

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LOWE'S HOME CENTERS, LLC,
Petitioner,

v.

MAUREEN REDDY,
Patent Owner.

Case IPR2015-00306
Patent D677,423

Before JOSIAH C. COCKS, PHILLIP J. KAUFFMAN, and
BRIAN P. MURPHY, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION
Final Written Decision
35 U.S.C. § 318; 37 C.F.R. § 42.73

I. INTRODUCTION

Lowe's Home Centers, LLC ("Petitioner") filed a Petition requesting *inter partes* review of the claim in U.S. Patent No. D677,423 ("the '423 patent"). Paper 1 ("Pet."). Maureen Reddy ("Patent Owner") filed a Preliminary Response to the Petition. Paper 6. On April 28, 2015, we instituted an *inter partes* review of the claim as anticipated by, or obvious over, the Cohrs patent¹ pursuant to 35 U.S.C. § 102(b) and § 103. Paper 7.

Patent Owner filed a Corrected Patent Owner Response (Paper 10, "PO Resp."), and Petitioner filed a Reply (Paper 11, "Reply"). Petitioner relies on the Declaration of Mr. Cooper Woodring, an experienced industrial designer, in support of the Petition. Ex. 1004 ¶¶ 7–13. Patent Owner does not rely on declaration testimony in support of her Response.

We heard oral argument on December 11, 2015. A transcript of the oral hearing is entered as Paper 18 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

We determine Petitioner has shown by a preponderance of the evidence that the claim of the '423 patent would have been obvious to a designer of ordinary skill in view of the Cohrs reference, pursuant to 35 U.S.C. § 103. We further determine Petitioner has not shown by a preponderance of the evidence that the claim of the '423 patent is anticipated by the Cohrs reference pursuant to 35 U.S.C. § 102(b).

A. *Related Proceedings*

The parties identify a district court action, *Reddy v. Lowe's Cos.*, No. 13-

¹ U.S. Patent No. 7,156,537 B1, issued January 2, 2007, to Cohrs, on an application filed May 17, 2004. Ex. 1002 ("Cohrs").

CV-13016-IT, (D. Mass. filed Nov. 25, 2013), in which the '423 patent is at issue. Pet. 1; Paper 4, 1.

B. The '423 Patent

The '423 patent, titled “Bathroom Vanity Light Shade,” issued March 5, 2013, from an application filed March 8, 2012. Ex. 1001, 1. The '423 patent claims “[t]he ornamental design for a bathroom vanity light shade, as shown and described.” *Id.* The '423 patent describes the claimed light shade as “an ornamental fixture consisting of a rectangular, metal rod skeleton, wrapped in fabric on three sides (front side, left side, right side), with a stationary acrylic diffuser bottom. The bathroom vanity light shade mounts on the wall with top/back exposed mounting rod.” *Id.* at Description.

Figures 3 and 5 of the '423 patent are reproduced below as illustrative.

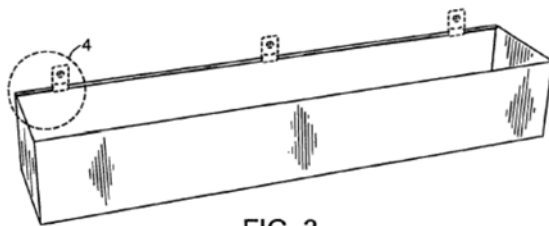


FIG. 3

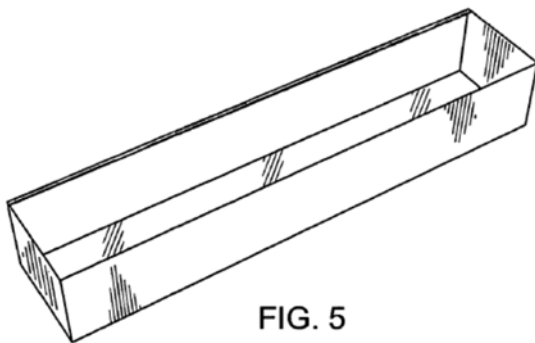


FIG. 5

Figures 3 and 5, above, are front perspective views and show the mounting rod (with and without mounting tabs, respectively) defining an ornamental edge between the open top and open back of the light shade (indicated by the absence of

line shading in these areas).² *Id.* The '423 patent figures use mandatory oblique line shading to indicate a translucent, transparent, or highly reflective surface on the bottom of the light shade (Fig. 5), and straight line shading on the front, left, and right sides to indicate those three vertical surfaces of the claimed light shade are opaque such that light does not pass through them. Pet. 4–5 (citing Ex. 1004 ¶¶ 32, 77; *Manual of Patent Examining Procedure* (MPEP) 1503.02(II) (8th ed., Rev. 9, Aug. 2012)). Figures 1 and 2 are to the same effect, and Figure 4 shows an enlarged view (close-up) of the mounting rod with a mounting tab depicted by broken-lines.

C. Asserted Grounds of Unpatentability

Petitioner asserts that the claimed ornamental design of the '423 patent is unpatentable as anticipated by Cohrs and obvious over Cohrs. Pet. 2–3. Patent Owner opposes. PO Resp. 1. We address the parties' arguments below.

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable interpretation in light of the patent specification. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs., LLC*

² We note the '423 patent states that the broken lines shown in Figure 3 (and Figure 4, not shown), which show mounting tabs attached to the mounting rod, “form no part of the claimed design.” Ex. 1001, Description; *see* MPEP 1503.02(III) (“Unclaimed subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used. Unclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof.”).

v. Lee, 136 S. Ct. 890 (mem.) (2016). When construing a design patent for an article that contains both functional and ornamental aspects, a patent owner “is entitled to a design patent whose scope is limited to [the ornamental] aspects alone and does not extend to any functional elements of the claimed article.” *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293–94 (Fed. Cir. 2010). “Design patents are typically claimed according to their drawings, and claim construction must be adapted to a pictorial setting.” *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1302 (Fed. Cir. 2010).

Petitioner proposes a construction that was adopted by the district court in the related district court action identified above, namely “the ornamental design for a bathroom vanity light shade, as shown and described in Figures 1–5.” Pet. 9–10 (quoting Ex. 1008). Patent Owner neither proposes a claim construction nor addresses Petitioner’s proposed construction. We agree with Petitioner’s proposed construction and construe the claim of the ’423 patent as “the ornamental design for a bathroom vanity light shade, as shown and described in Figures 1–5.”³

B. Asserted Anticipation of the ’423 Patent Claim by Cohrs

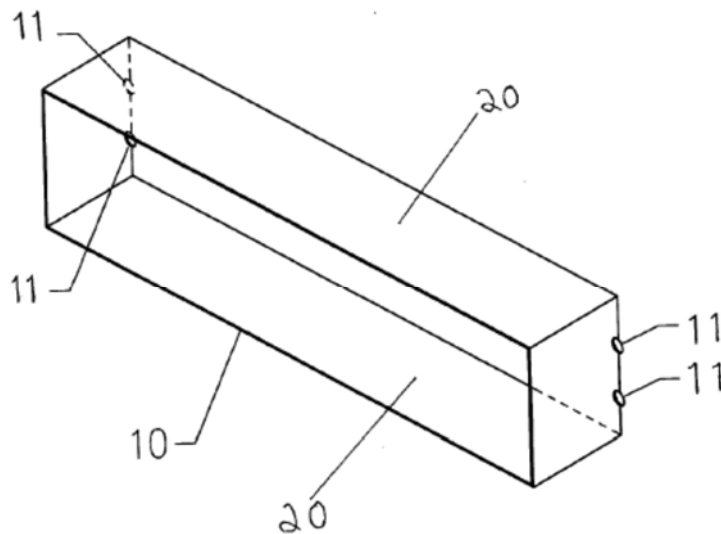
Petitioner argues that Cohrs Figure 6, as shown and described in the Cohrs patent, anticipates the ’423 patent claim. Pet. 15–22. Petitioner argues that Cohrs Figure 6 discloses the same overall visual appearance as the ’423 patent design, and asserts that the two designs share eleven “common visual features.” *Id.* at 15–16. Patent Owner responds that Cohrs Figure 6 does not anticipate because: i)

³ We consider the mounting rod only as an ornamental feature of the claimed design, not for its mounting function. See *Richardson*, 597 F.3d at 1293 (“[W]here a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.”) (citation omitted).

Cohrs is a utility patent, ii) the claims to Figure 6 were cancelled from the Cohrs patent application, iii) Cohrs is non-enabling and indefinite, iv) Cohrs does not satisfy the ordinary observer test, and v) Cohrs describes numerous possible design alternatives for Figure 6, which render Petitioner's asserted common features irrelevant. PO Resp. 3–32.

1. Cohrs

Cohrs issued on January 2, 2007, more than 5 years before the '423 patent's March 8, 2012 filing date. Ex. 1002, [45]. Cohrs is a utility patent directed to a light shade designed to fit over a strip light and be attached to a wall, such as in bathrooms or dressing rooms. *Id.* at 1:40–55. A strip light is an elongated light fixture “typically containing several bare bulbs, either clear or frosted.” *Id.* at 1:40–42, 54–57. The strip light is “typically mounted on a wall parallel to the floor and a short distance down from the ceiling . . . over a bathroom sink, counter or vanity.” *Id.* at 1:57–62. The bathroom vanity strip light shade optionally may have “a long opening on the top of the shade to allow more light to shine upward on the wall or ceiling.” *Id.* at 2:6–8. In addition to functional utility, Cohrs also discloses and describes decorative features of the bathroom vanity strip light shade, such as decorative colors, finishes, styles, patterns, and materials. *Id.* at Abstract, 2:16–24, 2:40–43, 4:46–48, 6:24–27. Cohrs Figure 6 discloses an embodiment of a vanity strip light shade, reproduced below.



Cohrs Figure 6, above, is a front perspective view of a strip light shade comprised of “a generally open rectangular box made of rods 10 typically of metal or strong plastic. . . . Various translucent plastic sheets 20 could be placed on some or all of the surfaces of this rectangular box which do not touch the wall, thereby shading the light fixture contained within the rectangular box.” *Id.* at 4:36–46, Fig. 6; *see* Ex. 1004 ¶ 69 (referring to Cohrs Figure 6 as a “tilted front perspective view[]”). Figure 6 depicts a rectangular box made of rods with translucent sheets 20 forming the top and bottom surfaces of the rectangular box. The use of broken and solid lines in Figure 6 illustrates an open front side and opaque, possibly translucent, side surfaces. *See* Tr. 9:18–10:6. The back side remains open to allow placement of the shade over a strip light for attachment to a wall using screw eyelets 11. Ex. 1002, 4:38–40. Cohrs states that other materials, “such as cloth, paper, wood products, rattan or similar materials,” may be attached to the frame of the open rectangular box “for a finished shade.” *Id.* at 6:24–27. Cohrs was not considered by the Examiner during prosecution of the application leading to issuance of the ’423 patent. Ex. 1001, [56]; Pet. 5 (citing Ex. 1004 ¶ 38).

2. Analysis

To anticipate a claim, a single prior art reference must disclose all limitations “arranged as in the claim,” either expressly or inherently. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). To be “arranged as in the claim,” the anticipatory reference must “show all of the limitations of the claims arranged or combined in the same way as recited in the claims, not merely in a particular order.” *NetMoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369–70 (Fed. Cir. 2008). In the context of design patents, the “ordinary observer test” is the sole test for determining whether a design patent is anticipated. *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009). Under the ordinary observer test, a design patent claim is unpatentable if, “in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other.” *Int’l Seaway*, 589 F.3d at 1239 (quoting *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871) (ordinary observer test applied in context of infringement)). The overall visual effect of the designs in question is used to determine whether the claimed design and the prior art design are substantially the same to an ordinary observer. *Crocs*, 598 F.3d at 1303.

a. *Cohrs qualifies as § 102(b) art in the design context*

“[T]he teachings in utility patents are within the prior art to be considered when determining the patentability of designs even though the patentability of a design may not be predicated on utilitarian or functional considerations.” *In re Aslanian*, 590 F.2d 911, 913 (CCPA 1979) (citations omitted). Patent Owner argues, as a threshold matter, that because *Cohrs* is a utility patent it is “fundamentally different from Patent Owner’s design patent,” and that *Cohrs*

discloses a “non-aesthetic, functional shade.” PO Resp. 1; *see also id.* at 1–2 (describing the Figure 1 embodiment of Cohrs, but not Figure 6 on which Petitioner relies). As Petitioner notes, Patent Owner does not cite any case law to support the argument, which is at odds with well-settled law that teachings of a prior art utility patent may be considered in a design context. Reply 6–7 (citing *Aslanian*, 590 F.2d at 913). Cohrs, moreover, expressly discloses decorative, ornamental design features for a bathroom vanity strip light shade, including features such as decorative colors, finishes, styles, patterns, and materials. Ex. 1002, Abstract, 2:16–24, 2:40–43, 4:46–48, 6:24–27. Thus, Patent Owner’s argument, that because Cohrs is a utility patent it does not disclose relevant design features, is misplaced. Patent Owner’s argument focuses on the functional description in Cohrs, particularly with respect to Figure 1, but does not address the non-functional illustrations and description in Cohrs. Therefore, we are not persuaded by Patent Owner’s argument that the utilitarian nature of Cohrs disqualifies it as a prior art reference to the ’423 design patent.

Patent Owner further states that patent claims directed to Cohrs Figure 6 were canceled during prosecution of the Cohrs patent application. PO Resp. 3–5 (citing Ex. 2002, 2004). From this fact, Patent Owner draws the unsupported conclusion that “where no claims for a[n] ‘open rectangular box made of rods’ exist in the Cohrs Patent” and where “the drawing and description of Fig. 6 are vague and ambiguous,” Cohrs is “insufficient” as prior art to anticipate the ’423 patent or render it obvious. *Id.* at 5–6. Patent Owner does not offer any case citations or further analysis to support her conclusion. “The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir.

1983); *see also In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006). Furthermore, cancelling claims does not negate their status as prior art. *See Johnson & Johnston Assocs., Inc. v. R.E. Serv. Co.*, 285 F.3d 1046, 1054 (Fed. Cir. 2002) (en banc) (“[W]hen a patent drafter discloses but declines to claim subject matter, as in this case, this action dedicates that unclaimed subject matter to the public.”).

Therefore, we are not persuaded by Patent Owner’s conclusory argument that cancelation of claims in Cohrs directed to Figure 6 renders Cohrs insufficient as prior art.

For the reasons given above, we conclude that Cohrs qualifies as § 102(b) prior art to the ’423 design patent.⁴

b. Cohrs is an enabling reference

Patent Owner argues that Cohrs is not enabled and is indefinite because Figure 6 “is internally inconsistent and does not enable a reader to recreate the invention, since the figure referenced is not accurately defined in the description.” PO Resp. 8, 11–12.

Patent Owner first confuses the requirement that an asserted anticipatory reference be sufficiently enabling to one of ordinary skill in the art, with the definiteness requirement of 35 U.S.C. § 112, second paragraph. To the extent Patent Owner asserts Cohrs is indefinite under 35 U.S.C. § 112, second paragraph, the argument fails because definiteness relates to patent claims under scrutiny, here

⁴ Patent Owner also states that Cohrs Figure 6 fails to meet the requirements of MPEP § 2125 because it allegedly does not “clearly show” the ’423 patent claim. PO Resp. 6–7. Patent Owner concludes, therefore, that Cohrs Figure 6 cannot anticipate or render obvious the ’423 patent claim. *Id.* at 7. Even if MPEP § 2125 were applicable, “[t]he drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art.” MPEP § 2125 (citing *Aslanian*, 590 F.2d at 911).

the '423 patent claim, not the claims in a prior art disclosure. *See* 35 U.S.C. § 112, second paragraph.⁵ Patent Owner also improperly quotes two separate paragraphs from Cohrs under the heading “Alternative Embodiments” as one continuous paragraph, without explanation. PO Resp. 9–10 (quoting Ex. 1002, 6:14–29). The first quoted paragraph discloses the alternative of manufacturing a finished strip light shade in several pieces and assembling the pieces prior to installation, for example when end caps are attached to the formed, half-cylindrical shade of Figure 1. Ex. 1002, 3:53–59, 6: 14–19. Patent Owner does not explain the relevance of the first quoted paragraph to her argument, although Patent Owner implies that it somehow relates to Cohrs Figure 6. PO Resp. 10–11. We fail to see the import of Patent Owner’s quotation to a description of Cohrs Figure 1, in connection with the argument that Cohrs would not have enabled one of ordinary skill in the art of light shade design to practice an embodiment of Figure 6, without undue experimentation. *Id.* at 8–12; *see Am. Calcar, Inc. v. Am. Honda Motor Co.*, 651 F.3d 1318, 1341 (Fed. Cir. 2011) (“To be anticipatory, a reference must describe, either expressly or inherently, each and every claim limitation and enable one of skill in the art to practice an embodiment of the claimed invention without undue experimentation.” (citing *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009))).

Patent Owner further conflates arguments distinguishing Cohrs Figure 6 from the '423 patent claim, which are indeed relevant to an assessment of anticipation under the ordinary observer test, with Patent Owner’s argument that Cohrs is non-enabling. PO Resp. 8–10. Prior art is presumed to be enabling, and

⁵ We note that this *inter partes* review proceeding is limited to consideration of whether the '423 patent claims being challenged are anticipated or obvious over prior art patents and printed publications under 35 U.S.C. §§ 102 and 103. 35 U.S.C. § 311(b).

Patent Owner bears the burden of presenting persuasive evidence to overcome the presumption. *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003) (“[We] hold a presumption arises that both the claimed and unclaimed disclosures in a prior art patent are enabled. . . . If a patentee presents evidence of nonenablement that a trial court finds persuasive, . . . then the presumption has been overcome.”).⁶ Patent Owner has not provided declaration testimony or persuasive evidence to satisfy Patent Owner’s burden of persuasion on this issue. In contrast, Petitioner provides a Supplemental Declaration of Mr. Woodring, who opines that the technology of light shades is simple enough that the Cohrs disclosure is sufficient to enable a designer of ordinary skill in the art to create the embodiment of Figure 6 without undue experimentation. Ex. 1010 ¶¶ 11–12. Patent Owner did not make of record any cross-examination testimony of Mr. Woodring.

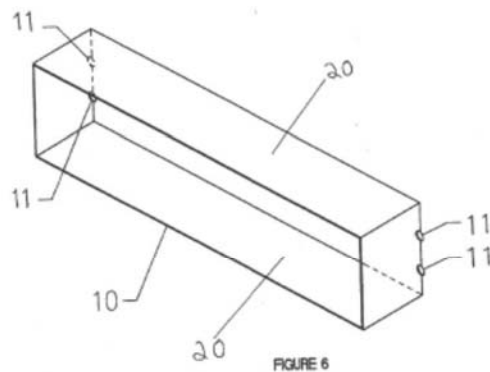
Having reviewed the evidence, including the unrebutted testimony of Mr. Woodring, we conclude Patent Owner has not satisfied her burden of overcoming the presumption that Cohrs is an enabling prior art reference.

c. The Ordinary Observer Test

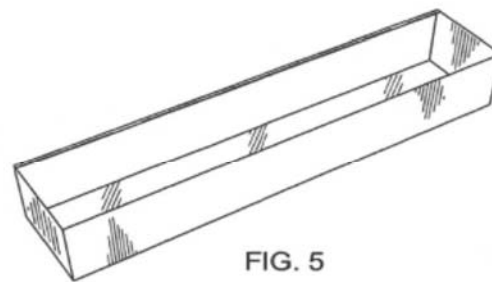
Petitioner argues that Cohrs Figure 6 is substantially the same as the ornamental design claimed in the ’423 patent and that both have a “virtually identical overall visual appearance.” Pet. 15–16 (citing Ex. 1004 ¶¶ 69–70).

⁶ For an obviousness analysis under 35 U.S.C. § 103, discussed in Section II.C. below, a prior art reference need not be enabled, and the reference qualifies as prior art for all that it teaches one of ordinary skill in the art. *See Amgen*, 314 F.3d at 1357; *see also Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989) (“Even if a reference discloses an inoperative device, it is prior art for all that it teaches”).

Petitioner presents a visual comparison of Cohrs Figure 6 and the '423 patent Figure 5, reproduced below.



Cohrs '537 Patent's Fig. 6



Reddy '423 Patent's Fig. 5

Cohrs Figure 6, above left, uses solid lines and hidden broken lines to depict a strip light shade in the shape of a rectangular box made of rods 10. Ex. 1002, 4:36–38, Fig. 6. The strip light shade has an open front, open back, and translucent top and bottom surfaces specifically identified as “translucent plastic sheets 20.” *Id.* at 4:43; Tr. 9:18–10:24. Although Petitioner identifies multiple design elements that Petitioner asserts Cohrs Figure 6 shares with the '423 patent, there are several design differences between Cohrs Figure 6, as depicted, and the light shade claimed in the '423 patent. The top surface depicted in Cohrs Figure 6 is a translucent plastic sheet rather than an open top as claimed in the '423 patent. Therefore, the rod shown at the interface of the top and back surfaces does not define an ornamental edge between an open top and open back as claimed in the '423 patent. The front surface depicted in Cohrs Figure 6 is open, not opaque as claimed in the '423 patent. The side surfaces depicted in Cohrs Figure 6 are opaque, or possibly translucent, as indicated by the use of solid and hidden broken lines, although the side surfaces in Figure 6 are not identified as translucent in contrast to the specifically numbered translucent top and bottom surfaces. Ex.

1002, 4:43–45 (“translucent plastic sheets 20 could be placed on some or all of the surfaces . . . which do not touch the wall”), 6:24–27 (“attaching materials, such as cloth, paper, wood products, rattan or similar materials to the frame for a finished shade”); Tr. 11:17–25, 15:9–16:2.

Petitioner asserts eleven common design elements between Cohrs Figure 6 and the ’423 patent claim including: a rectangular design having flat surfaces, 90° corners, proportionally thin surfaces, plain interiors, similar height-to-width and length-to-width ratios, open backs and *open tops*, *opaque vertical surfaces*, and *rods along the top/back edge*. Pet. 16 (emphases added). Many of the recited design elements are, indeed, common between the two designs. We do not agree, however, that Cohrs Figure 6 *as depicted* shows an opaque front (vertical) surface or an open top such that the rod forms an ornamental top/back edge as claimed in the ’423 patent, for the reasons given immediately above.

Petitioner states that Cohrs discloses the option of covering any combination of surfaces except for the back, which must remain open to permit the light shade to cover the wall-mounted light fixture. Pet. 18 (citing Ex. 1002, 4:35–45; Ex. 1004 ¶¶ 42, 44). Petitioner argues, therefore, that Cohrs Figure 6 discloses a rectangular box light shade that has a translucent bottom, three vertical sides covered in an opaque material, an open back and an open top with a metal rod forming an ornamental top/back edge of the light shade. *Id.* at 18–21 (citing Ex. 1004 ¶¶ 42, 44, 73–80). Petitioner concludes that the disclosure of Cohrs is such that an ordinary observer “would be deceived into believing that, taken as a whole, the Cohrs and ’423 Patents are even more alike than the ‘substantially similar’ standard required for anticipation under 35 U.S.C. § 102(b).” *Id.* at 22 (citing *Int’l Seaway*, 589 F.3d at 1240; Ex. 1004 ¶ 81). Petitioner further argues, in reply to Patent Owner’s response, that a “designer of ordinary skill . . . reading Cohrs

would envisage each of the features identified” in the ’423 patent claim. Reply 10–11. Petitioner relies on the case of *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, which stands for the proposition that even if a prior art reference does not expressly spell out all the limitations arranged as in the claim, the reference still anticipates if one of ordinary skill in the art could “*at once envisage* the claimed arrangement or combination.” *Id.* (citing *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1381 (Fed. Cir. 2015) ((emphasis added))).

The ’423 patent describes five design elements for the vanity strip light shade shown in Figures 1–5: (i) “a rectangular, metal rod skeleton;” (ii) “wrapped in fabric [an opaque surface] on three sides (front side, left side, right side);” (iii) an “acrylic diffuser bottom” (a translucent or transparent surface); (iv) an open back, and (v) an open top with a “top/back exposed mounting rod.” Ex. 1001, Description, Figs. 1–5; Pet. 3–5. Petitioner argues that an ordinary observer “would envisage” Cohrs Figure 6 arranged as in the ’423 patent claim with all of the enumerated design elements. Reply 11 (citing Ex. 1010 ¶¶ 15–16); *see also* Pet. 22 (“[A]n ordinary observer familiar with the relevant prior art would be deceived into believing that . . . the Cohrs and ’423 Patents are even more alike than the “substantially similar” standard required for anticipation.”). The difficulty with Petitioner’s anticipation argument is that it does not explain persuasively why an ordinary observer would immediately envisage all design elements arranged as in the ’423 patent claim, from the description of Figure 6 in Cohrs.

Cohrs discloses the option of placing translucent plastic sheets “on some or all” of the five rectangular shade surfaces that do not touch the wall, and attaching materials such as “cloth, paper, wood products, rattan or similar materials” for a “finished” shade. PO Resp. 21–22 (emphasis omitted). For example, from Cohrs’ teaching to place translucent sheets on some or all available sides, one of ordinary

skill would have to place a translucent plastic sheet on the bottom, but not the top or sides, of the rectangular box so that a rod forms an ornamental top/back edge. Similarly, from the teaching that cloth, paper, wood, rattan, or similar materials might be attached to form a finished shade, one of ordinary skill would have to attach opaque materials on the three available vertical surfaces, including an opaque rather than open front. These particular design modifications to Cohrs Figure 6, however straightforward they might be to a designer of ordinary skill, would need to be made in order to deceive an ordinary observer, “inducing him to purchase one [modified Cohrs Fig. 6] supposing it to be the other [’423 patent].” *Gorham*, 81 U.S. at 528; *Int’l Seaway*, 589 F.3d at 1239. Therefore, we conclude that the claimed arrangement would not be so immediate that an ordinary observer would “at once envisage” the ’423 patented design from Cohrs Figure 6, as shown and described, to satisfy the rigorous standard for design patent anticipation.

For the reasons given above, we determine Petitioner has not established by a preponderance of the evidence that Cohrs Figure 6 anticipates the ’423 patent claim under 35 U.S.C. § 102(b).

C. Asserted Obviousness of the ’423 Patent Claim over Cohrs

Petitioner argues in the alternative that, if Cohrs does not anticipate the ’423 patent claim, then Cohrs “readily suggests” to a designer of ordinary skill the “minor modifications” necessary to render the claimed design unpatentable as obvious over Cohrs. Pet. 22–23 (citing *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1335 (Fed. Cir. 2014); *High Point Design, LLC v. Buyer’s Direct, Inc.*, 730 F.3d 1301, 1314–15 (Fed. Cir. 2013); Ex. 1004 ¶¶ 83–86). Patent Owner opposes, arguing that i) the original claims for Cohrs Figure 6 were canceled during prosecution, ii) Cohrs Figure 6 fails to comply with MPEP § 2125,

iii) Cohrs Figure 6 is ambiguous and the Cohrs patent “indefinite” under 35 U.S.C. § 112, second paragraph, and iv) secondary considerations support the nonobviousness of the ’423 patent claim. PO Resp. 32–40. We address the parties’ arguments below.

For design patents, “the ultimate inquiry under section 103 is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *MRC Innovations*, 747 F.3d at 1331 (citations omitted). Obviousness under 35 U.S.C. § 103 requires an assessment of underlying factual inquiries including (1) the “level of ordinary skill in the pertinent art,”⁷ (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,”⁸ and (4) “secondary considerations” of nonobviousness such as “commercial success, long-felt but unsolved needs, failure of others, etc.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966)). More specifically for design patents, the relevant obviousness inquiry is a two-step process. First, we must identify a single reference, “a something in existence, the design

⁷ Mr. Woodring’s Declaration describes the skill and experience level of one of ordinary skill as a degreed industrial designer or design engineer having “some experience designing the ornamental appearance of consumer products” such as lamp shades. Ex. 1004 ¶¶ 7–8, 14–17. Patent Owner does not rebut Mr. Woodring’s definition of a designer of ordinary skill in the art. We find Mr. Woodring’s definition to be adequately supported. We apply Mr. Woodring’s definition – an industrial designer or design engineer having some experience designing consumer products such as lamp shades – in our analysis of whether the ’423 patent would have been obvious to one of ordinary skill at the time the ’423 patent application was filed in March 2012.

⁸ We rely on our previous discussion, in Section II.B., of the scope and content of Cohrs and any differences between Cohrs Figure 6 as depicted and the ’423 patent claim, for our obviousness analysis.

characteristics of which are basically the same as the claimed design.” *MRC Innovations*, 747 F.3d at 1331 (quoting *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982)). The “basically the same” test requires consideration of the “visual impression created by the patented design as a whole.” *Id.* The second step requires a determination of whether any secondary reference is “so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *Id.* (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

1. Cohrs Qualifies as a Rosen Reference

We begin by analyzing the disclosure of Cohrs in connection with Figure 6 according to the *Rosen* test. Cohrs discloses an “open rectangular box made of rods” that is substantially the same as the “rectangular, metal rod skeleton” described in the ’423 patent. Pet. 6 (citing Ex. 1002, 4:35–43; Ex. 1004 ¶¶ 41, 43), 21 (citing Ex. 1004 ¶ 80); Ex. 1001, Description. The vanity strip light shade of Cohrs Figure 6 has flat side surfaces, sharp non-radiused 90° corners, proportionately thin surfaces, plain interiors, proportionately similar height-to-width and length-to-width ratios, and an open back, which provide Cohrs Figure 6 with “basically the same” overall size, shape, structure, and visual appearance as the vanity strip light shade shown in Figures 1–5 of the ’423 patent. Pet. 5, 15–19 (citing Ex. 1004 ¶¶ 39, 69–73). Cohrs, moreover, expressly discloses placing translucent plastic sheets “on some or all” of the strip light shade surfaces except for the open back area that touches the wall (to allow for mounting over a strip light), which would include an “acrylic diffuser bottom” as described and shown in the 423 patent. *Id.* at 6–7 (citing Ex. 1002, 4:43–45), 18 (citing Ex. 1004 ¶¶ 42, 44). Cohrs further discloses the option of attaching alternate materials such as “cloth” to the “open rectangular box made of rods,” similar to the vertical surfaces

“wrapped in fabric” in the ’423 patent, to produce “a finished shade.” *Id.* at 6–7 (citing Ex. 1002, 6:24–28), 20–21 (citing Ex. 1004 ¶¶ 75–79).

Petitioner quotes from Patent Owner’s deposition transcript in this proceeding, where Patent Owner acknowledged that Cohrs discloses a rectangular vanity light shade that could be covered with cloth or other materials in a way that is “similar to the design claimed in [the ’423] patent.” Reply 2–3 (citing Ex. 1009, 70:5–71:3). Patent Owner also admitted several of the many points of similarity between Cohrs Figure 6 and the ’423 patent as explained by Mr. Woodring. *Id.* at 3–4 (citing Ex. 1009, 69:17–19 (“Q. It’s the same shape as the design in your patent, correct? A. Yes.”), 70:2–4 (“Q. And it has 90 degree angles at the corners? A. Uh-huh.”), 70:17–21 (“Q. So this patent discloses a rectangular vanity shade that could be covered with cloth or other materials, correct? A. Yes.”)). Patent Owner’s sworn deposition testimony is consistent with, and reinforces, Mr. Woodring’s Declaration testimony.

Patent Owner attempts to rebut Mr. Woodring’s eleven points of similarity between Cohrs Figure 6 and the ’423 patent, based on the premise that Cohrs Figure 6 is ambiguous and “can be construed to have an indefinite amount of design outcomes.” PO Resp. 21; *see also id.* at 13 (the visual appearance of Cohrs Figure 6 “is not known until the invention is fully assembled and finished” (emphasis omitted)).⁹ Patent Owner then attempts to “interpret” possible outcomes using a Cohrs “base kit” that allegedly represents Cohrs Figure 6, such as a “swag” interpretation, a “rattan” interpretation, an “inside painted plastic” interpretation, and a “bamboo” interpretation. *Id.* at 22–32. First, as explained previously,

⁹ We also addressed two of Patent Owner’s non-obviousness arguments, that Cohrs Figure 6 is ambiguous or indefinite and the corresponding patent claims were cancelled during prosecution, in Section II B.2. of this Decision.

Patent Owner relies on a description of assembling light shade components of a different embodiment than Cohrs Figure 6. *Id.* at 13 (quoting Ex. 1002, 6:14–23). Second, even if assembly of Cohrs Figure 6 were necessary, Patent Owner’s interpretations of various “kit” patents (*id.* at 14–20) are of little relevance to the issue of whether Cohrs discloses the same basic design of the vanity strip light shade claimed in the ’423 patent. Third, Patent Owner’s “interpretations” of Cohrs Figure 6 (*id.* at 22–32) distort the actual disclosure of Cohrs relating to Figure 6 and amount to unsupported fact and/or expert testimony not in compliance with our rules. *See* 37 CFR §§ 42.53(a) (“Uncompelled direct testimony must be submitted in the form of an affidavit.”), 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”). For example, the swag and rattan interpretations alter the size, shape (a generally open rectangular box), and height-to-width ratios of Cohrs Figure 6 without explanation. PO Resp. 25–28. The inside painted plastic interpretation takes even greater unexplained liberties with the actual disclosure of Cohrs, postulating a design that alters the size, shape, 90° corners, and length-to-width ratio of Cohrs Figure 6. *Id.* at 29–30. In short, we are persuaded more by Patent Owner’s sworn deposition testimony than by her unsworn interpretations of Cohrs Figure 6.

MPEP § 2125, titled “Drawings as Prior Art,” relates that drawings in a design patent or utility patent “can anticipate or make obvious the claimed invention.” MPEP § 2125(I). This provision also provides that drawings in utility patents “must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art.” *Id.* (citing *Aslanian*, 590 F.2d at 911). Patent Owner, citing MPEP § 2125 but omitting the quote from *Aslanian*, argues that Cohrs Figure 6 does not meet the requirements of MPEP § 2125 because the drawing

does not clearly show the design claimed in the '423 patent. PO Resp. 6–7, 33. Patent Owner's argument, however, misapprehends the law and the Petition. The obviousness ground of unpatentability is based not on Cohrs Figure 6 alone, but on Cohrs Figure 6 in combination with the teachings of Cohrs as understood by an industrial designer or design engineer of ordinary skill in the art. Cohrs Figure 6, when read in light of the Cohrs specification for what it reasonably teaches an industrial designer or design engineer of ordinary skill, discloses the same basic design claimed in the '423 Patent. Ex. 1004 ¶¶ 81, 83–84, 86.

For the reasons given above, we find that Cohrs Figure 6, read in light of the Cohrs specification from the perspective of an ordinarily skilled designer, discloses basically the same visual impression as the vanity strip light shade of the '423 patent claim. Therefore, we determine that Cohrs Figure 6, as shown and described in Cohrs, qualifies as a *Rosen* reference.

2. *Suggestion of the translucent diffuser bottom, open top, and opaque vertical surfaces in Cohrs*

Petitioner persuasively argues that Cohrs teaches a designer of ordinary skill the option to use a translucent bottom surface, which matches the “acrylic diffuser” bottom and open top described and shown with appropriate line shading in Figures 1, 2, and 5 of the '423 patent. Pet. 6–7 (citing Ex. 1004 ¶¶ 41, 42, 44), 15–21 (citing Ex. 1004 ¶¶ 75–79); Reply 11–12 (citing Ex. 1010 ¶¶ 11–12, 14–18). Patent Owner responds that the drawing of Cohrs Figure 6 is “ambiguous” and “it is unclear which surfaces are translucent” in Figure 6. PO Resp. 7–9. Patent Owner also maintains that Cohrs Figure 6 indicates a translucent plastic sheet for the top surface, but Patent Owner does not directly address Petitioner's argument, the detailed description of alternative design options in Cohrs, or Mr. Woodring's testimony. *Id.* at 7–11, 20, 22–23, 33. Patent Owner also fails to cite rebuttal

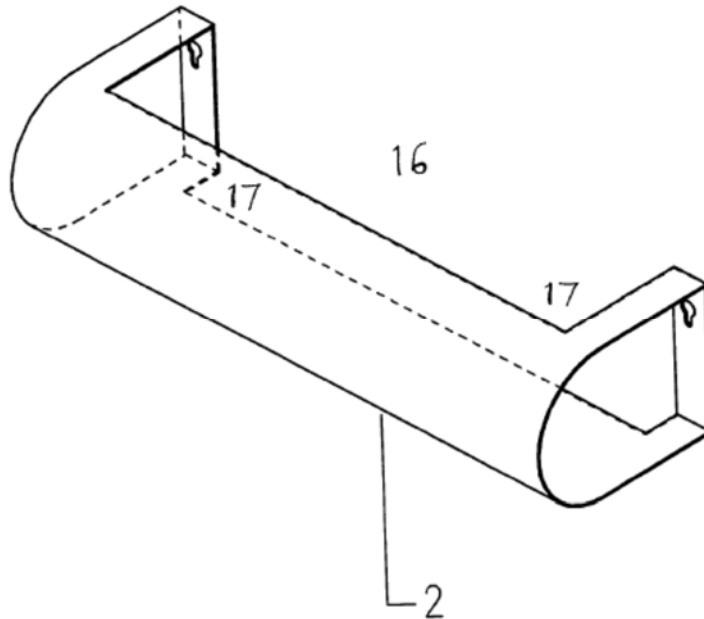
testimony or cross-examination testimony of Mr. Woodring in support of Patent Owner's argument.

We are persuaded by Mr. Woodring's testimony, in rebuttal to Patent Owner's Response, that a designer of ordinary skill reading Cohrs would understand the desirability of leaving the top surface open "to achieve the desired effect of venting heat from the fixture." Ex. 1010 ¶¶ 15–16. Cohrs describes the open top effect in some detail, and illustrates the design impact of a strip light shade having a bottom diffuser to diffuse light shining down on the bathroom sink or vanity, an open top and open back surfaces. Ex. 1002, 1:61–63 ("strong light over a bathroom sink, counter or vanity . . . can be too bright and glaring in the eyes"), 2:6–8 ("a long opening on the top of the shade to allow more light to shine upward on the wall or ceiling"), 2:12–15 ("[t]ranslucent sheets . . . may be positioned inside the shade or over the outside to produce decorative effects"), 2:38–39 ("a shade which diffuses intense glare from exposed light bulbs"), 2:54–56 (quoted below), 4:15–18 (Figure 3 shows "a rectangular cut out 17 in the top of a curved surface 2 to allow more light to escape from the fixture and be reflected from the ceiling or wall"), 4:29–30 (Figure 4 shows "[c]utouts 17 and back rectangular opening 16"), 4:43–48 ("translucent plastic sheets 20 could be placed on some or all of the surfaces of this rectangular box which do not touch the wall"), 5:3–5 ("ventilation holes above the bulbs to dissipate heat"); Reply 11–12 (citing Ex. 1004 ¶ 86; Ex. 1010 ¶¶ 11–12, 14–18); *see also* Ex. 1002, Figs. 3–4. Cohrs discloses, in particular:

a shade which diffuses the direct light from bare bulbs in a strip light, yet which may have an opening near the top to let stronger light bounce off the ceiling.

Ex. 1002, 2:54–56.

Cohrs Figure 3 discloses an exemplary strip light shade having an open top and open back, reproduced below.



Cohrs describes Figure 3, above, as showing rectangular cutout 17 encompassing most of the top surface of the strip light shade and back rectangular opening 16. *Id.* at 4:15–18. We are persuaded by the teachings in Cohrs and Mr. Woodring’s testimony that a designer of ordinary skill reading Cohrs would have had little difficulty designing a decorative vanity strip light shade, in accordance with Cohrs Figure 6, having a translucent plastic sheet on the bottom to diffuse light shining down on the bathroom sink and vanity, and having a rectangular open top to ventilate heat and allow light to shine up on the wall and ceiling. Ex. 1010 ¶¶ 14–16. Given Cohrs’ express disclosure that the rectangular back of the shade must be open to allow mounting over a strip light, such a design would result in an ornamental rod defining the top/back edge of the vanity strip light shade. *Id.* Therefore, we find by a preponderance of the evidence that Cohrs Figure 6, read in light of the Cohrs specification from the perspective of an ordinarily skilled

industrial designer, would have readily disclosed a strip light shade having a translucent bottom, open top, and open back arrangement with a rod defining an ornamental top/back edge.

We are further persuaded that Cohrs discloses a light shade shown and described in Figure 6, where the vertical surfaces of the open rectangular box of rods (front, left, and right sides) are covered in opaque cloth or other opaque material. Pet. 6–7 (citing Ex. 1002, 3:18–20, 4:35–45, 6:24–28; Ex. 1004 ¶¶ 41–44), 16, 18–21 (citing Ex. 1004 ¶¶ 70, 73–79). In particular, we are persuaded by Mr. Woodring’s testimony that Cohrs discloses the design concept of using opaque cloth or fabric (or other opaque materials such as wood) on the front and two sides of a vanity strip light shade, as would be understood by an ordinarily skilled designer. Ex. 1004 ¶¶ 78–79 (one of ordinary skill “would understand that these materials identified in the Cohrs Patent, ‘cloth, paper, wood products, rattan, or similar materials’ are opaque.”). For example, covering the front and sides with opaque cloth or fabric would provide an ornamental design element to the shade, even though an additional motivation for using opaque material would be to hide the bare strip light bulbs from view. Reply 11 (citing Ex. 1010 ¶ 15); Ex. 1002, 1:61–63 (a strip light “can be too bright and glaring in the eyes”), 2:16–24 (the invention “offer[s] consumers an affordable, decorative and functional option . . . by covering the exposed light bulbs with a decorative shade or diffuser . . . offered in a variety of decorative colors, finishes, and styles”), 2:38–39 (the shade “diffuses intense glare from exposed light bulbs”), 2:48–49 (the shade “hides dust on the bulbs and light fixture and is much easier to clean”). Such straightforward design features are adequately described in Cohrs so as to suggest a finite number of known design alternatives to be used in an ornamental vanity strip light shade, to an industrial designer or design engineer of ordinary skill. *See KSR*, 550 U.S. at

421 (“When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.”).

Patent Owner argues that Cohrs Figure 6 differs from the ’423 patent because Cohrs Figure 6 illustrates a light shade with: i) a translucent top, rather than an open top and open back with a rod defining an ornamental top/back edge, ii) two non-opaque sides, iii) a single rod at the bottom front of the design, and iv) four screw eyelets. PO Resp. 6–11.¹⁰ To the extent the light shade depicted in Cohrs’ Figure 6 differs from the claimed design of the ’423 patent, Cohrs itself suggests the straightforward modifications to Figure 6 that bridge any gap in the two designs. Cohrs describes the option of covering or not covering any side except the open back, which includes having an uncovered open top. *See* Ex. 1002, 4:43–46 (“Various translucent plastic sheets 20 could be placed on some or all of the surfaces of this rectangular box which do not touch the wall, thereby shading the light fixture contained within the rectangular box.”) In that respect, the light shade design shown and described in Cohrs readily suggests to a designer of ordinary skill the straightforward modifications that would render the claimed design unpatentable as obvious over Cohrs Figure 6. *See KSR*, 550 U.S. at 417, 421 (“If a person of ordinary skill can implement a predictable variation, § 103

¹⁰ As noted previously, the screw eyelets in the ’423 patent drawings do not form any part of the claimed design and are, therefore, depicted using broken lines. *See* MPEP 1503.02(III) (“Unclaimed subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used. Unclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof.”).

likely bars its patentability. . . . When there is a design need . . . to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp.”). Given that the overall visual impression of Cohrs Figure 6 and the ’423 patent are basically the same, with the two designs sharing significant design similarities enumerated above, and given that Cohrs itself suggests straightforward design alternatives applicable to Figure 6, we are persuaded by Petitioner’s obviousness argument.

3. *Secondary considerations*

Patent Owner argues secondary considerations of i) a recognized problem of “cheap,” “dated,” and “not aesthetically pleasing” strip light fixtures, ii) a long-felt but unresolved need to solve the problem, iii) a failure of others to solve the problem, iv) copying of the ’423 patent design by competitors, and v) commercial success, all support a determination of nonobviousness over Cohrs. PO Resp. 34–40. Petitioner opposes each of the above-stated arguments. Reply 13–15. We address the parties’ arguments below.

Factual inquiries for an obviousness determination include secondary considerations based on evaluation and crediting of objective evidence of nonobviousness. *See Graham*, 383 U.S. at 17–18. Notwithstanding what the teachings of the prior art would have suggested to one of ordinary skill in the art at the time of the invention, the totality of the evidence submitted, including objective evidence of nonobviousness, may lead to a conclusion that the challenged claims would not have been obvious to one of ordinary skill in the art. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). Secondary considerations may include long-felt but unmet needs, failure of others, unexpected results, commercial success,

copying, licensing, and praise. *See Graham*, 383 U.S. at 17; *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Evidence of secondary considerations must be reasonably commensurate with the scope of the claims. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011) (citing *In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971); *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998)). For such evidence to be accorded substantial weight, the proponent of secondary considerations evidence must establish a nexus between the evidence and the merits of the claimed invention. *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). “Where the offered secondary consideration actually results from something other than what is both claimed and *novel* in the claim, there is no nexus to the merits of the claimed invention.” *Kao*, 639 F.3d at 1068 (citing *Tokai Corp. v. Easton Enters., Inc.*, 632 F.3d 1358, 1369 (Fed. Cir. 2011) (“If commercial success is due to an element in the prior art, no nexus exists.”)). The burden of showing a nexus lies with the patent owner. *Id.*

With regard to identifying the problem of cheap, dated, aesthetically unpleasing “Hollywood” strip light fixtures, Patent Owner relies, primarily, on unsupported argument. PO Resp. 34. Patent Owner’s factual statements regarding the asserted problem are not supported by affidavit or declaration testimony or by citation to relevant publications. *Id.* Similarly, “[a] ‘long-felt need’ implies the existence of an articulated and identified problem in the art calling out for a solution.” *Rambus Inc. v. Hynix Semiconductor Inc.*, 254 F.R.D. 597, 607 (N.D. Cal. 2008) (citing *Texas Instruments Inc. v. U.S. Int’l Trade Comm’n*, 988 F.2d 1165, 1178 (Fed. Cir. 1993)). “A sufficient showing should include some minimum effort to survey industry publications or consider the efforts of multiple persons in the field to solve the alleged . . . problem.” *Id.* at 608. Patent Owner

does not make an evidentiary showing in support of the assertion of a long-felt need. PO Resp. 34.

Patent Owner reproduces Figure 1 from Cohrs as an example of the failure of others to solve the alleged problem. *Id.* at 35. Patent Owner then acknowledges Cohrs' Summary of Invention section, which identifies a solution to the problem by offering consumers "an affordable, decorative and functional option for upgrading their existing strip light fixture by covering the exposed light bulbs with a decorative shade or diffuser." *Id.* at 36 (citing Ex. 1002, 2:16–19). Patent Owner says nothing more about Cohrs, or the two other prior art references that offer similar solutions to the same problem, aside from the unsupported and unexplained statement that "[n]one of these shades met commercial success." *Id.*

Not only is Patent Owner's proffered evidence insufficient to satisfy Patent Owner's evidentiary burden, the cited prior art tends to support the opposite of Patent Owner's propositions. Cohrs, in particular, discloses a prior solution to the same problem using substantially the same solution as the '423 patent. Therefore, we are not persuaded by Patent Owner's unsupported arguments and limited, unpersuasive evidence of an asserted recognized problem of cheap, dated, unaesthetic "Hollywood" strip light fixtures, a long-felt need to solve the problem, and the failure of others to solve the problem.

Patent Owner's argument and evidence of asserted copying and commercial success of the '423 patent are similarly unavailing. "[C]opying requires evidence of efforts to replicate a specific product, which may be demonstrated through internal company documents, direct evidence such as disassembling a patented prototype, photographing its features, and using the photograph as a blueprint to build a replica, or access to the patented product combined with substantial similarity to the patented product." *Wyers v. Master Lock Co.*, 616 F.3d 1231,

1246 (Fed. Cir. 2010) (citations omitted). Patent Owner again makes statements of fact without submitting a supporting declaration, although some of the statements are supported by Patent Owner's sworn deposition testimony in this proceeding, which was submitted by Petitioner. Ex. 1009, 93 *et seq.* Regardless of any evidentiary insufficiency, Patent Owner's statements amount to little more than an accusation of copying based on her meeting with a Lowes representative where Patent Owner presented her '423 patent design, conversations with one of Lowes' lighting vendors, Evolution Lighting, and the subsequent offer for sale of a "Vanity Refresh Kit" produced by Evolution. PO Resp. 36–38. Patent Owner's evidence is, at best, evidence of access to her design drawings and photographs of the '423 patent prototype. Patent Owner's evidence, however, is not direct evidence that Evolution or Lowe's used Patent Owner's design information as a blueprint to replicate it in the Vanity Refresh Kit. Although the two designs shown in photographs provided by Patent Owner are similar, the photographs are not authenticated, and Patent Owner does not attempt to establish a nexus between the photographs and the '423 patent claim. *Id.* at 37–38.

Patent Owner's evidence that Lowes and Evolution applied for a design patent on a "Rounded Shade for Vanity Shadow Box" also does not support Patent Owner's accusation of copying. *Id.* at 38–39 (citing Ex. 2011). Patent Owner acknowledges that the ornamental design of the Rounded Shade version of the Vanity Refresh Kit and the '423 patent differ, primarily due to the prominent, rounded front surface of the Rounded Shade design. Therefore, we find the Rounded Shade design not to be persuasive of alleged copying.

Patent Owner argues the design claimed in the '423 patent has been commercially successful. *Id.* at 39. Patent Owner includes unauthenticated photographic images in her Response, as well as statements of fact not supported

by affidavit or declaration testimony or cited references. *Id.* at 39–40. Patent Owner concedes she has not sold a product embodying the claimed design and did not offer to license the ’423 patent to Lowes. Ex. 1009, 47:6–8, 136:5–11. With respect to Petitioner’s product, Patent Owner states only that it has been on sale since November 2012 and that it “has been commercially successful,” but offers no sales figures, expert analysis, or evidence in support. PO Resp. 39–40. Patent Owner also does not establish a nexus between any alleged commercial success and the claimed design. *See Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000) (a showing of commercial success requires a “nexus between [the] commercial success and the claimed features”). Therefore, we find Patent Owner’s commercial success argument to be unpersuasive.

III. CONCLUSION

For the reasons given above, we are persuaded Petitioner has shown by a preponderance of the evidence that the claimed design of the ’423 patent would have been obvious over Cohrs to a designer of ordinary skill at the time the ’423 patent application was filed, and the claim is unpatentable pursuant to 35 U.S.C. § 103.

IV. ORDER

It is ORDERED that:

The ’423 patent claim has been shown to be unpatentable.

This is a Final Written Decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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