Enablement and Definiteness of Design Patents in Light of the Federal Circuit’s Precedential Decision in Maatita

By
Leigha Santoro*

Abstract

For a two-dimensional object, there is no need to include three-dimensional renderings of that object in an application for a design patent. If an ordinary observer can be reasonably certain to understand the entire scope of the designed element from the two-dimensional drawing, that will be sufficient to show that the drawing is both definite and enabled for design patent application purposes. As was held in Maatita, a single, two-dimensional drawing is sufficient if an ordinary observer would understand the scope.

* December 2019 J.D. Candidate at Drexel University Thomas R. Kline School of Law.
INTRODUCTION

As with utility patent applications, design patent applications must meet certain statutory requirements to be granted; in general, the requirements for utility patents, including those for enablement and definiteness, apply to design patents. The purpose of these requirements is to ensure that potential competitors know what infringement consists of, based on the disclosure in the claims or drawings. In a recent precedential Federal Circuit decision, the court held that with some limitations, two-dimensional plan-view drawings for design patents are sufficient to make an ordinary observer aware of the potential infringement of the design. Therefore, the claim in this case met the enablement and definiteness requirements. This ruling brings United States patent law more in line with that of Europe.

The ruling in this case makes it possible to file design patent applications with fewer drawings than were previously required because the claims no longer need to fully disclose elements, such as contour and depth. On the one hand, this allows design patent applicants to obtain much broader claims, making it more difficult for competitors to design around. That being said, there are several arguments against this decision including the fact that there is no guarantee a patent will be granted, it is a risk to file an application with limited drawings, and it

---

1 See 35 U.S.C. § 171 (providing that the statutory requirements for design patents are the same as those for utility patents with some exceptions).
3 In re Maatita, 900 F.3d 1369, 1379 (Fed. Cir. 2018); see also Bultman I, supra note 2.
4 Maatita, 900 F.3d at 1379.
7 Id.; Bultman II, supra note 5.
opens the door to more validity challenges. Additionally, there is some opposition to the standard that the Federal Circuit applied.

Part I discusses the factual background relating to the Maatita design patent, as well as the decisions from the patent examiner, the Board, and the Federal Circuit. Part II looks at the relevant legal standards for enablement and definiteness with respect to design patents. Finally, Part III provides an analysis of why two-dimensional plan-view drawings are acceptable for design patents in the limited circumstances specified by the Federal Circuit in Maatita.

I. IN RE MAATITA

A. FACTUAL BACKGROUND

Ron Maatita filed a design patent on October 24, 2011 for the design of an athletic shoe bottom. The application consisted of one claim for “[t]he ornamental design for a Shoe Bottom as shown and described” as well as two plan-view figures. Figure 1 is reproduced below, with the solid lines customarily indicating the claimed design, and the broken lines showing the shoe bottom environment. The second figure in the patent application differed only in the unclaimed elements.

---

8 Bultman II, supra note 5.
10 In re Maatita, 900 F.3d 1369, 1371 (Fed. Cir. 2018).
11 Id.
12 Id. at 1372 (citing In re Blum, 374 F.2d 904, 907 (C.C.P.A. 1967)).
13 Id.
B. THE PATENT EXAMINER’S DECISION

The examiner issued a first office action stating the embodiments shown in applications figures were identical, and the design claim failed to satisfy the enablement and definiteness requirements.\textsuperscript{14} The examiner’s view was that the two-dimensional plan-view left the design open to multiple interpretations with respect to the depth and contour of the claimed elements, making the claim indefinite and not enabled.\textsuperscript{15}

Maatita responded by arguing “there is no specific allegation that one of ordinary skill would not be able to produce the claimed design,” and therefore, there was no enablement issue.\textsuperscript{16} Additionally, he argued the claim covers multiple depths and contours for the shoe, and omitting certain design elements “merely affects the breadth of the claimed design”.\textsuperscript{17} In Maatita’s view, these factors do not render the claim indefinite.\textsuperscript{18}

The examiner issued a final rejection because the claim was not enabled and was indefinite.\textsuperscript{19} In his rejection, he included four different renderings of the two-dimensional plan-view shoe bottom that was claimed, reproduced to the right in Figure 2.\textsuperscript{20} These drawings, according to the examiner, are patentably

\begin{figure}[h]
\centering
\includegraphics[width=\textwidth]{figure2.png}
\caption{Examiner’s renderings showing the different configurations based on the claims.}
\end{figure}

\begin{flushright}
\textsuperscript{14} Id.  \\
\textsuperscript{15} Id.  \\
\textsuperscript{16} Id.  \\
\textsuperscript{17} Id.  \\
\textsuperscript{18} Id.  \\
\textsuperscript{19} Id. at 1373.  \\
\textsuperscript{20} Id.
\end{flushright}
distinct. In his rejection, the examiner specifically noted, “the claim was not enabled ‘because the disclosed design is not understandable to a designer of ordinary skill in the art without resorting to conjecture.’” Additionally, he found “the claim indefinite ‘because the scope of protection sought is not disclosed in the specification or understandable as depicted in the drawings.’”

C. THE BOARD’S DECISION

The Board affirmed the examiner’s rejections, concluding “that ‘because the single view does not adequately reveal the relative depths and three dimensionality between the surfaces provided, the Specification does not reveal enough detail to enable the claimed shoe bottom,’ and that ‘[t]he same lack of clarity and detail also makes the scope of the claim indefinite.’” Maatita appealed this decision to the Federal Circuit.

D. THE FEDERAL CIRCUIT’S DECISION

The Federal Circuit assessed the enablement and definiteness requirements together because they are similar inquiries for design patents. The issue the Federal Circuit was addressing was whether the single, two-dimensional plan-view drawing was an adequate disclosure, sufficiently describing the design.

The Federal Circuit held that in order to assess definiteness in this context, the design needed to be viewed from the perspective of an ordinary observer, and the court needed to assess whether an ordinary observer would reasonably understand the scope of the design based on the

---

21 Id. at 1373–74.
22 Id. at 1375.
23 Id.
24 Id.
25 Id.
26 Id.
27 Id. at 1376 (Federal Circuit also discussed the issue regarding potential inconsistencies between the two figures provided in the patent application but that is not a topic under consideration for this paper).
The court held that for purposes of § 112, “the level of detail required should be a function of whether the claimed design for the article is capable of being defined by a two-dimensional, plan- or planar-view illustration.” Here, even though Maatita decided not to disclose all potential depth choices, an ordinary observer would understand the claimed design because that design is fully disclosed in the two-dimensional plan-view image. The Federal Circuit, therefore, reversed the decision of the Board.

II. RELEVANT LEGAL STANDARDS

Because this design patent was filed on October 24, 2011, the pre-AIA version of 35 U.S.C. § 112 applies. The first paragraph of § 112 concerns the written description and enablement requirements for patents:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

The inquiry for enablement is “whether the specification sufficiently describes the design to enable an average designer to make the design.” The second paragraph of § 112 is concerned with the definiteness requirement for patents: “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” The inquiry for definiteness is “whether the scope of the claim is clear with reasonable certainty.”

---

28 Id. at 1377.
29 Id. at 1378.
30 Id. at 1378–79.
31 Id. at 1379.
32 Id. at 1372 n.1 (noting that the analysis would be the same under either version of 35 U.S.C. § 112 because the AIA did not significantly change the language of this section).
34 Maatita, 900 F.3d at 1375.
36 Maatita, 900 F.3d at 1375.
In order to assess the statutory requirements for design patents, the inquiry is limited to what is shown in the drawings. Because of the limited scope of design patent claims, the issue regarding enablement can be considered similar to that of definiteness. Therefore, these inquiries are assessed together, as the court did in this case, with a focus primarily on the definiteness requirement.

The Supreme Court defined the test for definiteness in *Nautilus, Inc. v. Biosig Instruments, Inc.*, where it held § 112 “require[s] that a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty.” It should be noted, however, that this case was regarding a utility patent, so the application will not be exactly the same in the context of a design patent.

The purpose of the definiteness requirement is to ensure that “any description which is sufficient to . . . serve as a warning to others of what the patent claims as a monopoly, is sufficiently definite to sustain the patent.” The Federal Circuit has stated that with respect to this purpose and the utility test for definiteness, the standard for definiteness in design patents is related to that of infringement, and infringement occurs if “an ordinary observer, familiar with the prior art, would be deceived into thinking that the accused design was the same as the patented design.” This, therefore, is the standard to apply when assessing definiteness of design patents.

---

37 In re Mann, 861 F.2d 1581, 1582 (Fed. Cir. 1988).
38 Ex parte Asano, 201 U.S.P.Q. 315, 317 (Pat. & Tr. Office Bd. App. 1978) (stating that the enablement issue is “generally the same as the definiteness issues”).
39 *Maatita*, 900 F.3d at 1375; *but see* Anders & Rourk, *supra* note 9 (arguing that this proposition is incorrect and that the court relied on a case for a utility patent, where it should have performed a legal analysis for ornamental design instead).
41 *Id.* at 903.
42 *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 437 (1902)
III. ANALYSIS

The court applied the correct standard in this case by looking at the enablement and definiteness requirements regarding design patents from the perspective of an ordinary observer. Based on the relevant law, many cases have held that for design patents, the ordinary observer test is the correct standard to apply when determining infringement, which is used to determine definiteness.44 One argument against this standard, however, is that an ordinary observer is not the equivalent of a person of ordinary skill in the art.45 Although this is a true statement, case law has been consistent in holding that the ordinary observer test is the correct perspective to view a design from for design patent cases.46 Therefore, the ordinary observer test is the appropriate standard to use for this case, as the Federal Circuit has done, and for any other case involving a design patent.

In holding that two-dimensional plan-view drawings are sufficient in limited circumstances for design patents, the court created a standard that will allow broader claims to issue for design patents.47 Because design patent applications no longer need to disclose contours or depths, patentees can obtain much broader claim scope without showing non-essential design elements, such as the rest of the shoe.48 Drawings showing designs that are fully visible from a single, two-dimensional plan-view are now sufficient to obtain a patent in certain cases.49 This will certainly make it more difficult for competitors to attempt to design around the claimed

---

44 Egyptian Goddess, 543 F.3d at 672; Gorham, 81 U.S. at 528.
45 Anders & Rourk, supra note 9.
46 Egyptian Goddess, 543 F.3d at 672; Gorham, 81 U.S. at 528; Int’l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1237–41 (Fed. Cir. 2009) (holding the ordinary observer test is applied for anticipation of design patents); Peters v. Active Mfg. Co., 129 U.S. 530 (1889) (applying the test in Gorham and holding “[t]hat which infringes, if later, would anticipate, if earlier”).
47 Schmidbauer, supra note 6.
48 Id.
49 Bultman II, supra note 5.
features. For example, because the contours and depth of the design do not need to be disclosed, any depth or contour could be seen as infringing; any of the examiner’s renderings, shown in Figure 2, would infringe on this design patent. This gives the patentee much broader claims than if he had only been able to patent one of those depth and contour designs.

However, it is extremely important to note the limitation that the Federal Circuit put on this standard because that limitation is what negates any potential arguments against the holding. The court mentioned that although the design for an entire shoe or a teapot, for example, cannot be adequately described by a single plan-view drawing, it is possible for the design of a rug or a placemat to be described as such. This means that this standard only applies to objects that are completely disclosed by looking at one two-dimensional rendering. This is consistent with the decision in Ex parte Salsbury which stated “[i]t is recognized that flat articles can generally be sufficiently illustrated by a single view.”

The ornamental design is what the court considers in design patent cases, and if the “ornamental design is capable of being disclosed and judged from a two-dimensional, plan- or planar-view perspective,” then the two-dimensional drawing is sufficient for enablement and definiteness inquiries.

There are, however, several arguments against the decision in this case. First, there is no guarantee a patent will be granted if the application only has two-dimensional plan-view drawings. Examiners still have the ability to reject claims for definiteness reasons if they do not find the single, two-dimensional plan-view sufficient because the Federal Circuit did not say this type of view always meets the standard; rather, it said that a “single view isn’t necessarily

50 Id.
51 In re Maatita, 900 F.3d 1369, 1378 (Fed. Cir. 2018); see also Bultman II, supra note 5.
52 Ex parte Salsbury, 38 U.S.P.Q. 149 (Com’r Pat. & Tr. 1938).
53 Maatita, 900 F.3d at 1378.
54 Bultman II, supra note 5.
This argument is furthered by the fact that it is still a risk to file an application that is limited to two-dimensional plan-view drawings. This risk comes from the patent standard that prevents the addition of new matter once the application is filed. If an examiner rejects a two-dimensional plan-view drawing, an inventor is prevented from adding new matter, and new matter for a design patent would be a new drawing. In other words, a patentee would not be able to add any new drawings to the application, so it may be better to include three-dimensional drawings from the beginning instead of risking a rejection of the application.

Finally, there is an argument that this Federal Circuit decision, allowing for broader claims, will open the door for more validity challenges. Because of the potential broad scope of these patent claims, as with utility patents, it will be more difficult to defend validity challenges despite the fact that it is easier to establish infringement. Although these arguments do have merit, the Federal Circuit did provide the limitation that this holding should only be applied in situations where the design can be adequately described the two-dimensional drawing. If this limitation is followed, these arguments against the holding should not be of concern because they will only be raised in the circumstances where a design cannot be adequately described by the two-dimensional image.

55 Id. (citing Maatita, 900 F.3d at 1378–79).
56 Bultman II, supra note 5.
58 Bultman II, supra note 5; Ex parte Asano, 201 U.S.P.Q. 315, 317 (Pat. & Tr. Office Bd. App. 1978) (stating the test for new matter is “whether there is support anywhere in the drawings for the necessary or desirable figure corrections”). Applying this test to design patents, any new three-dimensional image would be considered new matter if the original application only contained two-dimensional drawings.
59 Bultman II, supra note 5.
60 Id.
IV. Conclusion

The statutory provisions for design patents require that the claims disclose enough information that it is clear to competitors what design is being claimed. The Federal Circuit held that for limited circumstances, such as the sole of an athletic shoe, a two-dimensional plan-view drawing is sufficient to provide an ordinary observer with enough disclosure so that the observer would reasonably understand the scope of the design. Based on the statutory requirements and the case law interpretations of those requirements in the design patent context, this is the correct outcome for this case. So long as it remains limited to circumstances where an ordinary observer can be reasonably certain he or she understands the entire scope of the designed element with the two-dimensional plan-view disclosure, there will not be any issues with overbreadth of the claims or risks of indefiniteness and additions of new matter.

---

61 Maatia, 900 F.3d at 1376.
62 Id. at 1379.