



Memorandum

October 13, 2021

Decision *In re SurgiSil* Limits Available Prior Art for Design Patents

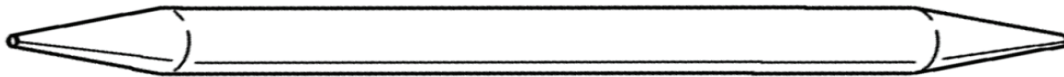
Introduction

On October 4th, the Federal Circuit held in *In re SurgiSil*¹ that a design patent application directed to a “lip implant” was not anticipated by an art tool called a “stump” because it was not the same *article of manufacture*² recited in the claim of the design patent application. In other words, even though the claimed design for a lip implant and the stump have a similar shape, an ordinary observer would not be deceived into believing the two designs are substantially the same.

The Patent at Issue

35 U.S.C. §171 says “Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor” In design patents, the formalistic claim recites, “I/We claim: an ornamental design for the [article of manufacture] shown and described herein.”³

SurgiSil sought design patent protection for the “ornamental design for a lip implant as shown and described.” See below.



Representative Figure from SurgiSil's Design Patent Application

¹ *In re SurgiSil L.L.P.*, No. 2020-1940, 2021 WL 4515275 (Fed. Cir., Oct. 4, 2021).

² The Supreme Court in *Samsung Electronics Co. v. Apple Inc.* held that an “article” is just “a particular thing,” and “manufacture” means “the conversion of raw materials by the hand, or by machinery, into articles suitable for the use of man” and “the articles so made.” The Court concluded that an “article of manufacture” is “simply a thing made by hand or machine.” *Samsung Electronics Co. v. Apple Inc.*, 137 S. Ct. 429 (2016).

³ The Manual of Patent Examining Procedure (M.P.E.P.) requires that the title and claim must correspond. M.P.E.P. §1503.01(I).

During prosecution, the patent examiner rejected the claim as unpatentable under 35 U.S.C. §102 as anticipated by (lacking novelty in view of) an art tool called a “stump,” which is made of “tightly spiral-wound, soft gray paper” and used “for smoothing and blending large areas of pastel or charcoal.” *See below.*



Alleged Prior Art Stump

The patent examiner cited the seminal *Gorham v. White*⁴ case as support that the ordinary observer test for anticipation does not require the designs for comparison be from analogous arts or purchased in the same context. SurgiSil appealed, and the Patent Trial and Appeal Board (PTAB) affirmed the patent examiner’s rejection. SurgiSil appealed again.

The Federal Circuit reversed the PTAB, holding that it erred as a matter of law that the claimed design is not limited to the particular article of manufacture identified in the claim. The court anchored its holding in the text of §171, *Gorham v. White*, and its 2019 *Curver Luxembourg*⁵ decision. In *Gorham v. White*, the Supreme Court explained that Congress authorized the grant of design patents for “not an abstract impression, or picture, but an aspect given to those objects mentioned in the acts.” Thus, design protection is not available for designs *per se* – it is available for designs applied to an article of manufacture identified in the claim. In *Curver Luxembourg*, the Federal Circuit held that a design patent that claimed “a pattern for a chair” was limited to the inclusion of the claimed pattern on a chair and did not prevent a competitor from using the same pattern on a basket. The court thus extended *Curver Luxembourg* (an infringement case) to the reciprocal invalidity context (recall the maxim “that which infringes, if later, anticipates, if earlier”).

Summary

This decision marks a significant departure from long-time USPTO policy that for rejections under §102, “Anticipation does not require that the claimed design and the prior art be from analogous arts.”⁶ By narrowing the universe of available prior art, *SurgiSil* makes it easier for applicants to obtain design patent protection⁷ and to defend against challenges to a design patent’s validity in litigation or during post-grant proceedings before the PTAB.

⁴ 81 U.S. 511 (1871).

⁵ *Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1336 (Fed. Cir. 2019).

⁶ M.P.E.P. §1504.02 (citing *In re Glavas*, 230 F.2d 447, 450 (CCPA 1956)).

⁷ *Keep in mind, most design patents issue without having overcome any prior art rejections anyway. See <https://bigpatentdata.com/2019/04/design-patent-rejections-update/>; see also <https://patentlyo.com/patent/2010/01/design-patent-rejections.html>.*

However, *SurgiSil* and *Curver Luxembourg* are two edges of the same sword. While *SurgiSil* makes it easier for applicants to avoid prior art by claiming designs for a more specific article of manufacture, *Curver* limits the scope of protection to designs for the article of manufacture recited in the claim. Accordingly, applicants should carefully choose the appropriate article of manufacture at filing based upon the products for which protection is sought, as well as their understanding of any similar prior art.

Applicants should also provide support in the specification for foreseeable amendments to the title during prosecution, and should consider strategic continuation applications to obtain different claim scope by varying the article of manufacture recited in the claim. This is particularly true for design applications claiming priority to foreign design applications, where the original title (and thus, the article of manufacture recited in the claim) may have been influenced by naming rules in certain countries that require applicants to utilize a title based on the Locarno classification of the particular goods to which the design applies.

This memorandum is not intended to provide legal advice, and no legal or business decision should be based on its content. Questions concerning issues addressed in this memorandum should be directed to:

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