁷ *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 435 (2016).

⁵⁸ *Richardson v. Stanley Works, Inc.* 597 F.3d 1288, 1293–94 (Fed. Cir. 2010).

⁵⁹ *Id.* at 1294.

⁶⁰ *Id.*

⁶¹ 37 C.F.R. § 1.153(a) (2021).

⁶² *Id.* § 1.152.

⁶³ *Id.*

⁶⁴ *Id.* Color may be used in special circumstances in a design patent application. *Id.* § 1.84(a).

⁶⁵ *See, e.g., Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1339–1340 (Fed. Cir. 2019).

⁶⁶ *Id.* at 1340.

⁶⁷ *Id.* at 1336–37 fig. 1.

⁶⁸ *Id.* at 1337.

⁶⁹ *Id.* at 1337–38.

⁷⁰ *Id.* at 1338.

disembodied from an article of manufacture.”⁷¹ Further, the court noted that the USPTO directs patent examiners to reject a patent applicant’s claims “not applied to or embodied in an article of manufacture.”⁷² Thus, the scope of the claimant’s patent was limited to the article of manufacture the patent claimed—a pattern *for* a chair.⁷³

After the Federal Circuit decided *Campbell Soup Co.*, the court heard an appeal of a design patent application rejection for an “ornamental design for a lip implant.”⁷⁴ In *In re Sugisil, L.L.P.*, the USPTO had rejected the applicant’s claim, reasoning that the overall shape of the article of manufacture was anticipated by a similar-looking art tool, a stump.⁷⁵ The patent owner appealed, arguing that the USPTO improperly cited the prior art as it disclosed an entirely different article of manufacture.⁷⁶ The Federal Circuit agreed with the patent owner and noted 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.”⁷⁷ Thus, the court reversed the USPTO’s decision and held that the claimed design patent *was* limited to lip implants.⁷⁸

The Supreme Court of the United States established the basic design patent infringement test in *Gorham Co. v. White*.⁷⁹ The test evaluates the similarity between designs through the “eye of an ordinary observer, giving such attention as a purchaser usually gives.”⁸⁰ Infringement is established if the designs are so similar that the ordinary observer would be deceived.⁸¹ The *Gorham* Court established that an “ordinary observer” is not an expert in the field but rather a person of “ordinary acuteness,” observing the design in the way an “ordinary [person]” would.⁸² The Federal Circuit later clarified that while the *Gorham* “ordinary observer” test is the only test for design patent infringement, the ordinary observer may be informed by prior art if a design patent and the alleged infringing design at issue are not “plainly dissimilar.”⁸³ The court noted that

⁷¹ *Id.* at 1340.

⁷² *Id.* at 1341 (quoting U.S. PATENT & TRADEMARK OFF., MPEP § 1504.01 Statutory Subject Matter for Designs (9th ed. Rev. Oct. 2019)).

⁷³ *Id.* at 1336.

⁷⁴ *In re SurgiSil, L.L.P.*, 14 F.4th 1380, 1381 (Fed. Cir. 2021).

⁷⁵ *Id.* See discussion on patent novelty (including anticipation) *infra* note 89.

⁷⁶ *In re SurgiSil*, 14 F.4th at 1381–82.

⁷⁷ *Id.* at 1382.

⁷⁸ *Id.*

⁷⁹ *Gorham Co. v. White*, 81 U.S. 511, 528 (1871). The test in *Gorham Co.* is also used to determine patent anticipation under 35 U.S.C. § 102. *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239 (Fed. Cir. 2009).

⁸⁰ *Gorham Co.*, 81 U.S. at 528.

⁸¹ *Id.*

⁸² *Id.* at 527–28.

⁸³ *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008).

knowledge of prior art could lead an ordinary observer to find significant differences in designs that otherwise are not plainly dissimilar “in the abstract.”⁸⁴

B. *Inter Partes Reviews*

The America Invents Act of 2011 replaced the *Inter Partes* Reexamination process with the *Inter Partes* Review proceeding.⁸⁵ IPRs are trial proceedings conducted by the PTAB in which a petitioner argues that the PTAB should hold one or more patent claims unpatentable.⁸⁶

IPRs resemble courtroom litigation, as they are more adjudicative than examinational.⁸⁷ The IPR process begins when a third party to the patent owner petitions the PTAB to review one or more claims in a patent.⁸⁸ The scope of review deployed in an IPR is limited to unpatentability claims alleging that a patent fails to fulfill the requirements of patent novelty and nonobviousness.⁸⁹ IPRs allow petitioners to support their unpatentability claims through prior art in the form of either patents or printed publications.⁹⁰ The patent owner may file a preliminary response to the petition that either rebuts the unpatentability claim (i.e., “answering” the petition) or disclaims a challenged claim (i.e., the patent owner “gives up” the claim to the patent)—precluding an IPR on that claim.⁹¹ If the PTAB decides that there is a “reasonable likelihood that at least one of the claims challenged in the petition is unpatentable,” the PTAB may institute the review.⁹² Upon institution of the review, the patent owner may file an opposing response.⁹³ Either party may request

⁸⁴ *Id.*

⁸⁵ MUELLER, *supra* note 7 at 710.

⁸⁶ 35 U.S.C. § 316(c); *Id.* §§ 311–19.

⁸⁷ See MUELLER, *supra* note 7 at 703 n.152 (stating that the AIA “converts *inter partes* reexamination from an examinational to an adjudicative proceeding...”).

⁸⁸ 35 U.S.C. § 311(a)–(b). Exceptions to who may petition for an IPR are listed in 37 C.F.R. § 42.101 (2021).

⁸⁹ 35 U.S.C. § 311(b). Patent novelty is described in 35 U.S.C. § 102(a) and asks whether a claimed invention has already been expressed in prior art before the effective filing date of the claimed invention. *Id.* § 102(a). Prior art for this purpose includes if a “claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public,” as well as being described in a published patent or patent application with another inventor named. *Id.* Additionally, for an invention to be anticipated under § 102, each element of the invention must be found in a single prior art reference. See MUELLER, *supra* note 7 at 242. The law of obviousness in patent claims is discussed in Part III., Sections C and D *infra*.

⁹⁰ 35 U.S.C. § 311(b).

⁹¹ 37 C.F.R. § 42.107(a), (e) (2021).

⁹² *Id.* § 42.108(c).

⁹³ *Id.* § 42.120(a).

an oral argument before the PTAB but must specify the issues to be argued.⁹⁴

Once the PTAB has decided on the unpatentability of the patent claims at issue, the PTAB will issue a final judgment.⁹⁵ If desired, a party may appeal the results of the IPR directly to the Court of Appeals for the Federal Circuit.⁹⁶ After the PTAB issues a final written decision and all appeals are terminated, the USPTO issues a certificate reflecting the status of the claims.⁹⁷

C. Law of Obviousness and Design Patents

An invention is obvious if the invention as a whole would be obvious to a person of ordinary skill in the art (“POSITA”) who considered any prior art references that existed before the effective filing date of the claimed invention.⁹⁸ An obviousness inquiry typically involves examining the differences between the available prior art and the invention as a whole.⁹⁹ Courts have regularly applied the obviousness doctrine as part of the “invention” requirement since the United States Supreme Court decided *Hotchkiss v. Greenwood* almost two centuries ago.¹⁰⁰

In *Hotchkiss*, the patent at issue purported to provide an improved method for making knobs for doors, cabinets, and other items.¹⁰¹ The patent claimed the improvement was that the knobs were made from clay or porcelain.¹⁰² Plaintiffs alleged patent infringement, and Defendants countered by claiming that the methods and individual parts of the patent were already well-known.¹⁰³ The *Hotchkiss* Court noted that the only novel part of the invention was the material used to create the knob.¹⁰⁴ According to the Court, the overall arrangement of the invention was

⁹⁴ *Id.*

⁹⁵ 35 U.S.C. § 318(a).

⁹⁶ *Id.* § 141(c). Alternatively, a party could request a rehearing before the PTAB. 37 C.F.R. § 42.71(d) (2019). However, this is reserved for when a party believes that the PTAB has “misapprehended or overlooked” a matter previously submitted to the PTAB in a motion, opposition, reply, or sur-reply. *Id.*

⁹⁷ *Id.* § 42.80 (2021). The certificate will note canceled and unpatentable claims, patentable claims, and new or amended claims. *Id.*

⁹⁸ 35 U.S.C. § 103. Prior art is defined in *supra*, note 5. The Patent Act of 1952 officially codified this provision. *Id.* Section 103 has been amended since its enactment, but the changes were not substantive.

⁹⁹ *Id.*; See *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 14–15 (1966).

¹⁰⁰ See *Hotchkiss v. Greenwood*, 52 U.S. 248 (1850).

¹⁰¹ *Id.* at 264; Making Door and other Knobs of all kinds of Clay used in Pottery and of Porcelain, U.S. Patent No. 2,197 ln.7–11 (issued July 29, 1841).

¹⁰² *Hotchkiss*, 52 U.S. at 264; ’197 Patent ln. 39–43.

¹⁰³ *Hotchkiss*, 52 U.S. at 264.

¹⁰⁴ *Id.* at 265.

already well-known, and the only improvement was the “superiority of the material, which [was] not new.”¹⁰⁵ The Court further noted that the material substitution involved a judgment call, not ingenuity,¹⁰⁶ and thus invalidated the patent.¹⁰⁷

The *Hotchkiss* Court recognized the proposition that novelty alone is not sufficient to acquire a patent.¹⁰⁸ The test for nonobviousness created in *Hotchkiss* required an invention to have more “ingenuity and skill” than that possessed by an “ordinary mechanic acquainted with the business.”¹⁰⁹ The “ordinary mechanic acquainted with the business” standard from *Hotchkiss* established an early form of POSITA.¹¹⁰

The Court later provided guidance on how to apply the Section 103 nonobviousness test in *Graham v. John Deere Co. of Kansas City*.¹¹¹ The Court determined that the analysis of the nonobviousness requirement is a question of law which requires an examination of four factual inquiries, which patent attorneys colloquially call the *Graham* factors:¹¹² (1) “the scope and content of the prior art;” (2) “differences between the prior art and the claims at issue;” (3) “the level of ordinary skill in the pertinent art;” and (4) “secondary considerations [such] as commercial success, long felt but unsolved needs, failure of others, etc. . . . to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”¹¹³ The first three *Graham* factors provide the “background” of an obviousness determination, while the objective indicia of nonobviousness in factor four “may have relevancy” in the determination.¹¹⁴

Because Section 171(b) incorporates Section 102’s novelty requirement and Section 103’s non-obviousness requirement into design patents,¹¹⁵ design patents must also pass an obviousness test to be deemed

¹⁰⁵ *Id.* at 265–66.

¹⁰⁶ *Id.* at 266.

¹⁰⁷ *Id.* at 265.

¹⁰⁸ *Id.* at 255–66.

¹⁰⁹ *Id.* at 267.

¹¹⁰ *Id.*

¹¹¹ *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

¹¹² MUELLER, *supra* note 7 at 405.

¹¹³ *Graham*, 383 U.S. at 17–18.

¹¹⁴ *Id.*

¹¹⁵ Title 35 of the United States Code contains statutes related to patents and is comprised of five parts which establish the USPTO, outline the patentability of inventions, patent rights, the Patent Cooperation Treaty, and the Hague Agreement regarding international registration. 35 U.S.C. “The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.” 35 U.S.C. § 171(b).

valid.¹¹⁶ In applying Section 103 in *Durling v. Spectrum Furniture Co.*,¹¹⁷ the Federal Circuit stated the requirement as: “whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.”¹¹⁸ Explained another way, “whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design.”¹¹⁹ This wording parallels the general obviousness standard outlined in Section 103,¹²⁰ which later became known as the “*Durling* test.”¹²¹

An obviousness inquiry requires analyzing the *Graham* factors, and the *Durling* test is how the first three *Graham* factors are analyzed for design patents.¹²² The starting point of the *Durling* test is to find a primary prior art reference with design characteristics that are “basically the same as the claimed design.”¹²³ After a primary reference is found, other secondary prior art may be combined with the primary reference, provided any secondary references are “so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other.”¹²⁴ To satisfy the *Durling* test, the prior art combination must “create a design that has the same overall visual appearance as the claimed design,” thus serving as the first three *Graham* factors.¹²⁵ While the first three *Graham* factors are analyzed through the *Durling* test, the final factor – objective indicia of nonobviousness – remains the last inquiry into a design patent obviousness inquiry.

¹¹⁶ 35 U.S.C. § 171(b)’s incorporation clause results in design patents needing to pass muster through the requirement of nonobviousness.

¹¹⁷ 101 F.3d 100 (Fed. Cir. 1996).

¹¹⁸ *Id.* at 103.

¹¹⁹ *Id.*

¹²⁰ 35 U.S.C. § 103; *see also supra* text accompanying note 99.

¹²¹ *See Durling*, 101 F.3d 100 (Fed. Cir. 1996). The Federal Circuit refers to the nonobviousness examination for design patents (i.e., the first three *Graham* factors) as the “*Durling* test.” *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275–76 (Fed. Cir. 2021), *cert. denied*, 142 S. Ct. 1129 (2022).

¹²² *Campbell Soup Co.*, 10 F.4th at 1275 (“In the design patent context, we address the first three *Graham* factors by determining whether a designer of ordinary skill would have combined teachings of the prior art to create ‘the same overall visual appearance as the claimed design,’” citing *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)).

¹²³ *Durling*, 101 F.3d at 103 (quoting *In re Rosen*, 673 F.2d 388, 391 (C.C.P.A. 1982)).

¹²⁴ *Id.* (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

¹²⁵ *Id.*

D. Objective Indicia of Non-Obviousness

Objective indicia focus on the claimed invention's market impact rather than technical merit.¹²⁶ Typical evidence of these secondary considerations includes the failure of others to solve the issues reached by the invention, commercial success of the invention, long-felt need for the invention, licensing and acquiescence to the patent, and evidence of the copying of the invention.¹²⁷

To give any weight to objective indicia of nonobviousness, “the evidence of secondary considerations must have a ‘nexus’ to the claims, *i.e.*, there must be a ‘legally and factually sufficient connection’ between the evidence and the patented invention.”¹²⁸ A patentee can achieve this nexus through a rebuttable presumption of nexus or by affirmatively proving the nexus.¹²⁹

Under the Rebuttable Presumption Based Upon Coextensive Product Theory, if a patentee successfully ties the evidence of objective indicia to a specific product and proves that the product shows the claimed invention – a conclusion called “coextensiveness”¹³⁰ – the patentee is entitled to the rebuttable presumption of nexus.¹³¹ Under the Affirmative Proof of Nexus Theory, there is no presumption of nexus absent coextensiveness.¹³² Thus, if the claimed invention is simply a part of a commercially successful product, the patentee will need to show that the claimed invention drove that success.¹³³ If a patent owner can prove that the objective indicia are the “direct result of the claimed invention,” the patent owner is entitled to a factual finding of nexus.¹³⁴

The Federal Circuit articulated the particulars of this nexus framework in its 2019 *Fox Factory* decision.¹³⁵ *Fox Factory* focused on

¹²⁶ MUELLER, *supra* note 7 at 432.

¹²⁷ *Id.* at 432–33.

¹²⁸ *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019) (quoting *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1332 (Fed. Cir. 2019)).

¹²⁹ *Id.* at 1373–74.

¹³⁰ *Id.* at 1371. The Federal Circuit succinctly described the motivation behind the coextensiveness requirement: “[T]he purpose of the coextensiveness requirement is to ensure that nexus is presumed only when the product ‘is the invention disclosed and claimed.’” *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1277 (Fed. Cir. 2021), *cert. denied*, 142 S. Ct. 1129 (2022) (quoting *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1374 (Fed. Cir. 2019)).

¹³¹ *Fox Factory, Inc.*, 944 F.3d at 1373.

¹³² *Id.*

¹³³ *Id.*

¹³⁴ *Id.* at 1373–74 (quoting *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996)).

¹³⁵ *Id.*

utility patents, and until *Campbell Soup Co., Fox Factory* outlined the extent that this nexus framework applied to partial product design patents.

IV. INSTANT DECISION

In *Campbell Soup Co.*, the Federal Circuit reviewed the PTAB's obviousness determination *de novo* and examined the factual findings for substantial evidence.¹³⁶ The court's review evaluated the PTAB's analysis of the *Graham* factors in the nonobviousness inquiry.¹³⁷ After an analysis of all *Graham* factors and the objective indicia of nonobviousness, the patents at issue were deemed obvious over 'D622 and therefore invalid.¹³⁸

A. Primary Prior Art Appearance

Using 'D622 – the prior art presented by the petitioner – the court first applied the *Durling* test to evaluate the first three *Graham* factors.¹³⁹ It placed 'D622 and the patents at issue side-by-side to examine the similarities and argued that the two designs were “nearly indistinguishable.”¹⁴⁰ The court noted that the PTAB's findings regarding the similarity between the designs were supported by substantial evidence.¹⁴¹ As evidence of the similarity, the court pointed specifically to the convex label area that extends forward and the lower can receiving area.¹⁴²

The court agreed with Gamon's assessment that there were visual differences between 'D622 and the patents at issue, but it ultimately decided that the differences were so slight that the designs remained visually similar.¹⁴³ For support, the court pointed out that the PTAB also found the exact visual differences suggested by Gamon, but the PTAB still concluded that 'D622 and the patents at issue had the same overall visual appearance.¹⁴⁴ The court added that Gamon did not challenge the PTAB's finding on this matter.¹⁴⁵ Accordingly, the court affirmed the PTAB's

¹³⁶ *Campbell Soup Co.*, 10 F.4th at 1275.

¹³⁷ *Id.*

¹³⁸ *Id.* at 1279.

¹³⁹ *Id.* at 1275.

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

¹⁴² *Id.* at 1276.

¹⁴³ *Id.* Gamon's visual difference arguments included that 'D622 would require a smaller diameter can than the patents at issue and that a can in 'D622 would sit rearward of a can in the patents at issue. *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ *Id.*

determination that, under the *Durling* test, 'D622 qualified as a primary prior art reference.¹⁴⁶

B. No Presumption of Nexus for Gamon Plus, Inc.

According to the court, the PTAB misunderstood the law and answered the wrong question when it found a presumption of nexus between Gamon's patent claims and the objective indicia of nonobviousness.¹⁴⁷ Initially, in determining coextensiveness with the patents at issue, the PTAB aimed to determine "whether [the] unclaimed features were insignificant to [the] product's ornamental design" (here, the unclaimed rear rails and product sides).¹⁴⁸ However, the court explained that the correct way to categorize the determinative question is "whether the unclaimed features are 'insignificant,' period."¹⁴⁹ The court reasoned that the PTAB failed to address whether the *final product* was the same as the patent claims when it considered only whether features were insignificant to the ornamental design.¹⁵⁰

Further, the court stated that the PTAB erred when it distinguished *Fox Factory* merely because it involved a utility patent.¹⁵¹ The court noted that the PTAB failed to explain its decision to approach a design patent differently, and the court rejected the idea that coextensiveness is found for a design patent if the patent's unclaimed features are *ornamentally* insignificant.¹⁵²

Ultimately, the court concluded that the PTAB's determination that there was a presumption of nexus was unsupported by substantial evidence.¹⁵³ When applying the "correct" legal standard, the court determined that the patents at issue included only minimal aspects of the whole iQ Maximizer product, including the label area, stops, and cylindrical object.¹⁵⁴ The unclaimed features, such as the sides and rails, were significant features integral to the iQ Maximizer's soup dispensing functionality.¹⁵⁵ Thus, the court held that the iQ Maximizer was not coextensive with the claims of the patents at issue.¹⁵⁶ The court stopped

¹⁴⁶ *Id.*

¹⁴⁷ *Id.* at 1276–77.

¹⁴⁸ *Id.* at 1277 (emphasis in original).

¹⁴⁹ *Id.*

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ *Id.* In other words, the Federal Circuit is noting that the features that the design patent claims represent only a small portion of the entire invention, the rest of which is not claimed in the design patent, all relevant in finding coextensiveness. *Id.*

¹⁵⁵ *Id.*

¹⁵⁶ *Id.*

short of holding that there could *never* be a presumption of nexus in design patent cases, noting, “[i]t is, however, hard to envision a commercial product that lacks any significant functional features such that it could be coextensive with a design patent claim.”¹⁵⁷

C. No Nexus-in-Fact for Gamon Plus, Inc.

The court also rejected the PTAB’s finding of a nexus-in-fact.¹⁵⁸ The court acknowledged the evidence that the PTAB relied on to show that commercial success and praise generally involved the patents at issue’s label area,¹⁵⁹ but it pointed out that the features relied on were already known in ’D622 with minor distinguishing features.¹⁶⁰ Therefore, the court determined that Gamon should have shown how the commercial success and praise of the iQ Maximizer arose from those distinguishing features included in the *patents at issue* rather than to the features present in the prior art.¹⁶¹ The court concluded that there was insufficient support to establish a nexus between the patents at issue’s claims and the objective indicia of nonobviousness.¹⁶²

Further, the court rejected the PTAB’s determination that objective indicia do not need to be linked to unique characteristics for design patent cases.¹⁶³ The court reasoned that utility patent cases required a link between unique characteristics and objective indicia and expressly held the same was required for design patents.¹⁶⁴

After this holding, the court then briefly addressed the PTAB’s finding that Trinity copied unique features of the patents at issue.¹⁶⁵ The court found that although there was evidence of copying, it did not by itself overcome the obviousness evidence found from analyzing ’D622.¹⁶⁶

¹⁵⁷ *Id.* at 1277 n.1.

¹⁵⁸ *Id.* at 1277–78.

¹⁵⁹ *Id.* at 1278. To establish commercial success, the PTAB, in part, used an internal marketing study lauding the iQ Maximizer’s label area’s effectiveness. *Id.* In establishing commercial praise, the PTAB cited an industry publication where Campbell’s marketing manager for retail development gave praise to the iQ Maximizer’s label area. *Id.*

¹⁶⁰ *Id.* The differences cited by the court between ’D622 and the patents at issue include: a larger cylindrical object, a different cylindrical object resting point, a taller label area designed to emulate the cylindrical object’s proportions, and one label’s worth of length between the label and cylindrical object. *Id.*

¹⁶¹ *Id.*

¹⁶² *Id.* at 1279.

¹⁶³ *Id.*

¹⁶⁴ *Id.*

¹⁶⁵ *Id.*

¹⁶⁶ *Id.*

V. COMMENT

The holdings in *Campbell Soup Co.* bring the methodology of an obviousness analysis of a design patent more in line with that of a utility patent. The court specifically pointed out this development in methodology by stating that there is no reason to distinguish *Fox Factory* simply because it concerns a utility patent.¹⁶⁷

Understandably, the PTAB wanted to distinguish coextensiveness for utility patents and design patents, given that utility patents and design patents protect fundamentally different subject matter. Design patents protect ornamental designs.¹⁶⁸ Utility patents protect function.¹⁶⁹ While the methodology presented in an obviousness inquiry for a design patent may differ from a utility patent, the underlying analysis involves the same four *Graham* factors and the same statutory guidance of Section 103.¹⁷⁰ The Federal Circuit determined that both design and utility patents exist underneath the same umbrella coextensiveness standard, rejecting the PTAB's stance to the contrary.¹⁷¹ Thus, the Federal Circuit implicitly tied the unclaimed designs closer to the article of manufacture requirement present for both utility and design patents.¹⁷²

The limiting language of Section 171(a) may explain the Federal Circuit's choice: "[the inventor of a new] ornamental design *for an article of manufacture* may obtain a patent therefor"¹⁷³ Another basis for the Federal Circuit's choice exists in 37 C.F.R. § 1.153(a), which requires "[t]he title of the design [to] designate the particular article."¹⁷⁴ The Federal Circuit's decision in *Campbell Soup Co.* situates the case comfortably in the middle of two surrounding Federal Circuit cases which more closely focused on the article of manufacture requirement.¹⁷⁵ In *Curver Luxembourg*, the Federal Circuit disallowed the assertion that a design patent containing a pattern designated for a chair could apply to a basket with the same pattern.¹⁷⁶ Similarly, the *In re Surgisil* court held that the design for a lip implant was limited to the article of manufacture itself, the lip implant.¹⁷⁷ While not explicitly mentioning the article of

¹⁶⁷ *Id.* at 1277.

¹⁶⁸ 35 U.S.C. § 171; *Auto. Body Parts Assoc. v. Ford Global Techs., LLC*, 930 F.3d 1314, 1319 (Fed. Cir. 2019).

¹⁶⁹ 35 U.S.C. § 101.

¹⁷⁰ *See, e.g., Campbell Soup Co.*, 10 F.4th at 1275.

¹⁷¹ *Id.* at 1277.

¹⁷² *See id.*

¹⁷³ 35 U.S.C. § 171(a) (emphasis added).

¹⁷⁴ 37 C.F.R. § 1.153(a) (2021).

¹⁷⁵ *See In re SurgiSil, L.L.P.*, 14 F.4th 1380 (Fed. Cir. 2021); *Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334 (Fed. Cir. 2019).

¹⁷⁶ *Curver Luxembourg*, 938 F.3d at 1341–43.

¹⁷⁷ *In re SurgiSil*, 14 F.4th at 1382.

manufacture, the *Campbell* court required the patentee to link the claimed design to the entire article (the can dispenser) to establish coextensiveness.¹⁷⁸ All three cases hinge on applying the design to the whole article of manufacture.¹⁷⁹

The Federal Circuit's decision to require an analysis of unclaimed features' significance ties together the two surrounding Federal Circuit decisions.¹⁸⁰ The decision strengthens design patents by strictly following Section § 171(a), which disallows patenting designs "in the abstract."¹⁸¹ In addition, this decision implicitly requires a patent owner to link their design more closely to an article of manufacture to invoke the protections afforded by objective indicia of nonobviousness.

While reaffirming its commitment to apply design patents to articles of manufacture, the Federal Circuit has strengthened design patents without raising the difficulty in obtaining design patent protection. *Campbell Soup Co.* and the surrounding design patent decisions merely limit the scope of a design's applicability.¹⁸² Future applicants need only be sure to apply their design to a particular article of manufacture and not try to monopolize a design in the abstract.

If the Federal Circuit allowed patenting an ornamental feature without tying it directly to an article of manufacture, it would stifle design innovation through unnecessary monopolization of mere patterns. For example, if the court allowed the patent owner in *Curver Luxembourg* to patent the overlapping "Y" design in the abstract, the patent owner could potentially assert their exclusionary right to that pattern over any article of manufacture exhibiting that design.¹⁸³ *Curver Luxembourg* stands for the proposition that patentees must tie their design to an article of manufacture. The patent owner in *Campbell Soup Co.* failed to show the Federal Circuit that any commercial success derived from the designs

¹⁷⁸ See *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1277 (Fed. Cir. 2021), *cert. denied*, 142 S. Ct. 1129 (2022).

¹⁷⁹ *In re SurgiSil*, 14 F.4th at 1380; *Campbell Soup Co.*, 10 F.4th at 1277; *Curver Luxembourg*, 938 F.3d at 1334.

¹⁸⁰ See *In re SurgiSil*, 14 F.4th 1380 (Fed. Cir. 2021); *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268 (Fed. Cir. 2021), *cert. denied*, 142 S. Ct. 1129 (2022); *Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334 (Fed. Cir. 2019).

¹⁸¹ See Dennis Crouch, *Federal Circuit Further Eases Path for Obtaining Design Patents*, PATENTLY-O (Oct. 6, 2021), <https://patentlyo.com/patent/2021/10/federal-circuit-obtaining.html> [<https://perma.cc/F2YT-UVST>]; Dennis Crouch, *Federal Circuit Rejects Patenting Designs "in the Abstract"*, PATENTLY-O (Sept. 12, 2019), <https://patentlyo.com/patent/2019/09/federal-patenting-abstract.html> [<https://perma.cc/9DVV-RV9C>].

¹⁸² See *In re SurgiSil*, 14 F.4th at 1380; *Campbell Soup Co.*, 10 F.4th at 1277; *Curver Luxembourg*, 938 F.3d at 1334.

¹⁸³ See *Curver Luxembourg*, 938 F.3d at 1337 fig. 1.

protected in the design patent.¹⁸⁴ *Campbell Soup Co.* supplemented *Curver Luxembourg* by holding that patentees must tie the evidence of commercial success to the claimed designs. *In re SurgiSil* illustrated how the patent at issue's scope was correctly limited by claim language in the patent and bolstered by the PTAB's finding that the article depicted in the figure was a lip implant.¹⁸⁵ *In re SurgiSil* concluded the trilogy of cases by holding that patentees must tie the design to an article of manufacture. The Federal Circuit has sent clear signals for design patents: only arguments tied to the article of manufacture will survive an IPR. Without this requirement, patentees could monopolize patterns across different articles of manufacture. Through the above trilogy, the Federal Circuit ensured that inventors in the United States can continue to fairly innovate designs.

In light of *Campbell Soup Co.*, the Federal Circuit was accused of “exhibit[ing] its misunderstanding of design patents compared to utility patents.”¹⁸⁶ Facially, the decision appears to ignore the critical difference between utility and design patents by removing the significance of the word “ornamental.”¹⁸⁷ The court admits as much when examining the nexus requirement: “In determining coextensiveness, the question is not whether unclaimed features are insignificant *to a product's ornamental design*. The question is instead whether unclaimed features are ‘insignificant,’ period.”¹⁸⁸ However, the court properly attached significance to the unclaimed functional features. A design patent pairs a design to an article of manufacture, which necessarily has a utilitarian purpose.¹⁸⁹ Therefore, it stands to reason that the context of a design patent matters. The patent in *Campbell Soup Co.* claimed the partial design of a label, can, and tabs.¹⁹⁰ These are ornamental elements that are applied to a soup can dispenser, serving the utilitarian purpose of conveniently organizing cans of soup. Because the ornamental elements are necessarily tied to the utilitarian aspect of the dispenser, it is easy to see how it could be construed as the Federal Circuit mixing the two patent types together.

¹⁸⁴ *Campbell Soup Co.*, 10 F.4th at 1279.

¹⁸⁵ *In re SurgiSil*, 14 F.4th at 1382.

¹⁸⁶ Perry Saidman, *In a Breathtaking Opinion, the Federal Circuit Nixes Nexus for Design Patents, Equates them with Utility Patents, and Ignores Strong Evidence of Copying*, DESIGNLAW PERSPECTIVES (Aug. 23, 2021), <https://www.designlawperspectives.com/blog/in-a-breathtaking-opinion-the-federal-circuit-nixes-nexus-for-design-patents-equates-them-with-utility-patents-and-ignores-strong-evidence-of-copying> [<https://perma.cc/83R5-APTH>].

¹⁸⁷ *Campbell Soup Co.*, 10 F.4th at 1277.

¹⁸⁸ *Id.*

¹⁸⁹ *Sport Dimension, Inc. v. Coleman Co., Inc.*, 820 F.3d 1316, 1320 (Fed. Cir. 2016).

¹⁹⁰ *See supra* Figure 1.

Here, the Federal Circuit has not mixed up the patent types, it has merely shown how the two are closely interrelated.

VI. CONCLUSION

The Federal Circuit's decision to link ornamental features with functional features during an obviousness analysis may appear counterintuitive on its face, but it further affirms that a design patent is linked to a useful product. This decision brings the obviousness inquiry for design patents in line with utility patents and recent Federal Circuit jurisprudence. In doing so, the decision helps strengthen design patents by reaffirming the Federal Circuit's position disallowing patenting an ornamental design in the abstract.

By tying the coextensiveness requirement more closely together with the design patent's article of manufacture requirement, the Federal Circuit clarified the standard of coextensiveness by specifying the requirements for design patents. In addition, the decision inherently strengthened the value of objective indicia of nonobviousness by requiring the attachment of evidence to the article of manufacture. Further, *Campbell Soup Co.* lessened the ability to patent designs in the abstract. The holding reflects a more cohesive standard for a complex issue in patent law and brings definiteness to the standard regarding design patents and obviousness. In sum, the Federal Circuit's recipe for design patent success includes no abstract designs but a dash of coextensiveness.