

PTAB Strategies and Insights

August 2021



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The PTAB Strategies and Insights newsletter provides timely updates and insights into how best to handle proceedings at the USPTO. It is designed to increase return on investment for all stakeholders looking at the entire patent life cycle in a global portfolio.

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- For Partial Design Patents and Utility Patents Alike, Reliance on Objective Indicia Requires Evidence of a Nexus to the Unique Claimed Features
- Federal Circuit Remands for Board's Improper Use of Extrinsic Evidence During Claim Construction
- Availability of Prior Art Under Pre-AIA Section 102(e) Based on Changing Inventorship

We welcome feedback and suggestions about this newsletter to ensure we are meeting the needs and expectations of our readers. So if you have topics you wish to see explored within an issue of the newsletter, please reach out to me.

Best,

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FOR PARTIAL DESIGN PATENTS AND UTILITY PATENTS ALIKE, RELIANCE ON OBJECTIVE INDICIA REQUIRES EVIDENCE OF A NEXUS TO THE UNIQUE CLAIMED FEATURES

By: [Deirdre M. Wells](#)

In [*Campbell Soup Co. v. Gamon Plus, Inc.*](#),^[i] the Federal Circuit considered the Patent Trial and Appeal Board's application of objective indicia to design patent claims. The Board had found that the prior art has the same overall visual appearance as the claimed designs, but that it is outweighed by objective indicia of nonobviousness. The Court, however, found that substantial evidence did not support either the Board's presumption of nexus or the Board's finding of nexus. The Court thus reversed the Board's decision and held that the challenged claims were unpatentable.

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FEDERAL CIRCUIT REMANDS FOR BOARD'S IMPROPER USE OF EXTRINSIC EVIDENCE DURING CLAIM CONSTRUCTION

By: [Jason D. Eisenberg](#)

In [*Seabed Geosolutions \(US\) Inc. v. Magseis FF LLC*](#), the Federal Circuit vacated and remanded an inter partes review decision for Patent Owner. The Court held that the Patent Trial and Review Board failed to perform the proper claim construction when the Board unnecessarily relied on extrinsic evidence that contradicted the intrinsic record.

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IN CASE YOU MISSED IT...

Director [Jon E. Wright](#) and Counsel [James R. Hietala](#) authored the *Westlaw Today* article "Availability of Prior Art Under Pre-AIA Section 102(e) Based on Changing Inventorship," which analyzes inventorship group applications of Section 102(e) in several cases.

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In *Seabed Geosolutions (US) Inc. v. Magseis FF LLC*, the Federal Circuit vacated and remanded an *inter partes* review decision for the Patent Owner. The Court held that the Patent Trial and Review Board failed to perform the proper claim construction when the Board unnecessarily relied on extrinsic evidence that contradicted the intrinsic record.

The Court first noted that the Board construed “geophone internally fixed within [the] housing” to require a non-gimbaled geophone. And that the Board found, based entirely on extrinsic evidence, that “fixed” had a special meaning in the relevant art at the time of the invention: “not gimbaled.”

The Court disagreed with this approach stating, “we begin with the intrinsic evidence, which includes the claims, written description, and prosecution history.” Slip Op. at 3. “If the meaning of a claim term is clear from the intrinsic evidence, there is no reason to resort to extrinsic evidence.” *Id.* at 4. “Extrinsic evidence may not be used ‘to contradict claim meaning that is unambiguous in light of the intrinsic evidence.’” *Id.*

The Court construed “fixed” in the phrase “geophone internally fixed within [the] housing” to carry its ordinary meaning, “i.e. attached or fastened.” *Id.* They supported their interpretation using the claim language (*id.* at 4 “The plain language, therefore, supports interpreting ‘internally fixed within’ to mean mounted or fastened inside.”), the specification (*id.* 4-7, e.g., “The specification describes mounting the geophone...as a key feature...By contrast, it says nothing about the geophone being gimbaled or non-gimbaled.”), and the prosecution history (*id.* at 7-8, e.g., “Each time the word fixed came up in prosecution, the applicant and examiner understood it in its ordinary sense, i.e., mounted or fastened”).

As an aside, the Court rejected the Petitioner’s argument that the Patent Owner had waived arguments concerning prosecution history by failing to raise them below. Rather the Court stated, “[t]he doctrine of waiver does not preclude a party from supporting the original claim construction with new citations to the intrinsic evidence of record.” *Id.* at 7.

In the end, the Court held “to the extent the Board relied on extrinsic evidence to alter the meaning of ‘fixed’ that is clear from the intrinsic evidence, that was an error.” *Id.* at 8.

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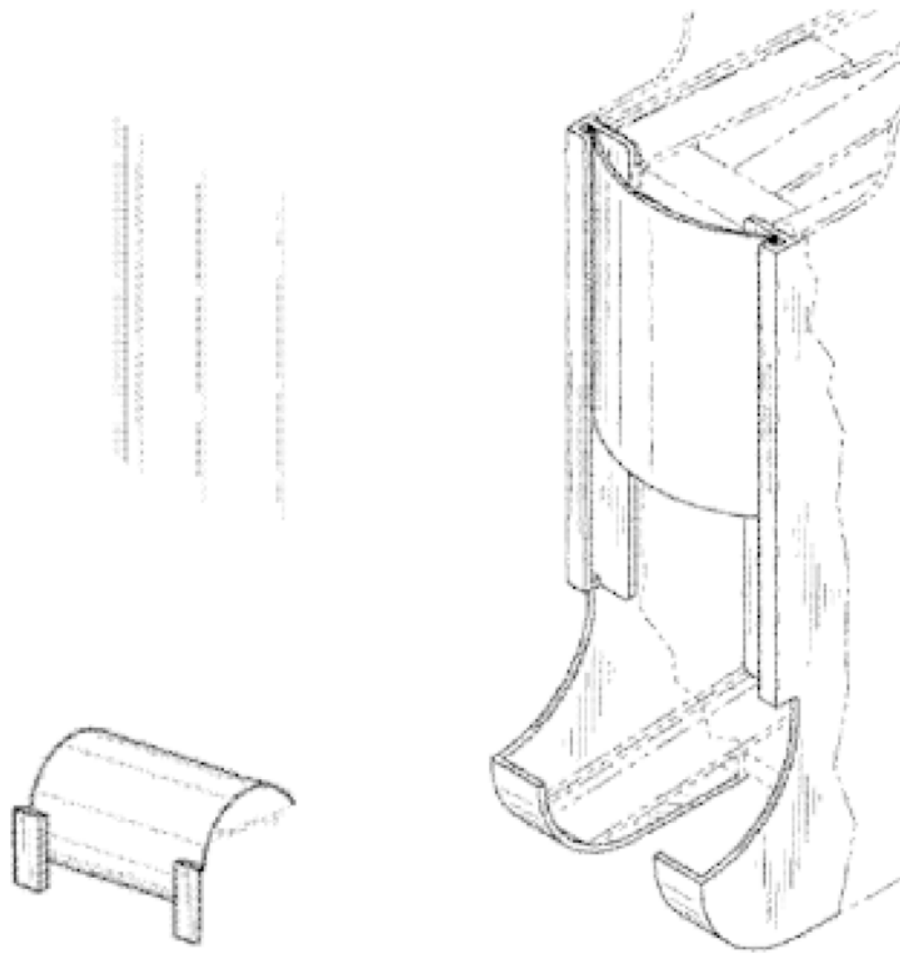
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FOR PARTIAL DESIGN PATENTS AND UTILITY PATENTS ALIKE, RELIANCE ON OBJECTIVE INDICIA REQUIRES EVIDENCE OF A NEXUS TO THE UNIQUE CLAIMED FEATURES

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The Court first considered whether the evidence supported the Board's finding that U.S. Design Patent No. D405,622 to Linz creates basically the same overall visual appearance as the claimed designs. A side-by-side of the claimed aspects of the designs (removing the broken lines) on the left and Linz on the right is shown below. The Court found no reason to disturb the Board's finding.



The Court next turned to the nexus analysis. The Board had found both a presumption of nexus and a nexus-in-fact between the claimed designs and the patentee's evidence of commercial success and praise.

Regarding a presumption of nexus, the Court explained that the presumption only applies if the product alleged to be a commercial embodiment of the claims is coextensive with the claimed invention. The Court stated that the coextensive analysis is not limited to whether unclaimed features are *ornamentally* insignificant but—as with utility patents—considers whether there are *functionally* significant unclaimed product features (even if they not ornamentally significant). Here, given the limited aspects of the claims shown with solid (as opposed to broken) lines, the Court found that the claims cover only a small portion of the commercial product and that the product includes significant unclaimed functional elements. In such cases, the presumption does not apply. Thus, the Court held that substantial evidence did not support the Board's presumption of nexus.

Turning next to nexus-in-fact, the Court stated that absent a presumption of nexus, nexus can also be shown if the objective indicia are the direct result of unique characteristics of the claimed invention (rather than a feature that was known in the prior art). The Court stated that the Board only found four features that distinguished the claimed designs from the Linz prior art. The Court held that, in order to establish nexus, the patentee would have needed to present evidence that the objective indicia derived from those four "unique characteristics." The Court found that the patentee failed to do so, presenting instead evidence linking the objective indicia to aspects of the commercial product that were already present in the prior art. Thus, as with the presumption, the Court held that substantial evidence did not support the Board's finding of nexus-in-fact.

Takeaway: For utility patents and design patents alike, if the claims are directed to partial or limited aspects of the commercial product, reliance on objective indicia requires evidence of a nexus to the unique characteristics of the claims (i.e., what is new over the prior art).

[i] *Campbell Soup Co. v. Gamon Plus, Inc.*, Appeal Nos. 20-2344, 21-1019 (Fed. Cir. August 19, 2021) (precedential).

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