



Patents Post-Grant



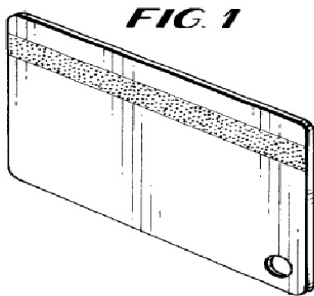
BPAI Emphasizes Obviousness Test in Reversing Inter Partes Design Patent Reexamination

Posted On: Apr. 28, 2010 By: [Scott A. McKeown](#)

Topics: Inter Partes Reexamination

In *inter partes* reexamination 95/000,034, *Vanguard Identification Systems Inc., v Bank of America Corporation*, the BPAI reversed the examiners obviousness rejection, emphasizing the difference between a proper obviousness determination for design and utility patents. An obviousness determination for a utility patent must consider the perspective of one of ordinary skill in the art to which the invention pertains. For design patents, obviousness is based on the

perspective of designer of ordinary skill who designs articles of the type involved. As this case demonstrates, failing to appreciate the distinction can lead to dire consequences for third party requesters.



The '247 design patent claims a design for a data card. The data card is rectangular in shape, has rounded corners, has a horizontal strip extending across one face, and includes a circular aperture, as shown in Figure 1 of the patent below:

The '247 patent illustrates different embodiments wherein the circular aperture is positioned at different locations on the data card.

During *inter partes* reexamination, the Examiner adopted the third party requesters proposed rejection, rejecting the sole claim of the '247 patent under 35 U.S.C. § 103(a), relying on Keller (U.S. Patent No. 6,196,594) and Drexler (U.S. Patent No. 4,711,996) as primary reference.

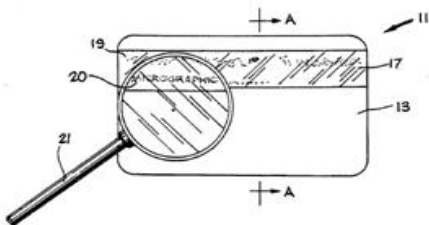


Fig. 1 of Drexler

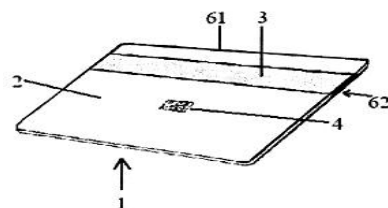


Fig. 1 of Keller

As can be seen above, neither primary reference shows a data card containing any type of aperture. Instead, the Examiner sided with the requester, taking the position that it would be obvious to modify the primary references to include one of the circular apertures present in data cards described in the secondary references.

The patent owner, Bank of America, appealed these rejections to the BPAI, arguing that the Examiner failed to establish a *prima facie* case of obviousness because Keller and Drexler were inadequate primary references since they completely lack an aperture. The Board, in the original decision of July 31, 2009, agreed with the patent holder Bank of America and reversed the rejections under 35 U.S.C. § 103(a).

The requester, Vanguard Identification Systems, requested a rehearing at the BPAI. Vanguard argued that the original decision misapplied Federal Circuit precedent since the primary references could be modified to include an aperture and such a modification would not “destroy fundamental characteristics” of the primary references.

In maintaining their position, the Board explained that obviousness of a design patent requires an analysis of whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved. In *In re Rosen*, the U.S. Court of Customs and Patent Appeals stated that, as a starting point for a § 103 rejection, “there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references.”

In applying the guidance from *In re Rosen*, the BPAI noted that the initial focus in an obviousness test is whether there is a reference in existence which creates basically the same overall visual impression. The BPAI stated that the aperture in the ‘247 patent is integral to, and cannot be disassociated from, the visual impression created by the patented design as a whole. Thus, without an aperture, the BPAI concluded that Keller and Drexler could not serve as primary references since neither reference creates basically the same visual impression as the design in the ‘247 patent.

Accordingly, an obviousness analysis of a design claim should be approached differently from that of a utility claim. For a design claim, the initial focus should not be on whether there is a primary reference which discloses a majority of features, but instead, whether there is a reference in existence presents the same basic visual impression as the claimed design.

As noted during [Design Day 2010](#) by Dr. Jasemine Chambers, Director of TC 2900, design examiners will soon receive supplemental training on the guidelines of obviousness for design applications. The purpose of these guidelines is to increase the quality of obviousness rejections and to be consistent with the *In re Rosen* case discussed above. Accordingly, whether preparing a Request for Reexamination or a response during prosecution, it is important to remember the differences between the obviousness analysis of design and utility claims.

Special thanks to design patent team member [Colin Harris](#) for his insight and review.