

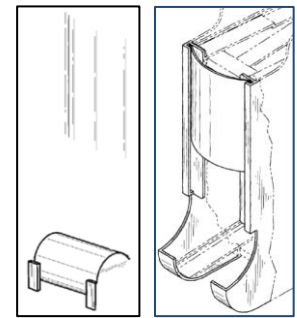
## Coming Back for Seconds

**Campbell Soup Co. v. Gamon Plus, inc., 2020-2344, 2021-1019 (CAFC, Aug. 19, 2021)**

By: Ifti Zaim & Andy Himebaugh | September 08, 2021

The Court of Appeals for the Federal Circuit (the “CAFC”) recently held, again, that the Patent Trial and Appeal Board (“PTAB”) erred in finding U.S. Design Patent Nos. D612,646 and D621,645, directed to gravity feed soup can dispensers, not obvious. The decision underscores that design patents are subject to the same rules as utility patents for objective indicia of non-obviousness.

In the first appeal, the CAFC reversed the PTAB’s disqualification of Petitioner’s primary reference. The PTAB had erred by focusing on “ever-so-slight differences in design” (lack of a “cylindrical object” and differences in the label area) instead of evaluating differences “in light of the overall similarities.”<sup>1</sup> On remand, the PTAB acknowledged that the prior art (right) disclosed a design not just basically the same, but having the same overall appearance as that claimed (left). Regardless, the PTAB again found the patent non-obvious this time based on objective indicia of non-obviousness: industry praise by the Petitioner; commercial success; and copying by others.



In this second appeal, the CAFC found that the PTAB’s approach was legally and factually flawed.<sup>2</sup> First, the CAFC faulted the PTAB for presuming a nexus between the claimed design and the objective indicia even though the patent did not even claim an entire product. To presume a nexus, the patented design must be “coextensive” with the successful or praised product—the product must be the invention itself. However, the successful product comprised substantial unclaimed, often functional portions, such as the rails and sides of the product. The Board dismissed these missing elements as “insignificant to the ornamental design.” That may be true, but as the CAFC noted, “ornamental significance” is not the question in determining coextensiveness; the unclaimed portions are still “significant functional elements,” and thus, the CAFC held that “no reasonable trier of fact could find that the [product] is coextensive with the claimed design.

The CAFC further reversed the PTAB’s finding of a nexus-in-fact based on the design’s claimed label area. To establish a nexus-in-fact for objective indicia of non-obviousness, the patent owner must show that the indicia are “the direct result of the unique characteristics of the claimed invention” and not of features “known in the prior art.”<sup>3</sup> However, the large label area was not “unique” to the patented design, it was disclosed by the asserted prior art, and the specific dimensions in which it might differ were unclaimed or unsubstantiated. The PTAB had tried to distinguish the required showing of nexus for design patents from utility patents on the basis that design patent obviousness contemplates overall visual appearance of the claimed design as a whole. The CAFC rejected this distinction because obviousness in the utility patent context similarly evaluates the claimed invention as a whole, yet indicia must still be linked to particular features.

<sup>1</sup> *Campbell Soup Co. v. Gamon Plus, Inc.*, 939 F.3d 1335, 1341 (Fed. Cir. 2019)

<sup>2</sup> *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019)

<sup>3</sup> *Fox Factory v. SRAM*, 944 F.3d 1366, 1373-74 (Fed. Cir. 2019); *Ormco v. Align Tech.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006)