

A faint, light gray technical drawing of a mechanical assembly, possibly a transmission or engine component, is visible in the background. It features numerous numbered callouts (e.g., 86, 84, 82, 56, 62, 58, 28, 38, 42, 54, 46, 64, 34, 66, 90) pointing to various parts of the assembly. The drawing is oriented diagonally across the slide.

TC 2900 Impacts on Obviousness Analysis under 35 U.S.C. 103 for Designs in view of *LKQ v. GM Global Tech* – Part 2

January 2025

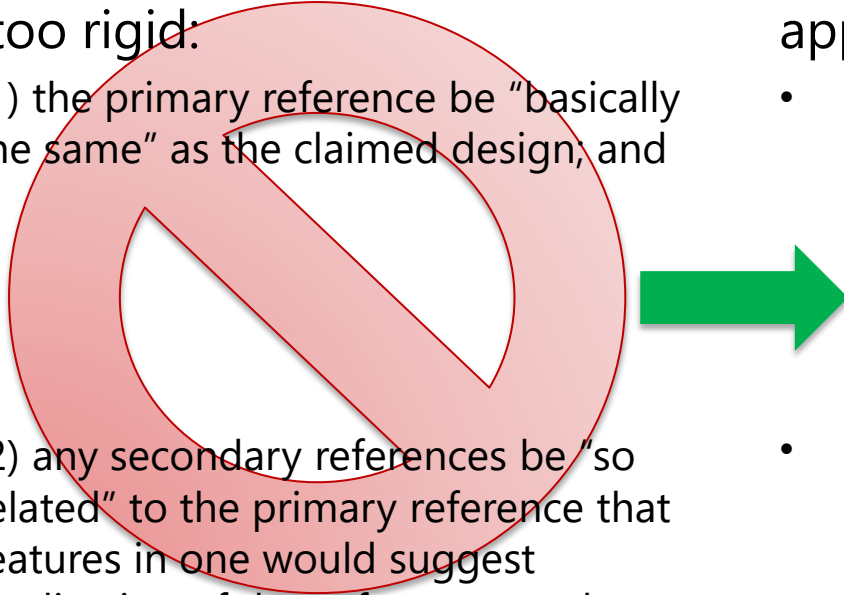
Learning Outcomes

1. Determine whether it is reasonable for a reference to be used as a primary reference based on the *Graham v. Deere* factual inquiries, given an example of a claimed design and prior art.
2. Determine whether it is reasonable for a reference to be used as a secondary reference, given an example of a claimed design and prior art.
3. Determine if it would have been obvious to an ordinary designer in the field to which the claimed design pertains to have modified the prior art design to create the same overall visual appearance as the claimed design.
4. Write a proper 35 U.S.C. 103 rejection to set forth a *prima facie* case of obviousness using the primary and secondary reference(s).

Review: What has changed since *LKQ*?

Rosen-Durling test requirements are too rigid:

- (1) the primary reference be "basically the same" as the claimed design, and
- (2) any secondary references be "so related" to the primary reference that features in one would suggest application of those features to the other



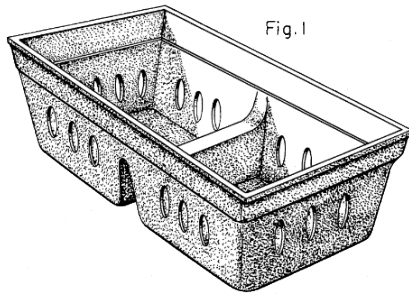
LKQ adopts the more flexible approach of *KSR*:

- Primary reference need not be "basically the same" as the claimed design
 - Need only be "something in existence" and "visually similar" to the claimed design and must be analogous to the claimed design
- Secondary reference(s) need not be "so related" to the primary reference that features in one would suggest application of those features to the other
 - However, must be analogous to the claimed design

Fruit Basket example

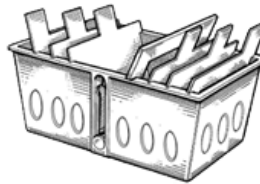
We'll use the following example to demonstrate the more flexible approach.

Title of the application:
Fruit Basket

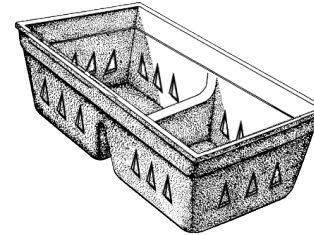


Claim: The ornamental design for Fruit Basket as shown and described.

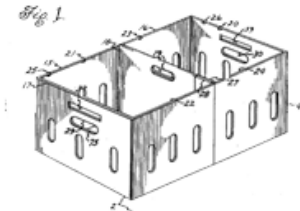
Prior Art



File Holder



Container A



Drawer Basket

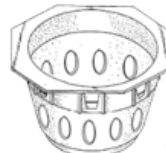


FIG. 1
Planter

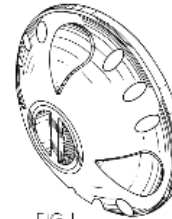
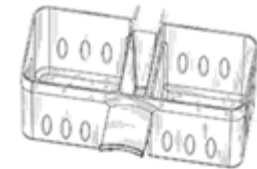


FIG. 1
Wheel Rim



Container B

**Assume the application contains a sufficient number of views to constitute a complete disclosure of the appearance of the design.*

Resolve the *Graham v. Deere* Factual Inquiries

Review: Basic factual inquiries guiding the evaluation of obviousness

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art;
- (3) Resolving the level of ordinary skill in the art; and
- (4) Evaluating any objective evidence of nonobviousness (i.e., so-called "secondary considerations").
 - Such evidence, sometimes referred to as "secondary considerations," may include evidence of commercial success, long-felt but unsolved needs, failure of others, and unexpected results.

See MPEP 1504.03(I) and MPEP 2141(II)*.

**The MPEP will be updated to reflect the changes to practice in view of LKQ in due course.*

Factual Inquiry 1: Determining the Scope and Content of the Prior Art

Review of Factual Inquiry 1: Determining the scope and content of the prior art

In determining the scope and content of the prior art, a primary reference must be identified.

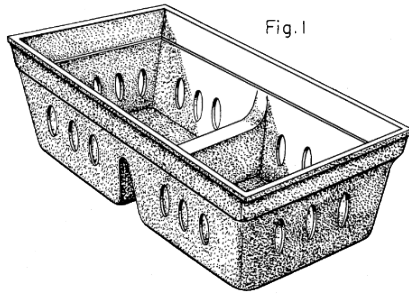
- Remember, the primary reference is analyzed in terms of its visual similarity to the claimed design, but this **primary reference need not be “basically the same” as the claimed design.**
- Rather, the primary reference need only be:
 - visually similar to the claimed design;
 - “something in existence—not . . . something that might be brought into existence by selecting individual features from prior art and combining them, particularly where combining them would require modification of every individual feature”;
 - analogous to the claimed design.

Review of Factual inquiry 1: Determining the scope and content of the prior art (cont.)

- Prior art is analogous to the claimed invention if:
 - the prior art is from the same field of endeavor as the article of manufacture of the claimed invention; **or**
 - is otherwise analogous to the claimed design for an article of manufacture as determined on a case-by-case basis.
 - As the Federal Circuit did not define how to determine whether a prior art design outside the field of endeavor of the article of manufacture is analogous, the design examiner should consider the degree to which an ordinarily skilled designer would consider other fields.
 - If the examiner questions whether a design is analogous art, the examiner should confer with their supervisory patent examiner (SPE).
- If prior art is not analogous art, it may not be considered by the examiner in assessing obviousness.

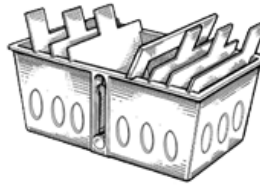
Knowledge Check 1

Title of the application:
Fruit Basket

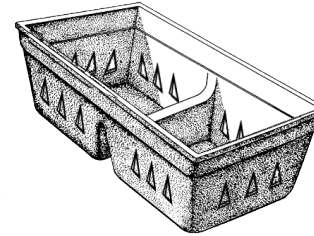


Claim: The ornamental design for Fruit Basket as shown and described.

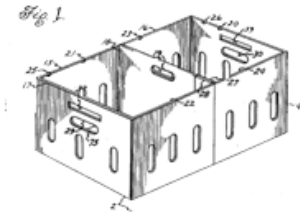
Prior Art



File Holder



Container A



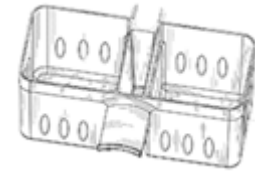
Drawer Basket



FIG. 1
Planter



FIG. 1
Wheel Rim

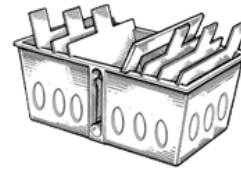


Container B

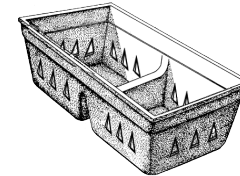
Which of these prior art references would not reasonably be considered analogous to the claimed Fruit Basket?

Knowledge Check 1: Answer

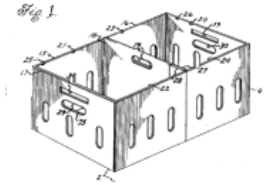
- *Remember*, references will typically be in the same field of endeavor as the claimed ornamental design's article of manufacture, but it need not be, so long as it is analogous art to the claimed ornamental design's article of manufacture.
- As with the primary reference, a design examiner must also determine whether a secondary prior art reference is analogous to the claimed ornamental design's article of manufacture.
- However, each reference applied in an obviousness rejection need **not** be analogous art to **each other**.
- The **wheel rim** is not in the same field of endeavor as containers. Barring evidence showing that an ordinarily skilled designer would consider wheel rims, it would be reasonable for the examiner to determine that the prior art Wheel Rim is not analogous to the claimed design.



File Holder



Container A



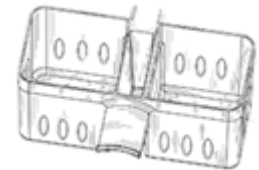
Drawer Basket



FIG.1
Planter



Wheel Rim

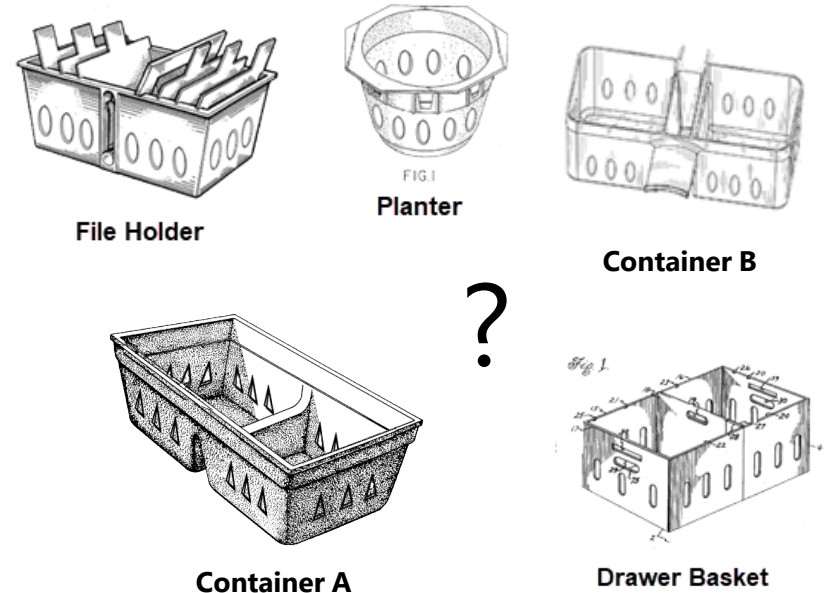


Container B

Factual inquiry 1: Determining the scope and content of the prior art – Fruit Basket example

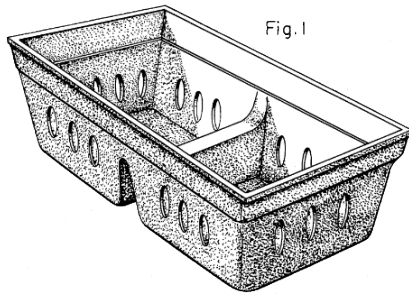
Remember, in addition to the reference needing to be analogous to the claimed design, a primary reference should also be:

- Visually Similar - "The 'more visually similar the primary reference design is to the claimed design, the better positioned' a design examiner will be to set forth a *prima facie* case of obviousness."
- Something in existence-not ... something that might be brought into existence by selecting individual features from prior art and combining them particularly where combining them would require modification of every individual feature. (*In re Jennings*, 182 F. 2d 207, 298 (CCPA 1950))



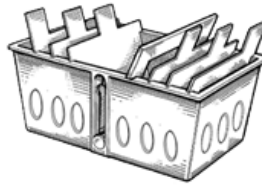
Knowledge Check 2

Title of the application:
Fruit Basket

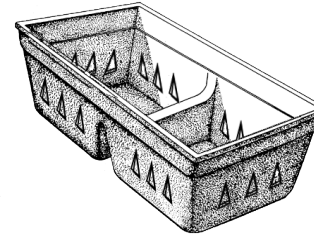


Claim: The ornamental design for Fruit Basket as shown and described.

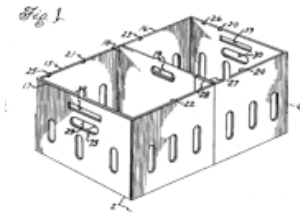
Prior Art



File Holder



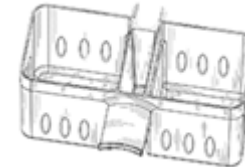
Container A



Drawer Basket



FIG. 1
Planter

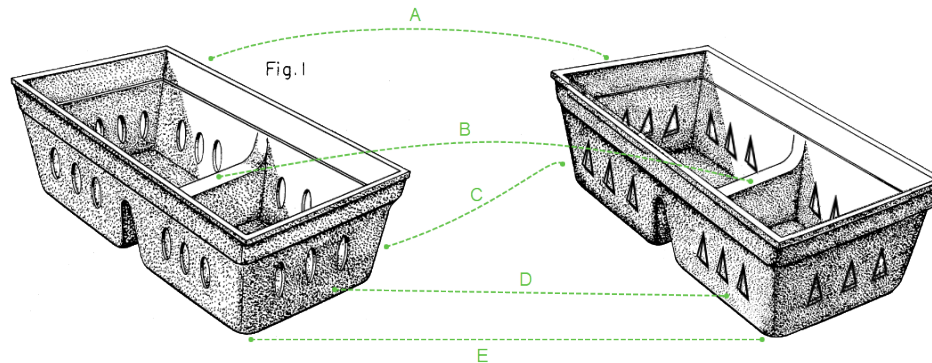


Container B

Identify which of these prior art references would reasonably be considered the **most visually similar** to the claimed design?

Knowledge Check 2: Answer

- While all prior art cited is analogous and something in existence, and may have some similar visual characteristics, Container A appears to be the **MOST** visually similar to the claimed basket.
- It would be reasonable for an examiner to determine that **Container A** is the best primary reference.

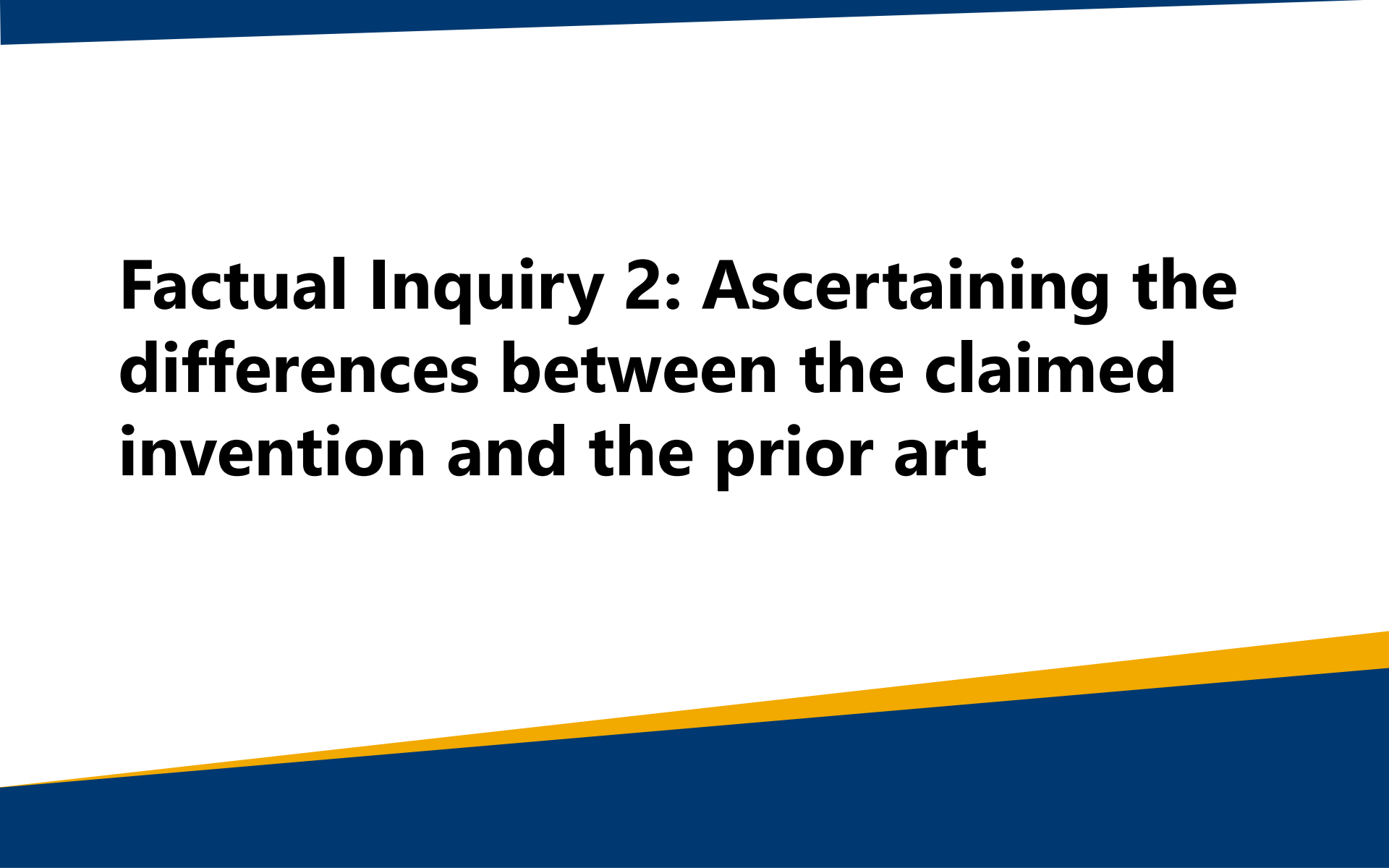


**Claimed design for a
Fruit Basket**

Container A

Similarities

- A. Rectangular Rims
- B. Partition separating compartment into two sections
- C. Tapered Sidewalls
- D. Textured Appearance
- E. Rounded Corners



Factual Inquiry 2: Ascertaining the differences between the claimed invention and the prior art

Review of Factual inquiry 2: Ascertaining the differences between the claimed invention and the prior art

After considering the scope and content of the prior art, the differences between the prior art and the design claim at issue must be determined.

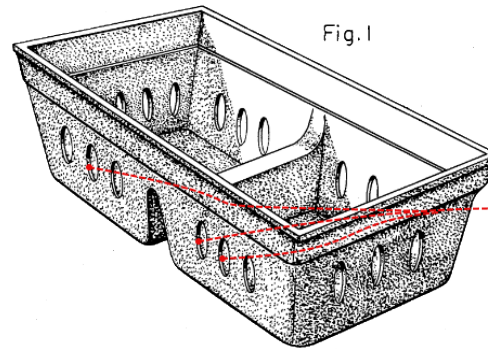
- *Remember:* This approach **does not use the threshold requirement of “basically the same” from *Rosen-Durling*** and is more flexible.
- Instead, when determining differences between the prior art and the design at issue, the design examiner must compare the visual appearance of the claimed design with prior art from the perspective of an ordinary designer in the field of the article of manufacture.

Factual inquiry 2: Ascertaining the differences between the claimed invention and the prior art for Fruit Basket example

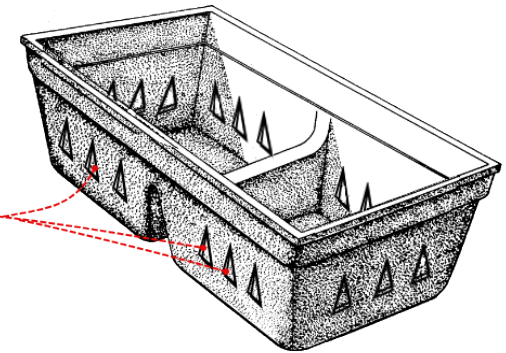
What are the differences between the claimed design and the primary reference?

Differences

F. The claim has oval shaped openings on the surface of the tapered sidewalls while the prior art has triangular shaped openings.



Claim: Fruit Basket



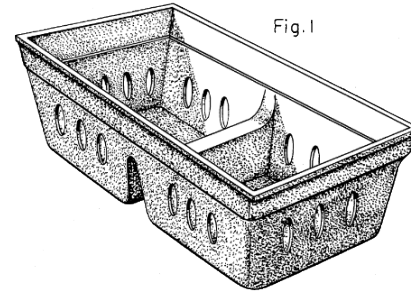
Container A

Factual Inquiry 3: Resolving the level of ordinary skill in the art

Review of Factual inquiry 3: Resolving the level of ordinary skill in the art

In determining the level of ordinary skill in the art, the design examiner should consider the knowledge of a designer of ordinary skill who designs articles of the type being examined.

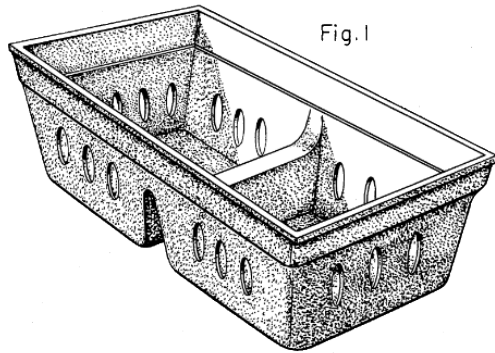
MPEP 1504.03, subsection I.C.



Claim: Fruit Basket

What is the level of ordinary skill in the art of a designer in the relevant field?

Factual inquiry 3: Resolving the level of ordinary skill in the art for Fruit Basket example (cont.)



Claim: Fruit Basket

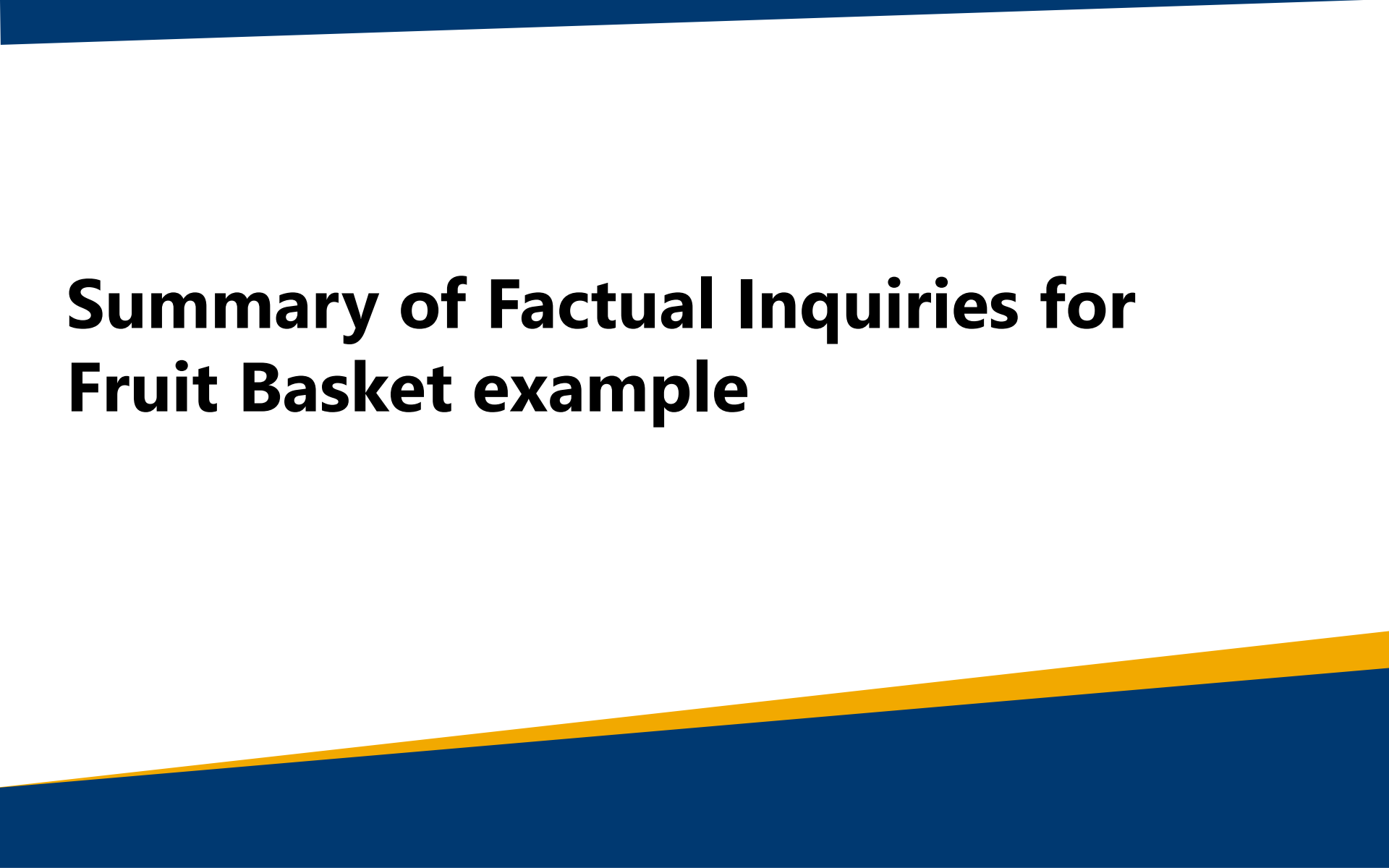
The level of ordinary skill is a designer of ordinary capability who designs baskets.



Factual Inquiry 4: Evaluating any objective evidence of nonobviousness

Review of Factual inquiry 4: Evaluating any objective evidence of nonobviousness

- Referred to as "secondary considerations"
- Whenever present, design examiners should continue to consider secondary considerations as indicia of obviousness or nonobviousness.
 - MPEP 1504.03(I)(D) and 1504.03(III).
- Evidence of nonobviousness may be present at the time a *prima facie* case of obviousness is evaluated or it may be presented in rebuttal of a prior obviousness rejection. MPEP 1504.03(I)(D).
 - Typically, this most often occurs after a response has been received from the applicant and not upon a first examination.

The slide features a white background with decorative diagonal stripes in dark blue and yellow. The stripes run from the top-left towards the bottom-right. A thick dark blue stripe is at the top, and a thinner yellow stripe is just below it. At the bottom, there is a wide dark blue stripe, and just above it, a thinner yellow stripe.

Summary of Factual Inquiries for Fruit Basket example

Summary of factual inquiries for Fruit Basket example

- **Factual Inquiry 1: Determine scope and content of the prior art**
 - Prior art Container A has been identified as visually similar when compared to the claimed design, something in existence, and analogous art to the claimed design. Therefore, it would be reasonable for an examiner to determine that Container A is the best primary reference.
- **Factual Inquiry 2: Ascertain the differences between claimed invention and the prior art**
 - The primary reference (Container A) has triangular shaped openings in the sidewall whereas the claimed design has oval shaped openings in the sidewall.
- **Factual Inquiry 3: Resolve the level of ordinary skill**
 - The level of ordinary skill is a designer of ordinary capability who designs baskets.
- **Factual Inquiry 4: Evaluate any secondary considerations**
 - No secondary considerations to consider



Considering a secondary reference

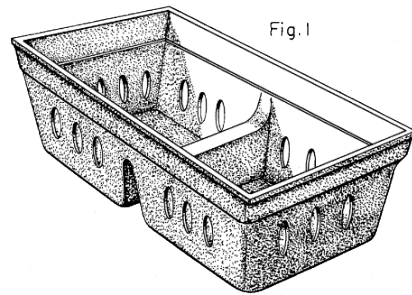
Review: Considering a secondary reference

- Where a primary reference alone does not render the claimed design obvious, secondary references may be considered.
- Secondary reference(s) need not be “so related in appearance” to the primary reference that features in one would suggest application of those features to the other
- Secondary reference(s) must be **analogous to the claimed design**
 - in the same field of endeavor as the article of manufacture of the claimed invention; or
 - otherwise analogous to the claimed design for an article of manufacture as determined on a case-by-case basis.
- To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art.

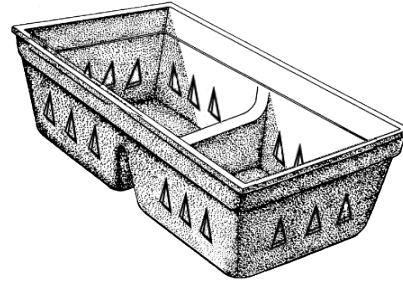
MPEP 1504.03(II)

Considering a secondary reference

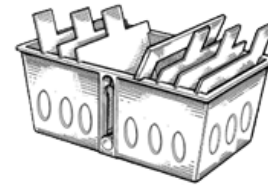
- All four references qualify as analogous to the claimed design.
- Further, all references teach oval shaped openings on the sidewalls of the containers



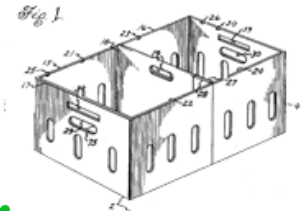
Claim: Fruit Basket



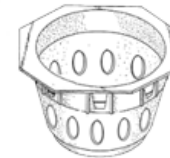
**Container A
Primary Reference**



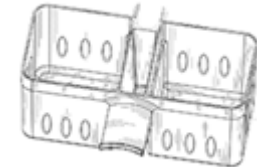
File Holder



Drawer Basket



Planter

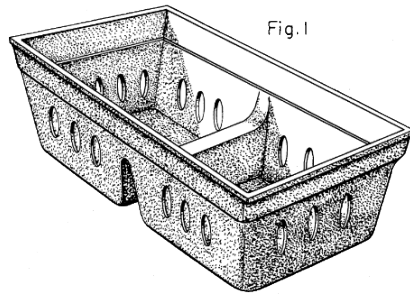


Container B

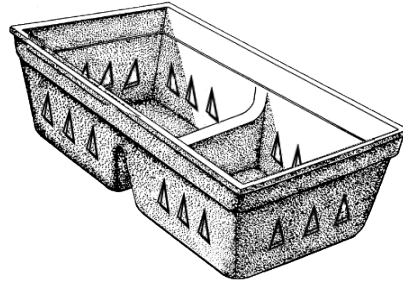


Considering a secondary reference

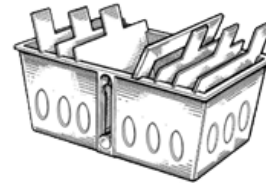
- Assume Container B is selected as the secondary reference



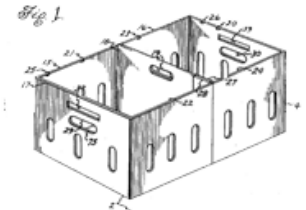
Claim: Fruit Basket



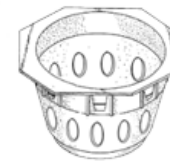
**Container A
Primary Reference**



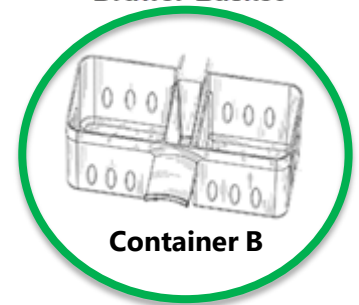
File Holder



Drawer Basket



**FIG. 1
Planter**



Container B

Establishing a *prima facie* case of obviousness for Fruit Basket example

Review: *Prima Facie* Obviousness

- After ascertaining the scope and content of the prior art, the knowledge of an ordinary designer in the field to which the claimed design pertains, and the differences between the prior art and the claimed design, the design examiner must evaluate the obviousness or nonobviousness of the claimed design.
- If an ordinary designer in the field to which the claimed design pertains would have been motivated to modify the prior art design to create the same overall visual appearance as the claimed design, then the examiner should reject the claim under 35 U.S.C. 103 barring convincing secondary indicia of nonobviousness being of record.
 - There must be some record-supported reason (without impermissible hindsight) that an ordinary designer in the field of the article of manufacture would have modified the primary reference based on the teaching(s) of the secondary reference(s) to create the same overall appearance as the claimed design
 - Design examiners should keep in mind that, generally, the more different the overall appearances of the primary reference versus the secondary reference(s), the more difficult it will be to establish a motivation to alter the primary prior art design in light of the secondary one and set forth a *prima facie* case of obviousness.
 - The inquiry must focus on the visual impression of the claimed design as a whole and not on selected individual pieces.

Review: When establishing a *prima facie* case of obviousness, rationale required

- If the rejection set forth in the Office action does not answer **WHY** it would have been obvious to have combined the teachings or made the modification, the examiner has failed to set forth the rationale necessary to establish a *prima facie* case of obviousness.
- Factors to consider in setting forth the rationale include:
 - the ordinarily skilled designer's experience, creativity, and common sense;
 - market demands and industry customs that exist in the relevant field;
 - ornamental features that are commonplace in the relevant field;
 - the extent to which ornamental features are motivated by functional considerations; and
 - whether industry designers face similar design problems as designers in other industries or otherwise look to other industries for design ideas.

Review: When establishing a *prima facie* case of obviousness, rationale required (cont.)

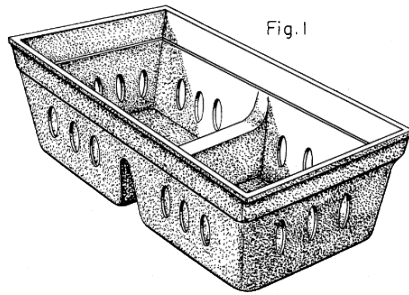
- The rationale may come from a variety of sources. See MPEP 2144 and 2143.01.
- Examples of rationales that may support a conclusion of obviousness include:
 - Simple substitution of one known design element for another
 - Industry designers face similar design problems as designers in other industries or otherwise look to other industries for design ideas
 - Consumer or market demand or industry customs for certain ornamental features as demonstrated by:
 - Prevalence in the prior art so that adding them to a claimed design would be an obvious design choice; or
 - Functional considerations that motivate a particular design choice.
 - Ornamental features that are commonplace in the relevant field
 - Some other teaching, suggestion, or motivation in the prior art that would have led a designer of ordinary skill in the art to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention

Review: When establishing a *prima facie* case of obviousness, rationale required (cont.)

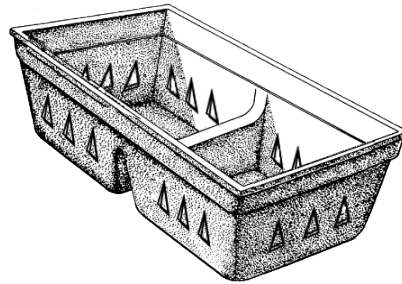
- Note that the list of rationales provided is not intended to be an all-inclusive list.
 - Other rationales to support a conclusion of obviousness may be relied upon by examiners.
 - The rationales should not be treated as per se rules, but rather must be explained and shown to apply to the facts at hand.
 - Any rationale employed must provide a link between the factual findings and the legal conclusion of obviousness.
- Should you have concerns about whether to rely on other rationales, submit an inquiry to designcaselaw@uspto.gov together with application number, prior art and proposed rationale.

Knowledge Check 3

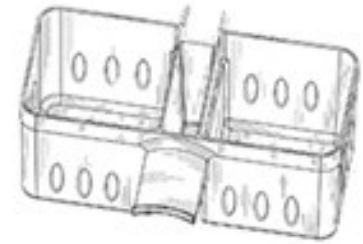
Given the available evidence, would it have been obvious for an ordinary designer in the field to which the claimed design pertains to have modified Container A (primary reference) with the feature(s) from Container B (secondary reference) to create the same overall visual appearance as the claimed design?



Claim: Fruit Basket



**Container A
Primary Reference**

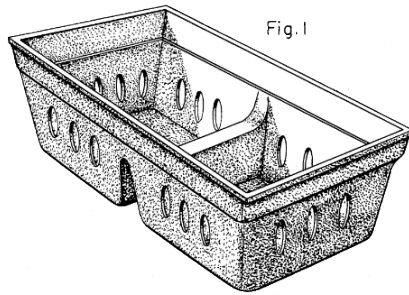


**Container B
Secondary reference**

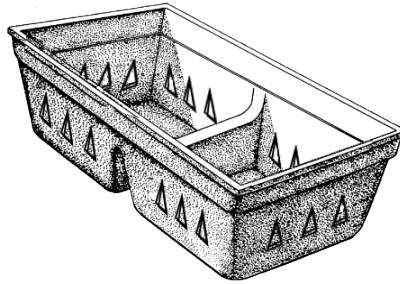
- A. Yes, it would have been obvious for an ordinary designer in the field of the article of manufacture to have modified Container A in light of Container B because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other.
- B. No, it would not have been obvious for an ordinary designer in the field of the article of manufacture to have modified Container A with Container B because the partition in Container B is an open space and would not create the same overall appearance as the claimed design when combined with Container A.
- C. Yes, it would have been obvious for an ordinary designer in the field of the article of manufacture to have modified Container A with Container B because such a modification is no more than a simple substitution of one known design element for another (oval design element replacing triangular design element).
- D. No, it would not have been obvious for an ordinary designer in the field of the article of manufacture to have modified Container A with Container B because such a modification is more than a simple substitution of one known design element for another (oval design element replacing triangular design element).

Knowledge Check 3: Answer

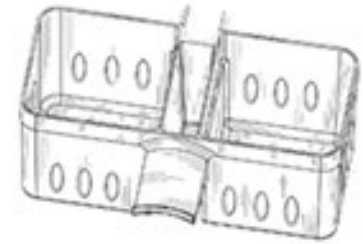
Given the available evidence, would it have been obvious for an ordinary designer in the field to which the claimed design pertains to have modified Container A (primary reference) with the feature(s) from Container B (secondary reference) to create the same overall visual appearance as the claimed design?



Claim: Fruit Basket



**Container A
Primary Reference**



**Container B
Secondary reference**

- A. Yes, it would have been obvious for an ordinary designer in the field of the article of manufacture to have modified Container A in light of Container B because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other.
- B. No, it would not have been obvious for an ordinary designer in the field of the article of manufacture to have modified Container A with Container B because the partition in Container B is an open space and would not create the same overall appearance as the claimed design when combined with Container A.
- C. Yes, it would have been obvious for an ordinary designer in the field of the article of manufacture to have modified Container A with Container B because such a modification is no more than a simple substitution of one known design element for another (oval design element replacing triangular design element).
- D. No, it would not have been obvious for an ordinary designer in the field of the article of manufacture to have modified Container A with Container B because such a modification is more than a simple substitution of one known design element for another (oval design element replacing triangular design element).

Writing an Obviousness Rejection

Review: Writing an obviousness rejection based on multiple references

The following is a suggested format for writing an obviousness rejection using the facts determined from the *Graham v. John Deere* factual inquiries:

- A. A description of what the primary reference teaches relative to the claimed invention
- B. An identification of what the differences are between the claimed invention and the primary reference
- C. An indication of what the secondary reference(s) teach(es) relative to the differences
- D. An explanation of how the primary reference is to be modified by each secondary reference to arrive at the claimed invention, and the rationale for making each modification
 - An examiner must explain **why** each modification or combination of prior art teachings would have been obvious to a designer of ordinary skill who designs articles of the type being examined in order to support the legal conclusion of obviousness.

Establishing a *prima facie* case of obviousness for Fruit Basket example

Suggested format for writing an obviousness rejection

- A. A description of what the primary reference teaches relative to the claimed invention
- B. An identification of what the differences are between the claimed invention and the primary reference
- C. An indication of what the secondary reference(s) teach(es) relative to the differences
- D. An explanation of how the primary reference is to be modified by each secondary reference to arrive at the claimed invention, and the rationale for making each modification

The claim is rejected under 35 U.S.C. 103 as being unpatentable over Container A in view of Container B.

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a designer having ordinary skill in the art to which the claimed invention pertains, the invention is not patentable. **(FP 15.19.aia)**

Container A has an overall appearance with design characteristics that are visually similar to those of the claimed design, in that it shows a rectangular open container with a divider and repeating sidewall openings.

The claimed design differs from Container A in that the sidewall openings are oval. Container B shows oval sidewall openings.

It would have been obvious to a designer of ordinary skill in the art before the effective filing date of the claimed design to modify Container A with Container B by substituting the triangular shaped openings of Container A with the oval shaped openings of Container B because such a modification is no more than a simple substitution of one known design element for another (oval design element replacing triangular design element). Moreover, such substitution of one known design element for another known design element in the same field would have been within the skill of an ordinarily skilled designer.

Camouflage Pants Writing Exercise

Camouflage Pants Example

Title: Camouflage Pants

Claim: The ornamental design for Camouflage Pants as shown and described.

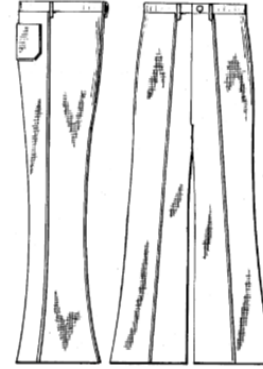


**Assume the application contains a sufficient number of views to constitute a complete disclosure of the appearance of the design.*

Camouflage Pants Example (cont.)



Claim:
Camouflage Pants



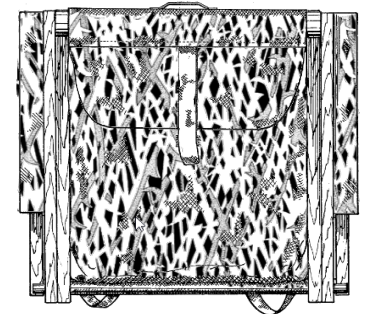
Patent A: Pants



NPL C



NPL B



Patent D: Camouflage
Backpack

Camouflage Pants Example (cont.)

Question:

Given the prior art references presented in the example, how would you establish a *prima facie* case of obviousness?

- We will now breakout into groups to discuss this example.
- You will have 15 minutes for discussion.
- After 15 minutes, you will submit your own individual rejection establishing a *prima facie* of obviousness for the Camouflage Pants example.

Remember, before writing a 103 rejection...

- Resolve the *Graham v. Deere* factual inquiries
 - Factual Inquiry 1: Determine scope and content of the prior art
 - Determine primary reference
 - Determine whether the reference is:
 - » "visually similar";
 - » in existence; and
 - » analogous art to the claimed invention.
 - Factual Inquiry 2: Ascertain the differences between claimed invention and the prior art
 - Factual Inquiry 3: Resolve the level of ordinary skill
 - Factual Inquiry 4: Evaluate any secondary considerations
- Determine secondary reference(s)
 - Where a primary reference alone does not render the claimed design obvious, secondary references may be considered.
 - Determine whether the secondary reference is analogous art to the claimed invention.
- Establish *prima facie* case of obviousness
 - An examiner must **explain why** each modification or combination of prior art teachings would have been obvious to a designer of ordinary skill in the art in order to support the legal conclusion of obviousness.

Guidance for writing exercise

We have resolved the factual inquiries and established that an ordinary designer in the field of the claimed Pants design would have been motivated to modify Patent A's Pants with the camouflage design of Patent D's Backpack, as evidenced by matching camouflage designs applied to a backpack and pants shown in NPL B and C, to create the same overall visual appearance as the claimed Pants.

Now it is time to write up an obviousness rejection.

- Write a rejection under 35 U.S.C. 103 supported by the facts determined from the factual inquiries using the suggested format:
 - A. Description of what the primary reference teaches relative to the claimed invention.
 - B. Identification of what the differences are between the claimed invention and the primary reference.
 - C. Indication of what the secondary reference(s) teach(es) relative to the differences.
 - D. Explanation of how the primary reference is to be modified by each secondary reference to arrive at the claimed invention, and the rationale for making each modification.

Camouflage Pants Example - Writing exercise: Answer

The claim is rejected under 35 U.S.C. 103 as being unpatentable over Patent A's Pants in view of Patent D's Camouflage Backpack as evidenced by NPL B and NPL C.

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a designer having ordinary skill in the art to which the claimed invention pertains, the invention is not patentable. **(FP 15.19.aia)**

Patent A's Pants have an overall appearance with design characteristics that are visually similar to those of the claimed design, in that the pants have the same basic form of the article (pants).

The claimed design differs from Patent A's Pants in that the claimed design has a camouflage design.

Patent D's Camouflage Backpack teaches a camouflage design applied to the article of a backpack where the camouflage design is the same as the claimed design.

It would have been obvious to a designer of ordinary skill in the art before the effective filing date of the claimed design to modify Patent A's Pants with the camouflage design of Patent D's Camouflage Backpack because it is customary in the industry to follow market trends of applying a camouflage design to pants in order to appeal to consumers who want camouflage designs on their clothes and accessories, as evidenced by the NPL B and NPL C (showing camouflage designs applied to both pants and backpacks).

Washcloth Example

Washcloth Example

Title: Washcloth

Claim: The ornamental design for a Washcloth as shown and described.



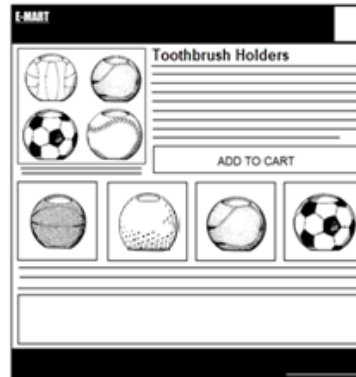
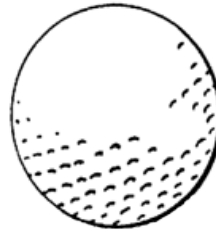
**Assume the application contains a sufficient number of views to constitute a complete disclosure of the appearance of the design.*

Washcloth Example (*cont.*)



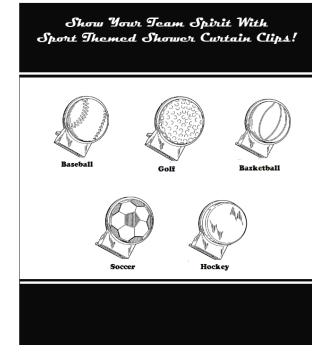
Claim: Washcloth

Patent A: Golf Ball Shaped Soap



NPL C: Toothbrush Holders

Patent B: Washcloth



NPL D: Shower Curtain Clips

Washcloth Example (*cont.*)

- Resolve the *Graham v. Deere* factual inquiries
 - Factual Inquiry 1: Determine scope and content of the prior art
 - Determine primary reference
 - Determine whether the reference is:
 - » "visually similar";
 - » in existence; and
 - » analogous art to the claimed invention.
 - Factual Inquiry 2: Ascertain the differences between claimed invention and the prior art
 - Factual Inquiry 3: Resolve the level of ordinary skill
 - Factual Inquiry 4: Evaluate any secondary considerations
- Determine secondary reference(s)
 - Where a primary reference alone does not render the claimed design obvious, secondary references may be considered.
 - Determine whether the secondary reference is analogous art to the claimed invention.
- Establish *prima facie* case of obviousness
 - An examiner must **explain why** each modification or combination of prior art teachings would have been obvious to a designer of ordinary skill in the art in order to support the legal conclusion of obviousness.

Washcloth Example – Question 1

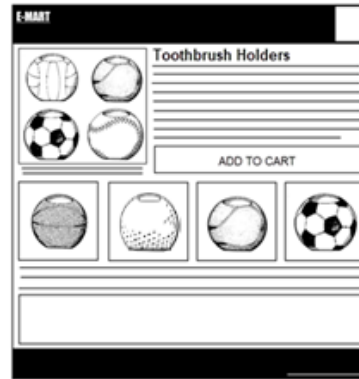
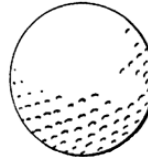
Which of these prior art references would reasonably be considered analogous to the claimed design?

Title: Washcloth



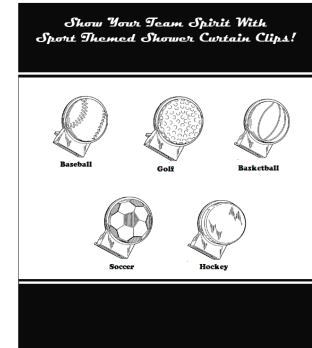
Claim: The ornamental design for a Washcloth as shown and described.

Patent A: Golf Ball Shaped Soap



NPL C: Toothbrush Holders

Patent B: Washcloth

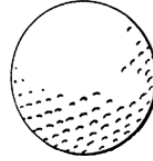


NPL D: Shower Curtain Clips

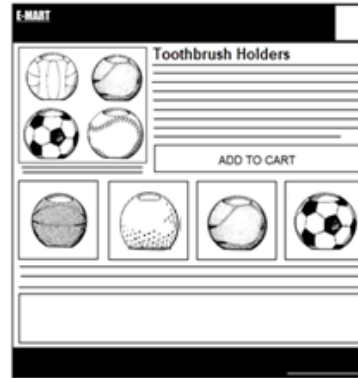
Washcloth Example – Question 1: Answer

- Each of the references are considered to be analogous to the claimed Washcloth design.
- Patent A's Golf Ball Shaped Soap, Patent B's Washcloth, NPL C's Toothbrush Holders, and NPL D's Shower Curtain clips are in the same field of endeavor as the claimed design (field of sports-related bathroom products)

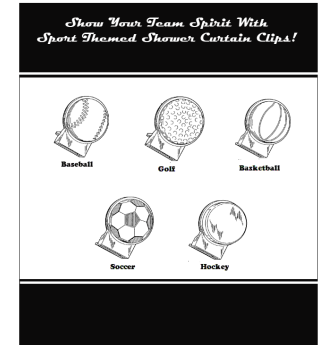
Patent A: Golf Ball Shaped Soap



Patent B: Washcloth



NPL C: Toothbrush Holders



NPL D: Shower Curtain Clips

Washcloth Example – Question 2

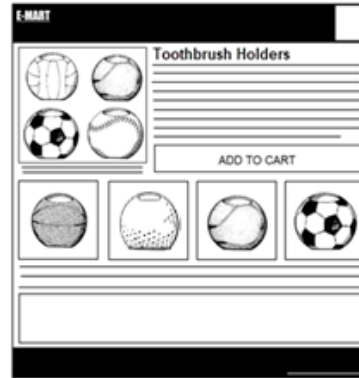
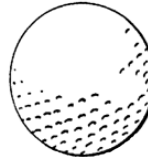
Identify which of these prior art references would reasonably be considered the **most visually similar** to the claimed design?

Title: Washcloth



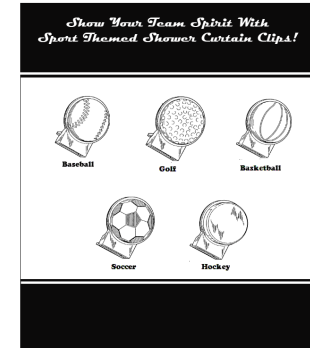
Claim: The ornamental design for a Washcloth as shown and described.

Patent A: Golf Ball Shaped Soap



NPL C: Toothbrush Holders

Patent B: Washcloth



NPL D: Shower Curtain Clips

Washcloth Example – Question 2: Answer

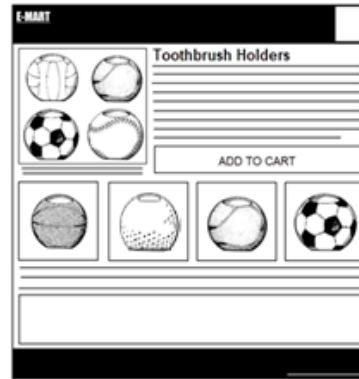
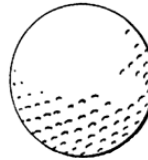
- While all prior art cited is analogous and something in existence, and may have some similar visual characteristics, Patent B appears to be the **MOST** visually similar to the claimed design.
- It would be reasonable for an examiner to determine that **Patent B** is the best primary reference.

Title: Washcloth



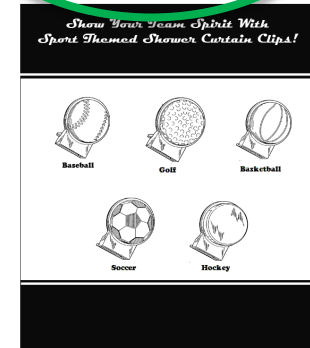
Claim: The ornamental design for a Washcloth as shown and described.

Patent A: Golf Ball Shaped Soap



NPL C: Toothbrush Holders

Patent B: Washcloth



NPL D: Shower Curtain Clips

Summary of factual inquiries for Washcloth Example

- **Factual Inquiry 1: Determine scope and content of the prior art**
 - Patent B has been identified as visually similar when compared to the claimed design, something in existence, and analogous art to the claimed design.
- **Factual Inquiry 2: Ascertain the differences between claimed invention and the prior art**
 - The primary reference (Patent B) has a soccer ball design attached to a washcloth whereas the claimed invention has a golf ball design attached to a washcloth.
- **Factual Inquiry 3: Resolve the level of ordinary skill**
 - The level of ordinary skill is a designer of ordinary capability who designs sports-related bathroom products.
- **Factual Inquiry 4: Evaluate any secondary considerations**
 - No secondary considerations to consider

Washcloth Example – Question 3

Given the available evidence, would it have been obvious for an ordinary designer in the field to which the claimed design pertains to have modified Patent B (primary reference) in view of Patent A and NPL C (secondary references) to create the same overall visual appearance as the claimed design?

Title: Washcloth



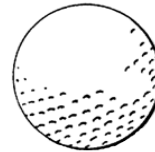
Claim: The ornamental design for a Washcloth as shown and described.

Patent B: Washcloth



Primary Reference

Patent A: Golf Ball Shaped Soap



Secondary Reference

NPL C: Toothbrush Holders



- A. No, it would not have been obvious for an ordinary designer in the field of the article of manufacture to have modified Patent B (primary reference) in view of Patent A's Golf ball shaped soap and NPL C's toothbrush holders because Patent A does not also teach a washcloth.
- B. Yes, it would have been obvious for an ordinary designer in the field of the article of manufacture to have modified Patent B (primary reference) in view of Patent A's Golf ball shaped soap and NPL C's toothbrush holders because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other.
- C. No, it would not have been obvious for an ordinary designer in the field of the article of manufacture to have modified Patent B (primary reference) in view of Patent A's Golf ball shaped soap and NPL C's toothbrush holders because, even though NPL C shows that different sports balls were known in the industry of bathroom articles, NPL C is not analogous to the claimed design. Therefore, it would not have been an obvious design choice to have modified Patent B with Patent A and NPL C to create the same overall appearance as the claimed design.
- D. Yes, it would have been obvious for an ordinary designer in the field of the article of manufacture to have modified Patent B (primary reference) with the golf ball design of Patent A because it is customary in the industry to follow market trends of substituting various sports balls with other sports balls in order to appeal to consumers who want bathroom products that reflect their sports interests, as evidenced by the varying sports ball toothbrush holders shown in NPL C (including a soccer ball and a golf ball).

Washcloth Example – Question 3: Answer

Given the available evidence, would it have been obvious for an ordinary designer in the field to which the claimed design pertains to have modified Patent B (primary reference) in view of Patent A and NPL C (secondary references) to create the same overall visual appearance as the claimed design?

Title: Washcloth



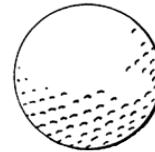
Claim: The ornamental design for a Washcloth as shown and described.

Patent B: Washcloth



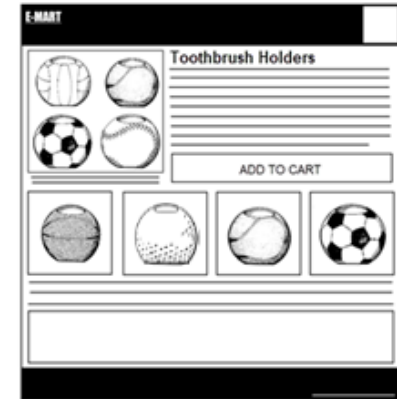
Primary Reference

Patent A: Golf Ball Shaped Soap



Secondary Reference

NPL C: Toothbrush Holders



- A. No, it would not have been obvious for an ordinary designer in the field of the article of manufacture to have modified Patent B (primary reference) in view of Patent A's Golf ball shaped soap and NPL C's toothbrush holders because Patent A does not also teach a washcloth.
- B. Yes, it would have been obvious for an ordinary designer in the field of the article of manufacture to have modified Patent B (primary reference) in view of Patent A's Golf ball shaped soap and NPL C's toothbrush holders because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other.
- C. No, it would not have been obvious for an ordinary designer in the field of the article of manufacture to have modified Patent B (primary reference) in view of Patent A's Golf ball shaped soap and NPL C's toothbrush holders because, even though NPL C shows that different sports balls were known in the industry of bathroom articles, NPL C is not analogous to the claimed design. Therefore, it would not have been an obvious design choice to have modified Patent B with Patent A and NPL C to create the same overall appearance as the claimed design.
- D. Yes, it would have been obvious for an ordinary designer in the field of the article of manufacture to have modified Patent B (primary reference) with the golf ball design of Patent A because it is customary in the industry to follow market trends of substituting various sports balls with other sports balls in order to appeal to consumers who want bathroom products that reflect their sports interests, as evidenced by the varying sports ball toothbrush holders shown in NPL C (including a soccer ball and a golf ball).



Summative Assessment: Washcloth Example Writing Exercise



Remember, before writing a 103 rejection...

- Resolve the *Graham v. Deere* factual inquiries
 - Factual Inquiry 1: Determine scope and content of the prior art
 - Determine primary reference
 - Determine whether the reference is:
 - » "visually similar";
 - » in existence; and
 - » analogous art to the claimed invention.
 - Factual Inquiry 2: Ascertain the differences between claimed invention and the prior art
 - Factual Inquiry 3: Resolve the level of ordinary skill
 - Factual Inquiry 4: Evaluate any secondary considerations
- Determine secondary reference(s)
 - Where a primary reference alone does not render the claimed design obvious, secondary references may be considered.
 - Determine whether the secondary reference is analogous art to the claimed invention.
- Establish *prima facie* case of obviousness
 - An examiner must **explain why** each modification or combination of prior art teachings would have been obvious to a designer of ordinary skill in the art in order to support the legal conclusion of obviousness.

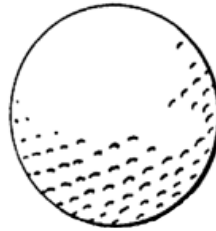
Washcloth Example

Title: Washcloth

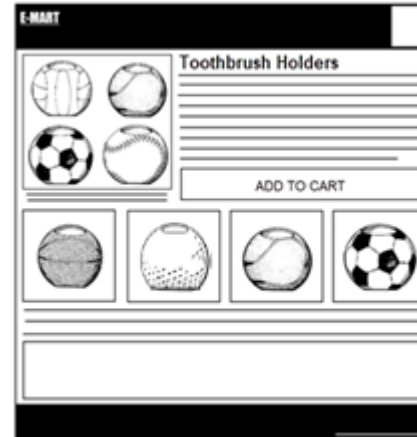


Claim: The ornamental design for a Washcloth as shown and described.

Patent A: Golf Ball Shaped Soap



Patent B: Washcloth



NPL C: Toothbrush Holders

Washcloth Example – Writing exercise

Using Patent B, Patent A, and the evidence provided in NPL C, set forth a *prima facie* case of obviousness by writing a rejection under 35 U.S.C. 103.

Title: Washcloth



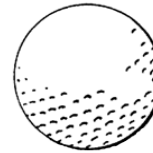
Claim: The ornamental design for a Washcloth as shown and described.

Patent B: Washcloth



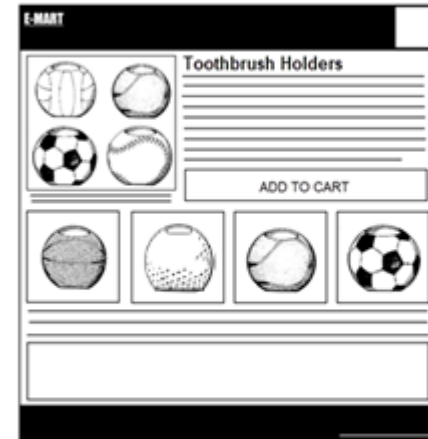
Primary Reference

Patent A: Golf Ball Shaped Soap



Secondary Reference

NPL C: Toothbrush Holders



Guidance for writing exercise

We have resolved the factual inquiries and established that an ordinary designer in the field of the claimed Washcloth design would have been motivated to modify Patent B's Washcloth with Patent A's Golf Ball Shaped Soap, as evidenced by the varying sports ball themed toothbrush holders shown in NPL C, to create the same overall visual appearance as the claimed Washcloth.

Now it is time to write up an obviousness rejection.

- Write a rejection under 35 U.S.C. 103 supported by the facts determined from the factual inquiries using the suggested format:
 - A. Description of what the primary reference teaches relative to the claimed invention.
 - B. Identification of what the differences are between the claimed invention and the primary reference.
 - C. Indication of what the secondary reference(s) teach(es) relative to the differences.
 - D. Explanation of how the primary reference is to be modified by each secondary reference to arrive at the claimed invention, and the rationale for making each modification.

Washcloth Example - Writing exercise: Answer

The claim is rejected under 35 U.S.C. 103 as being unpatentable over Patent B in view of Patent A as evidenced by NPL C.

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a designer having ordinary skill in the art to which the claimed invention pertains, the invention is not patentable. **(FP 15.19.aia)**

Patent B has an overall appearance with design characteristics that are visually similar to those of the claimed design, in that it shows a washcloth having an attached sports ball design.

The claimed design differs from Patent B in that the claimed design has an attached golf ball design instead of a soccer ball.

Patent A teaches a golf ball design for soap.

It would have been obvious to a designer of ordinary skill in the art before the effective filing date of the claimed design to modify Patent B with the golf ball design of Patent A (golf ball design replacing soccer ball design element), because such a modification would appeal to consumers who want bathroom products that reflect their sports interests. It is customary in the industry to follow market trends of offering consumers bathroom products that reflect a variety of sports interests, as demonstrated by the varying sports ball toothbrush holders shown in NPL C (including a soccer ball and a golf ball toothbrush holder).



Thank you!

