



DESIGN

LAW

2022

Obviousness: Secondary References and Secondary Considerations

Darrell Mottley, Daniel Gajewski

Graham v John Deere (1966)

- 1: Determine background (factual)
 - **determine scope and content of prior art**
 - ascertain differences between prior art and claim
 - resolve level of ordinary skill
 - assess secondary considerations
- 2: Against this background, determine obviousness or nonobviousness (legal)
- *Graham* applies to designs
 - “in view of the statutory requirement that patents for designs must be evaluated on the same basis as other patents, the test of *Graham* must be followed.” *In re Nalbandian* (CCPA 1981)

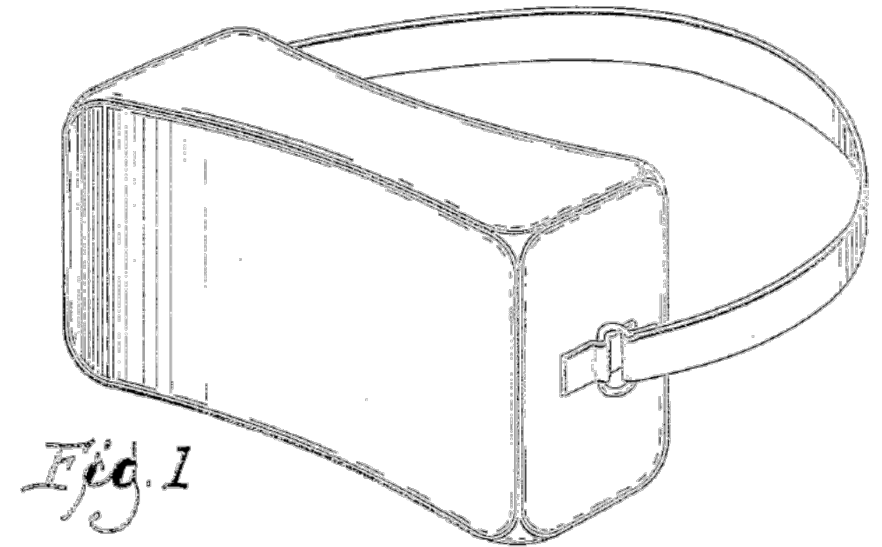
Obviousness in Design Law

- The familiar standard:
 - Step 1: Identify a single reference that has “basically the same” design characteristics as the claimed design
 - Step 2: Modify it using secondary references “to create a design that has the same overall visual appearance as the claimed design”

In re Glavas (1956)

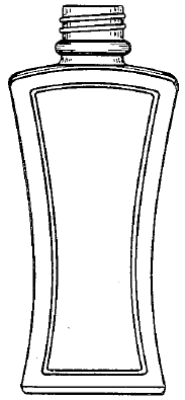
Judges: Ambrose O'Connell, Noble Johnson, Eugene Worley, William Cole, Joseph Jackson

- “The question in design cases is ... whether [the references] are **so related** that the appearance of certain ornamental features in one would suggest the application of those features to the other.”
- “the **nature of the articles involved** is a definite factor in determining whether the proposed change involves invention.”
- “the art from which a patent is drawn does not necessarily preclude its citation as a reference but ‘it does **reflect on the question of remoteness of suggestion** between what it discloses and what the applicant discloses.’”

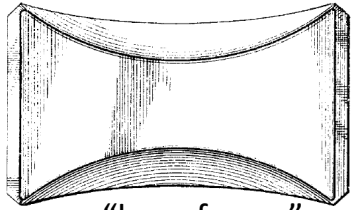


claimed design
“float”

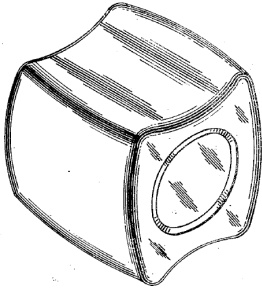
In re Glavas



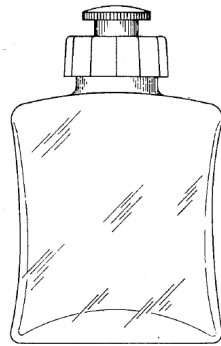
“glass bottle”



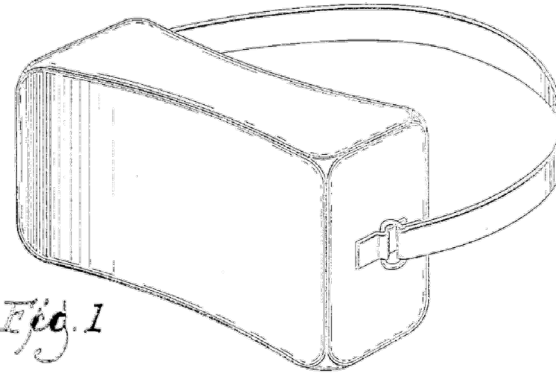
“bar of soap”



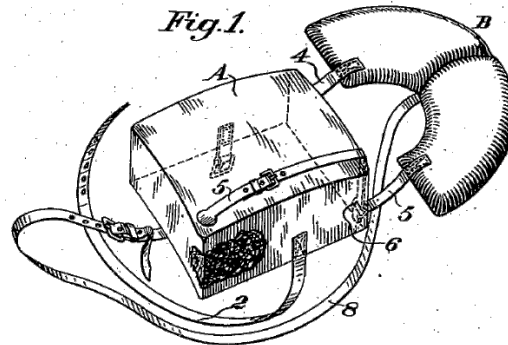
“razor blade sharpener”



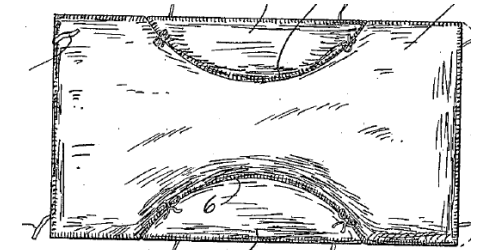
“bottle”



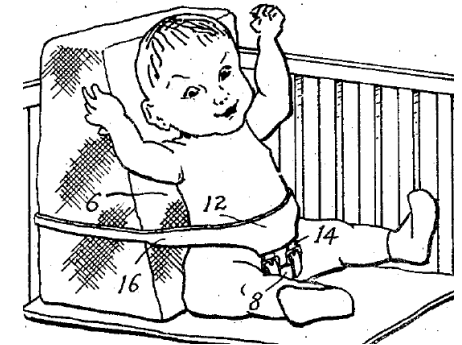
claimed design
“float”



primary reference
“life preserver”



“pillow”

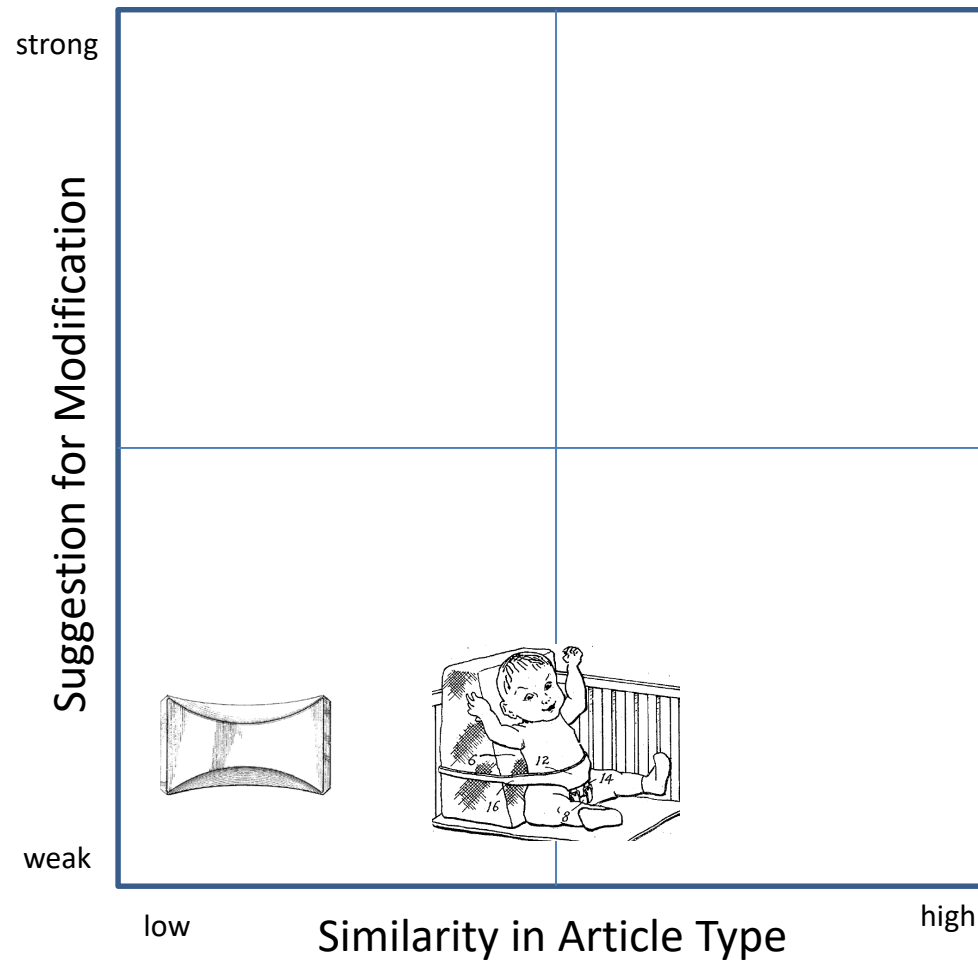


“baby supporter”

“If his problem were one of designing a float for swimmers, he would not be likely to turn to bottles, soap or razor blade sharpeners for suggestions”

None “closely approach[es] the claimed design] in general appearance”

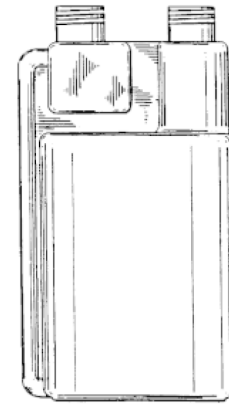
Plausible that they are related articles, but
“unable to find anything ... which would suggest modifying the Armstrong float in such a manner as to produce appellant's design”



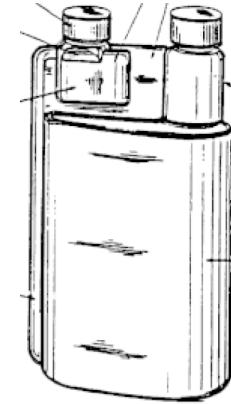
In re Borden (1996)

Judges: William Bryson, Randall Rader, Byron Skelton

- “In order for secondary references to be considered ... **there must be some suggestion** in the prior art to modify the basic design with features from the secondary references.”
- “Like the Bettix container, the Freshn Tea and Costa containers are dual-chamber designs.... [T]he [Freshn Tea] brochure also **lists other examples of custom variations**, including ‘neck changes’ and changes in the ‘size of the chamber,’ precisely the types of variations on the Bettix design that are embodied in the Borden container.”



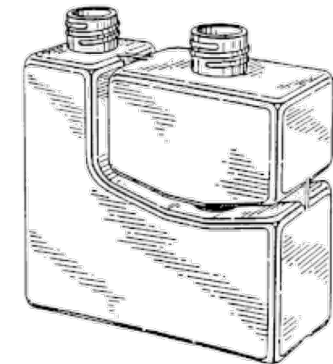
claimed design
“Borden”



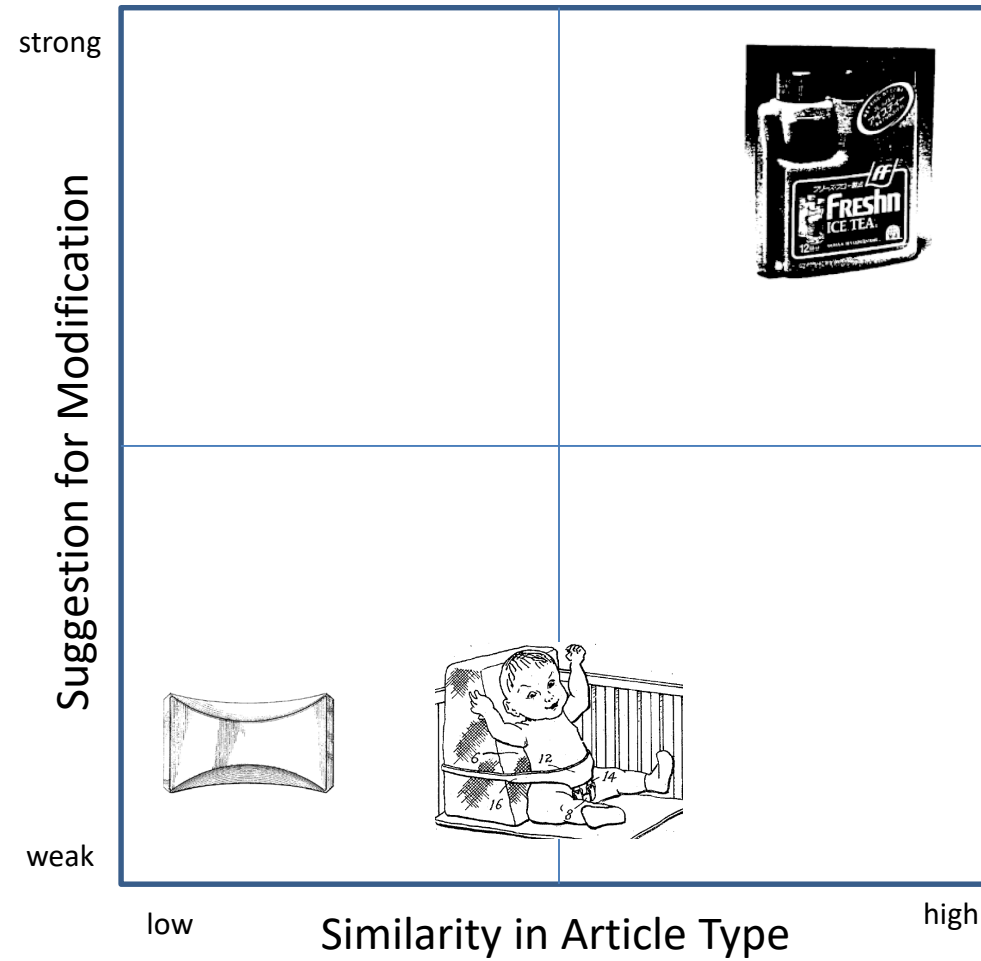
primary reference
“Bettix”



secondary reference
“Freshn Tea”



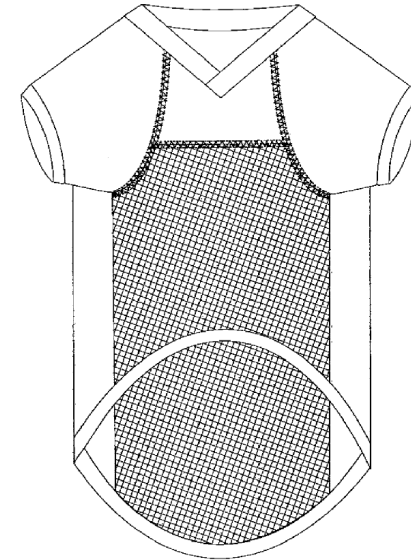
secondary reference
“Costa”



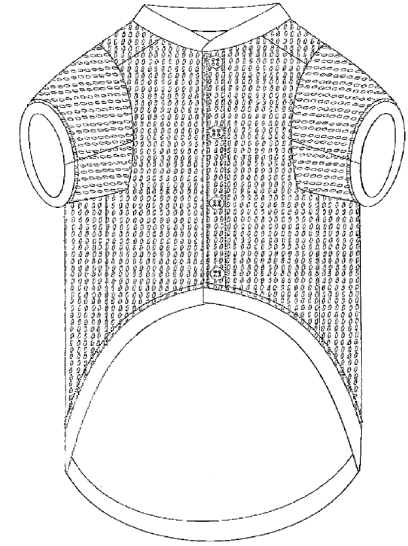
MRC v Hunter (2014)

Judges: Sharon Prost, Randall Rader, Raymond Chen

- “it is the mere similarity in appearance that itself provides the suggestion that one should apply certain features to another design.”
- “the secondary references ... were not furniture, or drapes, or dresses, or even human football jerseys; they were football jerseys designed to be worn by dogs.”



MRC design 1



MRC design 2



Primary reference
“Eagles”



Secondary reference
“V2”



secondary reference
“Sporty K9”

MRC v Hunter

- MRC Court did take factors into account other than “mere similarity in appearance”:
 - secondary references were “closely akin to the claimed design”
 - “not taken from unrelated references”
 - secondary references were “football jerseys designed to be worn by dogs”



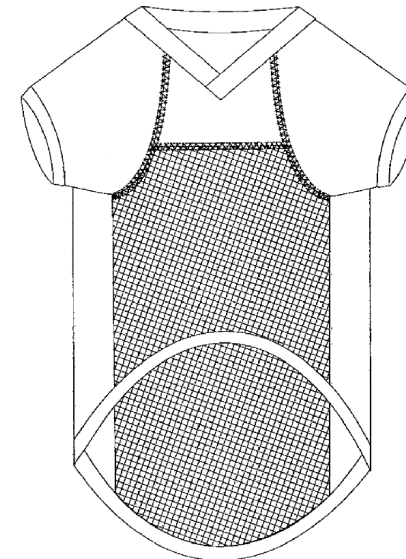
Primary reference
“Eagles”



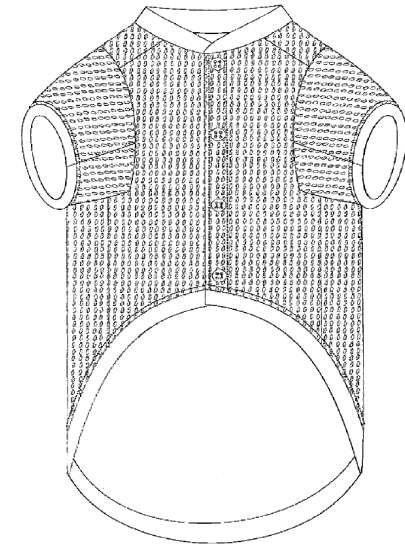
Secondary reference
“V2”



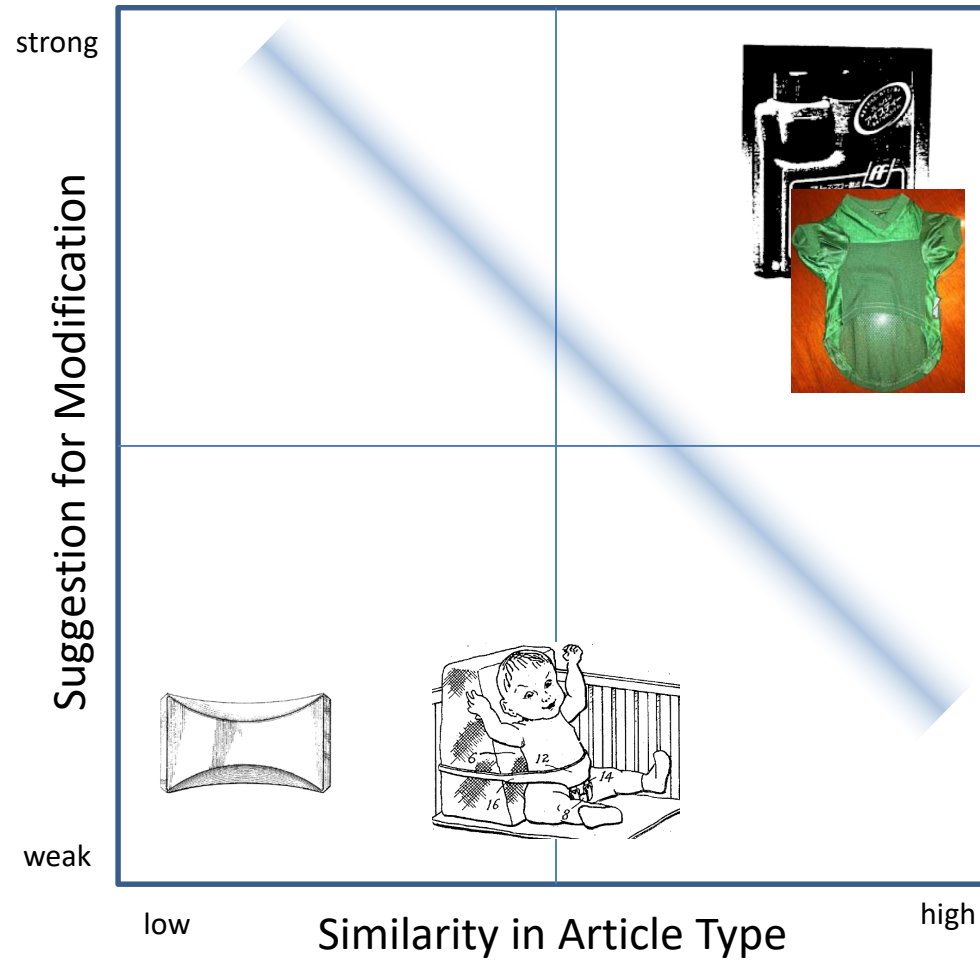
secondary reference
“Sporty K9”



MRC design 1



MRC design 2



Summary

- Suggestion for modification
 - *Glavas*: do “certain ornamental features” of one “suggest [their] application” to the other?
 - *Borden*: secondary references had low similarity in appearance, but explicit suggestions for modification
 - *MRC*: the “mere similarity in appearance” of the references provided the needed suggestion for modification
- Relatedness of art
 - All of *Glavas*, *Borden*, and *MRC* consider how closely-related the secondary references are to the primary references

**DESIGN
LAW
2022**

CAMPBELL SOUP COMPANY v. GAMON PLUS, INC.

Secondary Considerations ?

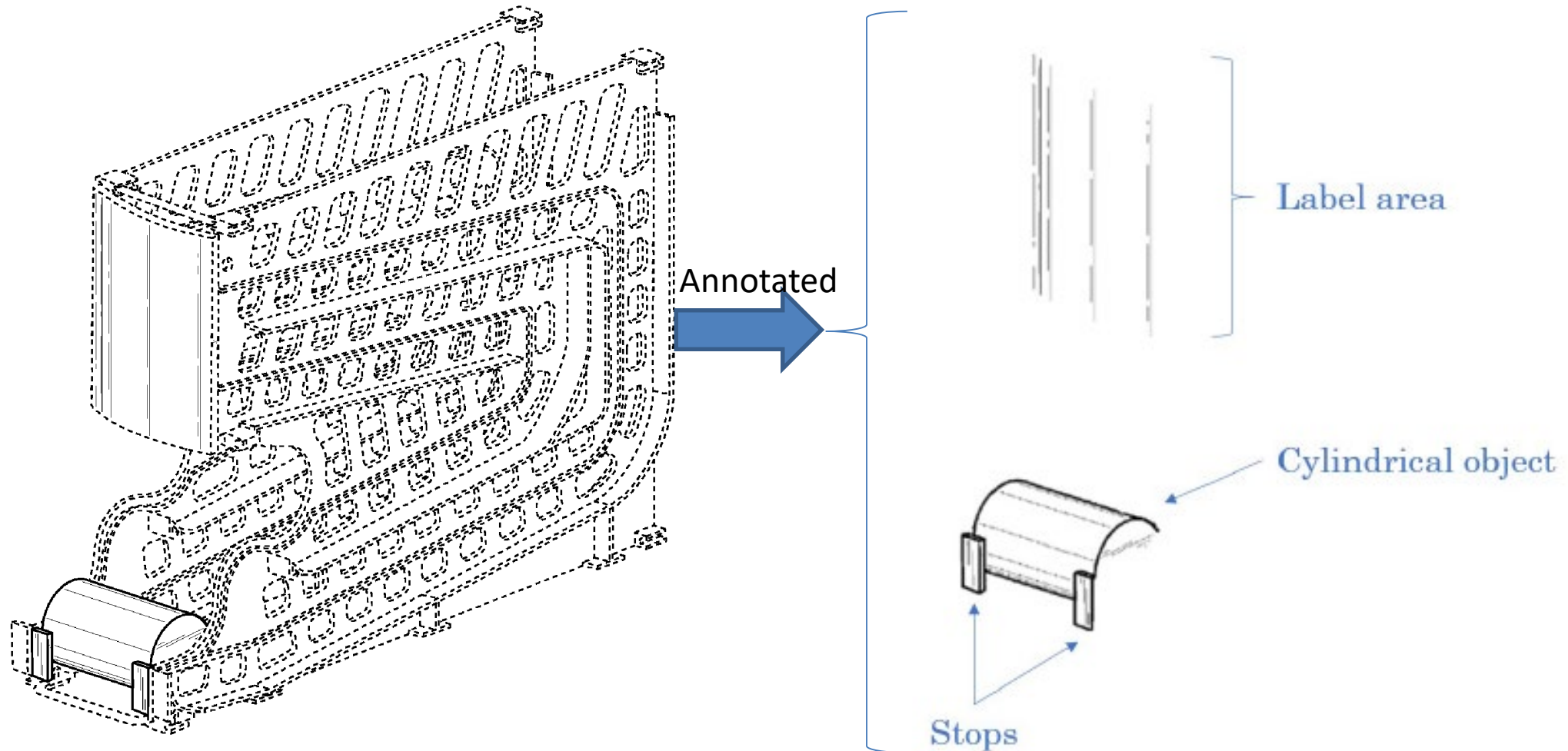
Campbell Soup Company v. Gamon Plus, Inc., 10 F.4th 1268 (2021)

Campbell Soup Co. v. Ganom Plus (Campbell II)



Andy Warhol
Campbell's Soup Cans
1962

Gamon Design Patent D612646



Linz D405622 (Primary Prior Art Reference)



US000405622S

United States Patent [19]
Linz

[11] **Patent Number:** **Des. 405,622**
[45] **Date of Patent:** **Feb. 16, 1999**

[54] **DISPLAY RACK**

[76] Inventor: **Arthur W. Linz**, 14 Deer Trail,
Boonton Township, NJ, 07005

[**] Term: **14 Years**

[21] Appl. No.: **78,857**

[22] Filed: **Nov. 5, 1997**

[51] **LOC (6) Cl.** **06-04**

[52] **U.S. Cl.** **D6/408**

[58] **Field of Search** D6/408, 449, 509-511,
D6/466-468, 515, 517, 475, 476, 473;
312/45, 36, 128; 211/184, 189, 195, 134,
135, 59.2, 59.3, 59.4, 74; 206/736, 738,
739, 740, 745, 750-754, 756, 761; 221/123,
282, 286

[56] **References Cited**

U.S. PATENT DOCUMENTS

D. 290,790 7/1987 Nathan et al. D6/408
D. 342,420 12/1993 Ienna D6/517
D. 380,113 6/1997 Byrd D6/515
2,888,145 5/1959 Knott et al. 211/59.2
4,356,923 11/1982 Young et al. 211/184 X
4,474,297 10/1984 Zucker 312/45 X

5,645,176 7/1997 Jay 211/59.2

Primary Examiner—James Gandy
Assistant Examiner—Linda Brooks
Attorney, Agent, or Firm—Lerner, David, Littenberg
Krumholz & Mentlik

[57] **CLAIM**

The ornamental design for a display rack, as shown and described.

DESCRIPTION

FIG. 1 is a perspective view of a display rack showing my new design;

FIG. 2 is a front elevational view;

FIG. 3 is a right side elevational view, the left side elevational view being a mirror image thereof;

FIG. 4 is a top plan view;

FIG. 5 is a bottom plan view; and,

FIG. 6 is a perspective view of a second embodiment of FIG. 1, the only difference being the addition of three adjoining display racks, it being understood that all the other surfaces are the same as shown in the embodiment of FIG. 1. The broken line showing of environmental structure as well as the broken lines which define the boundaries of the claimed design form no part thereof.

1 Claim, 4 Drawing Sheets

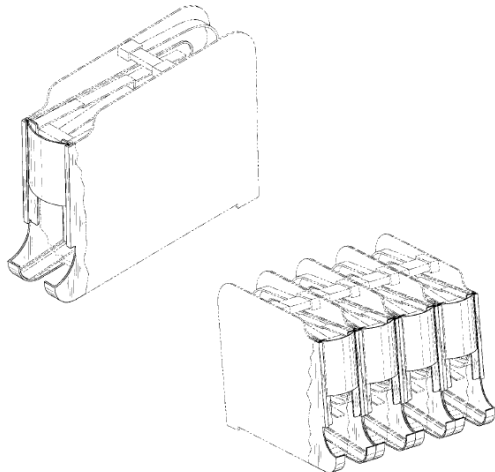
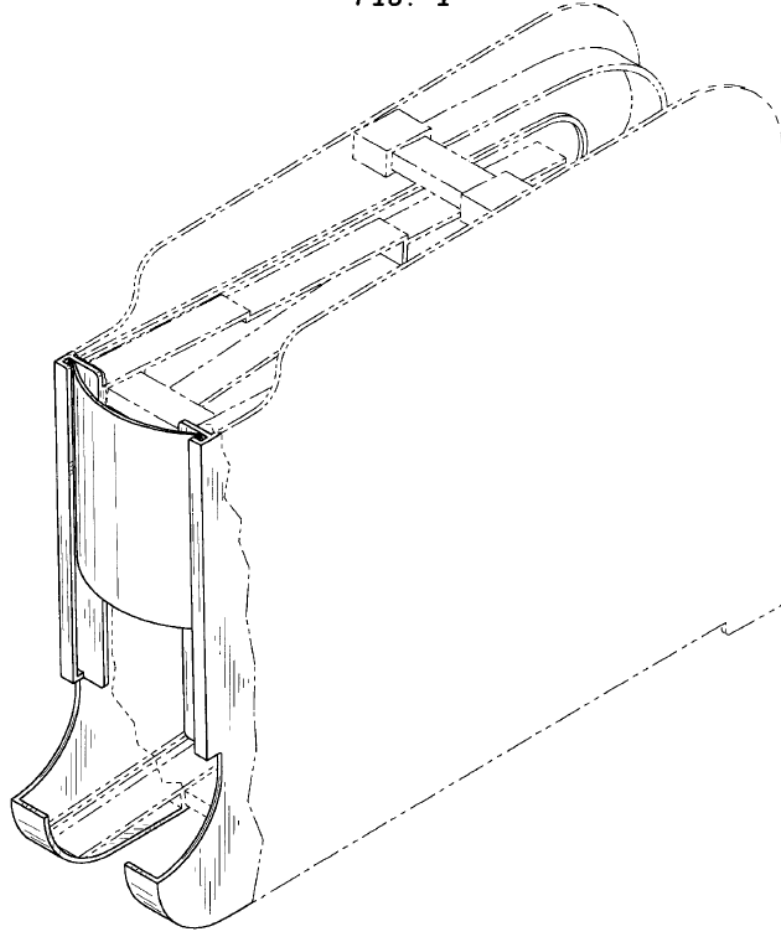
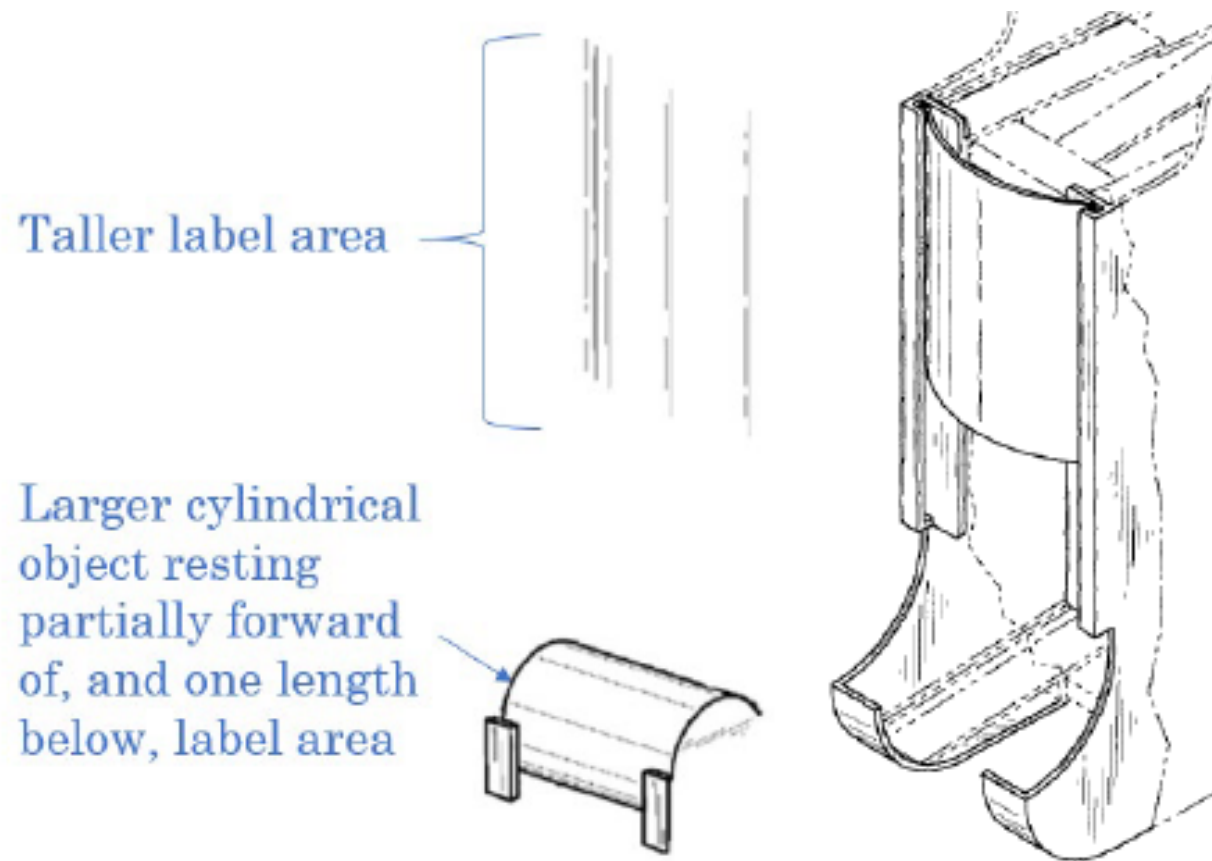


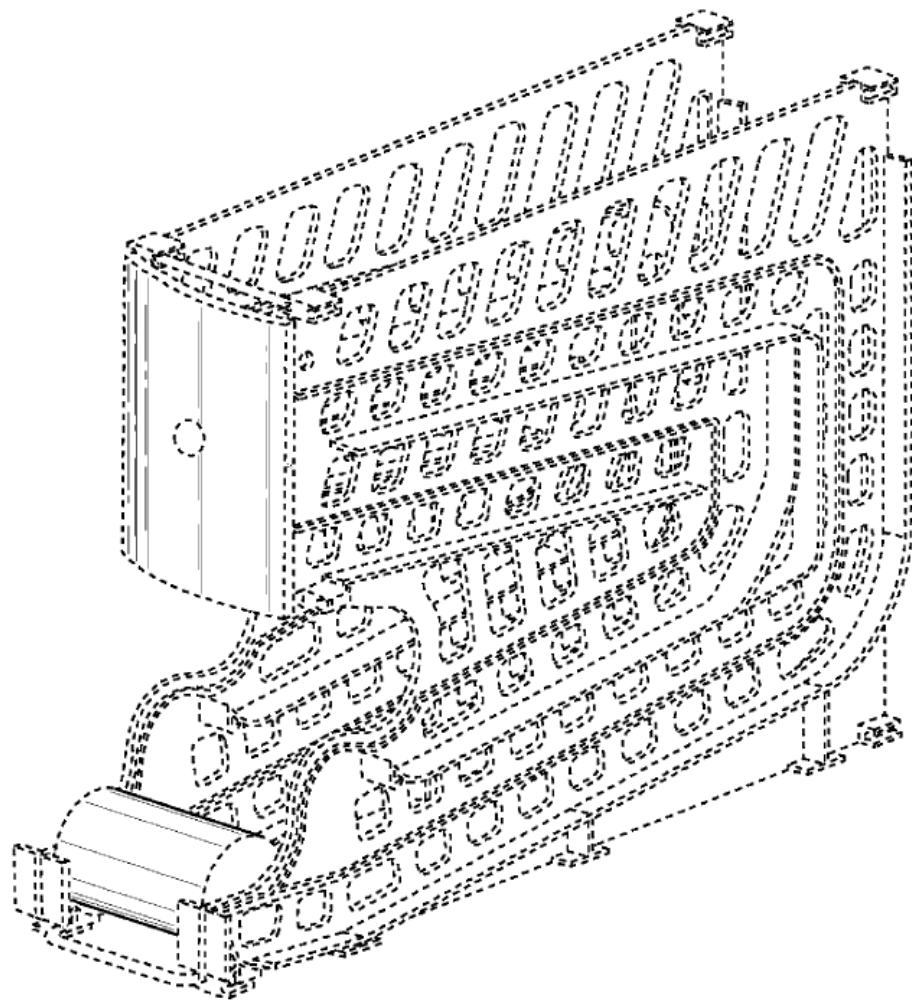
FIG. 1



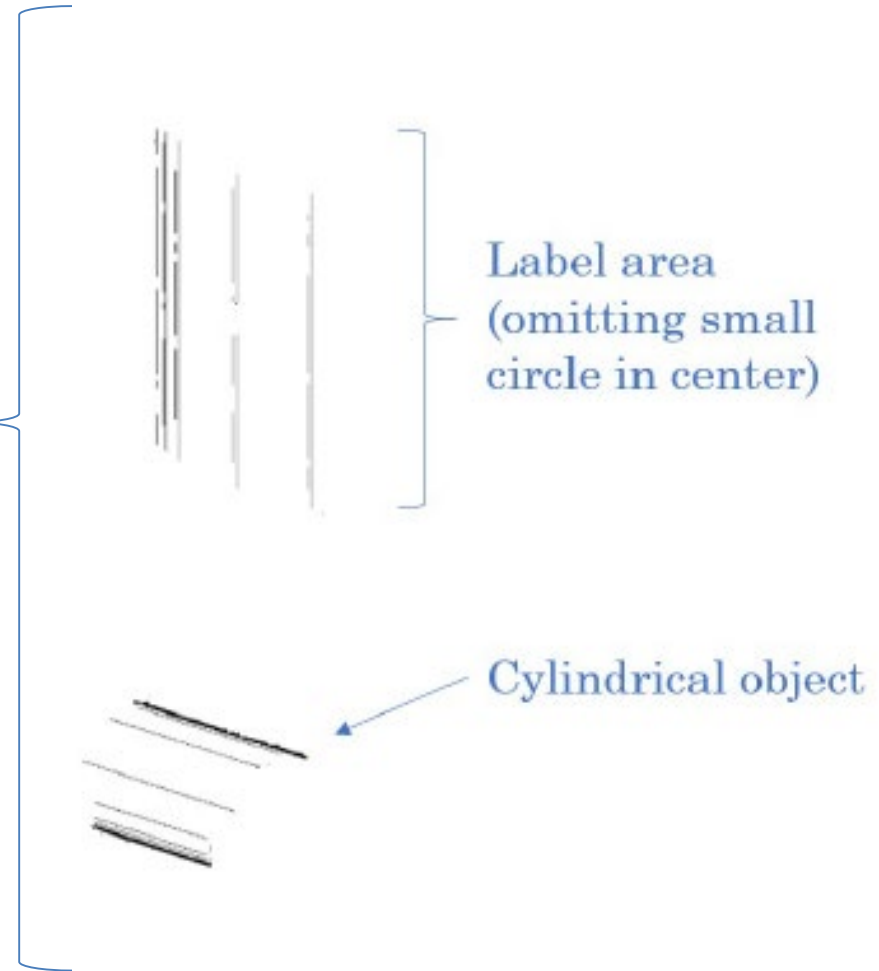
'646 Patent Annotated and Linz



Gamon Design Patent D621645



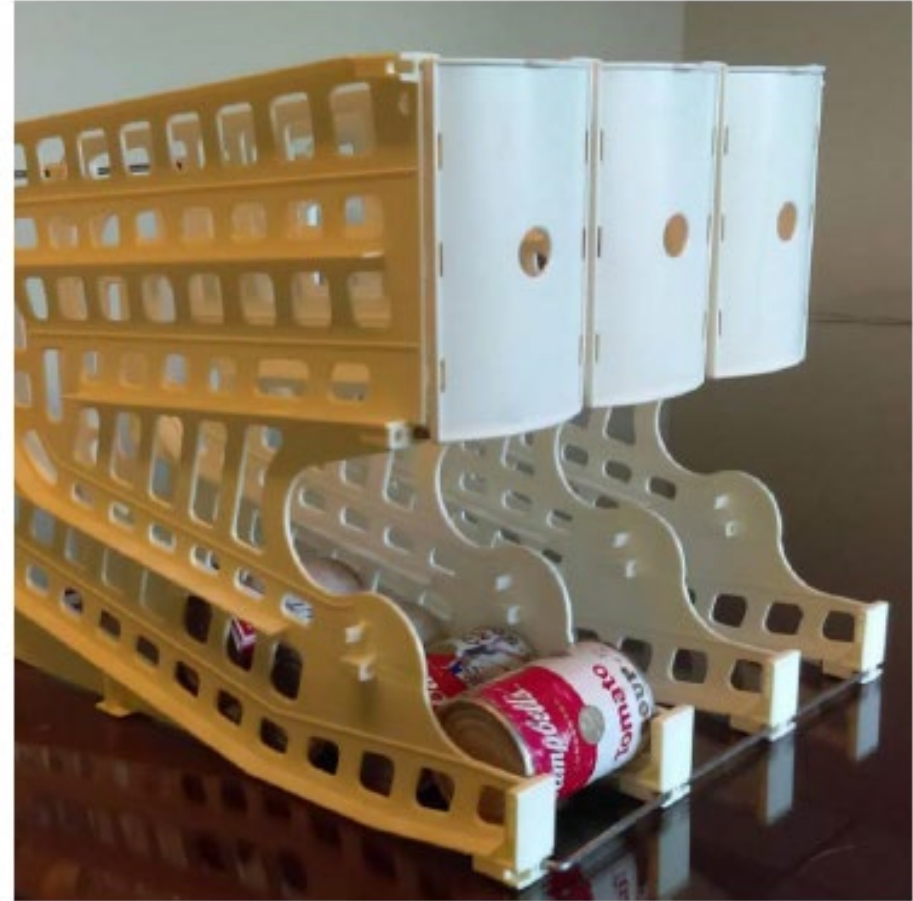
Annotated



Commercial Embodiment



iQ Maximizer Gravity Feed Dispenser in-use at Store



iQ Maximizer Gravity Feed Dispenser

Commercial Success

- \$31 million worth of iQ Maximizers sold to Campbell.
- Campbell installed the iQ Maximizers in about 17,000 stores nationwide.
- Campbell attributed increased soup sales in part to the iQ Maximizer.
 - “Condensed soup also benefited from the additional installation of gravity-feed shelving systems and increased advertising.”
- Dispenser’s label area for “making it easier for consumers to locate specific flavors.”

Fed. Circuit Commercial Success Rubric

- Rebuttal Presumption of Nexus



If no Presumption

- Must Establish Nexus-in-Fact

Fed Circuit Commercial Success Rubric

The Presumption of Nexus

- We presume a nexus if the objective indicia evidence is tied to a specific product that is “coextensive” with the claimed invention, meaning that the product “is the invention disclosed and claimed.”
- *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1374 (Fed. Cir. 2019)
- *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988).
- Both Opinions pertain to utility patents

But Coextensiveness in Federal Cir. Fox Factory, Inc., Utility Case

- The degree of correspondence between a product and a patent claim falls along a **spectrum**. At one end of the **spectrum** lies perfect or near perfect correspondence.
 - *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1374 (Fed. Cir. 2019)
- At other end lies no or very little correspondence, such as where “the patented invention is only a component of a commercially successful machine or process.” (*Id.*, quoting *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392)

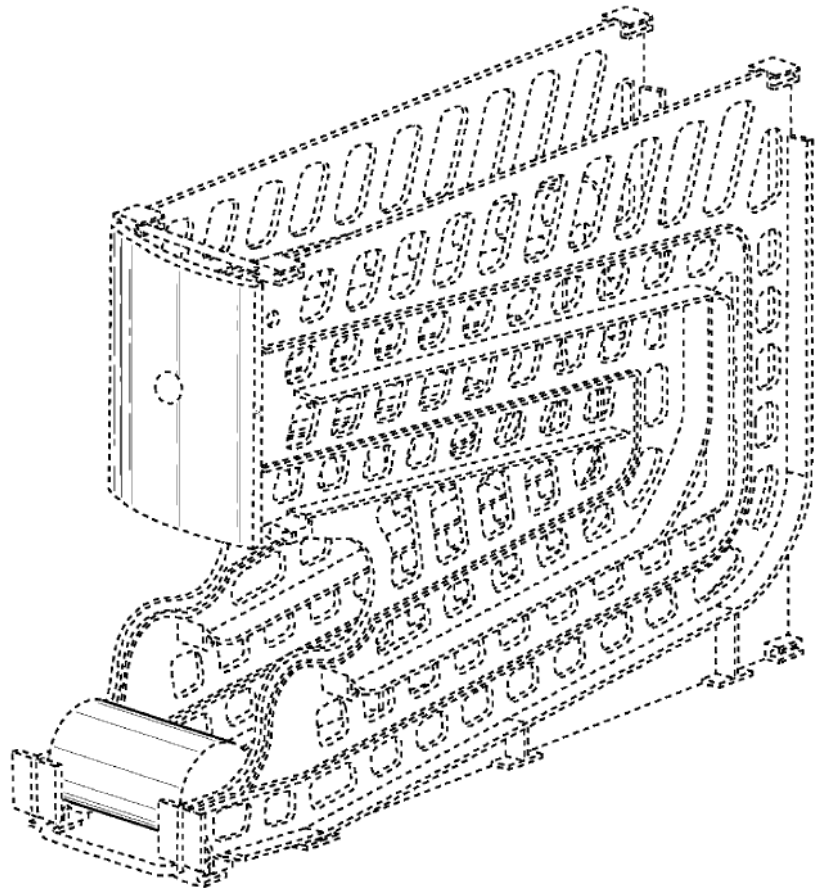
PTAB Decision on Remand

- Gamon Proved Rebuttal Assumption
- We find that the portions of the display rack that a consumer would observe are the most significant portions of the display rack in terms of ornamental design.
- The front portions of the display rack are the most significant features.
- The *unclaimed* rearward rails and side portions are not prominent ornamental features to a consumer, or to a designer of ordinary skill
 - The unclaimed portions of the display rack are “insignificant” to the ornamental design

Fed. Cir. Commercial Success for Gamon Patent No Presumption of Nexus Established

- No Presumption of Nexus
- Board erred in considering the product's ornamental features for coextensiveness
- “[T]he purpose of the coextensiveness requirement is to ensure that nexus is presumed only when the product *“is the invention disclosed and claimed.”*”
- The question is whether unclaimed features are “insignificant,” period. (re Functional significance features)
- Board simply did not answer the relevant question: whether the **iQ Maximizer** *“is the invention.”*
- Opinion by Chief Judge Moore

Patent Side-by-Side v. Commercial Embodiment



Gamon Design Patent D621645



iQ Maximizer Gravity Feed Dispenser

Fed. Cir. Coextensiveness in Design Cases after Campbell II

- The coextensiveness requirement **does not depend on the type of patent at issue.**
- We reject the proposition that a product satisfies the coextensiveness requirement in the design patent context merely if its unclaimed features are *ornamentally* insignificant.
- We do not go so far as to hold that the presumption of nexus can never apply in design patent cases. It 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. (Fn 1)

Fed. Circuit Commercial Success Rubric

Can Establish Nexus-in-Fact

- A patentee may establish nexus absent the presumption by showing that the objective indicia are the “direct result of the unique characteristics of the claimed invention,” *Fox Factory*, 944 F.3d at 1373–74 (quoting *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996)),
- Rather than a feature that was “known in the prior art,” *Ormco Corp. v. Align Technology, Inc.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006).

Gamon - No Nexus-in-Fact

- The only features the Board found that distinguished the claimed designs from the prior art Linz design were:
- (1) a larger cylindrical object,
- (2) a resting point of the cylindrical object that is partially forward of the label area,
- (3) a taller label area that mimics the proportions of the cylindrical object; and
- (4) spacing equal to one label length between the label and the cylindrical object.

Nexus-in-Fact in Design Cases after Campbell II

- We therefore hold that, **as in the utility patent context**, objective indicia must be linked to a design patent claim's unique characteristics.

Other Secondary Considerations

- Evidence of Copying proved by Gamon
- But, Fed. Circuit rules that evidence of copying does not overcome the strong evidence of obviousness in view of Linz.

Takeaways

- Proof of Commercial Success increasingly more difficult
- Federal Circuit focus on the “invention” seems to be on “functional features” instead of ornamental aspects to determine coextensiveness