

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TERMAX COMPANY,
Petitioner,

v.

ILLINOIS TOOL WORKS INC.,
Patent Owner.

IPR2022-00106
Patent D897,826 S

Before RAE LYNN P. GUEST, BART A. GERSTENBLITH, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

GUEST, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of the sole design claim of U.S. Patent No. D897,826 S (Ex. 1001, “the ’826 patent”). Patent Owner filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

The Petition indicates that Termax Company is the real party-in-interest for Petitioner. Pet. 1. Patent Owner’s Mandatory Notices indicate that Illinois Tool Works Inc. is the real party-in-interest for Patent Owner. Paper 3, 1.

The parties state that a case filed in the U.S. District Court for the Northern District of Illinois (Number 1-20-cv-05416) involves the ’826 patent. Pet. 1; Paper 5, 1. The parties also identify IPR2021-00724 as involving a related utility patent, namely U.S. Patent No. 10,863,882 (“the ’882 patent”). Pet. 1; Paper 5, 2.

II. BACKGROUND

A. The ’826 Patent and Challenged Claim (Ex. 1001)

The ’826 patent is titled “Fastener.” Ex. 1001, code (54). The challenged claim is for “[t]he ornamental design for a fastener as shown and described.” *Id.* at code (57). The ’826 patent is a design patent that issued from U.S. Patent Application No. 29/732,671, filed April 27, 2020. *Id.* at codes (21) and (22). The ’826 patent claims priority to two U.S. utility applications, namely U.S. Application No. 15/987,986, which issued as the ’882 patent (which is the subject of the related *inter partes* review), and U.S. Application No. 14/652,819, which issued as U.S. Patent No. 9,982,694 (“the ’694 patent”). *Id.* at code (63).

Figure 1, reproduced below, is representative of the claimed subject matter.

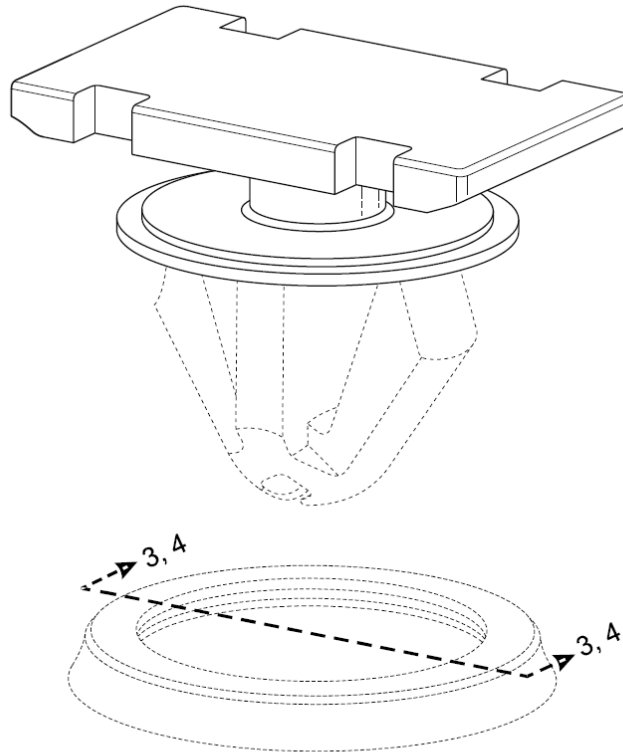


FIG. 1

Figure 1 of the '826 patent depicts in perspective view a fastener with solid lines illustrating an upper and lower platform connected by a post and dashed lines illustrating a lower clip portion disposed beneath the lower platform and a separate seal portion. The written description indicates that “Figure 1 is an enlarged exploded perspective view of a front, top, and right side of a fastener” and that “the exploded perspective view of the rear, top, and left side being identical thereto.” Ex. 1001, 1. The written description further states that “dash-dash-dash lines” illustrate “unclaimed” subject matter or structure, “which forms no part of the claimed design.” *Id.*

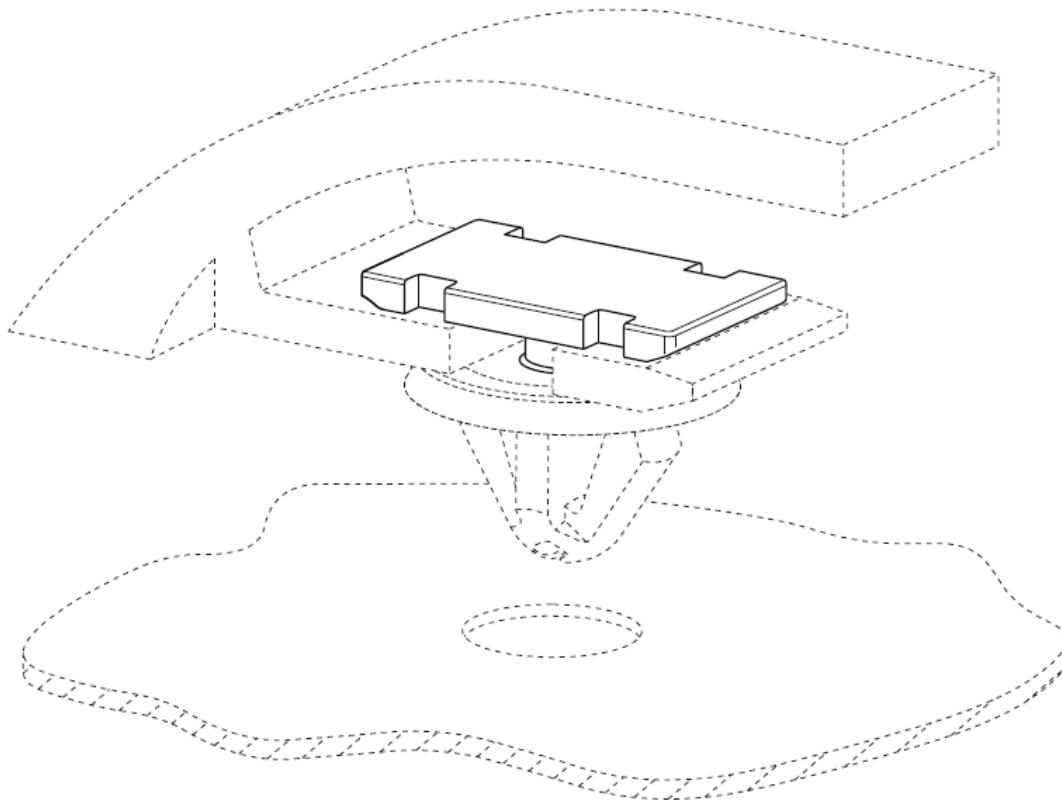


FIG. 2

Figure 2, reproduced above, depicts a similar perspective view of the front, top, and right side of the fastener as shown in Figure 1 and further includes, in dashed lines, an exploded view of the environment in which the fastener is used. In particular, the figure illustrates a dashed-lined image of what the parties refer to as a “doghouse connector,” having an upper portion positioned above, but not touching, the head and a lower portion that is positioned between the upper and lower platforms and partially surrounding the post. Figure 2 also depicts, in dashed lines, a second surface in partial cross-section with a hole, presumably for receiving the unclaimed “clip” portion of the fastener, which is similarly depicted in dashed lines. In

Figure 2, not all of the solid lined portions of the fastener from Figure 1 are visible. The written description indicates that perspective views of the “rear, top, and right side”¹ are “a mirror image thereof.” *Id.*

Figure 3 is described as a “front elevational view” of the fastener and includes an exploded environment in dashed lines. *Id.*

Figure 4, reproduced below, illustrates the fastener in an environment in which it is used. Figure 4 is similar to Figure 3 but without the environment depicted in an exploded view.

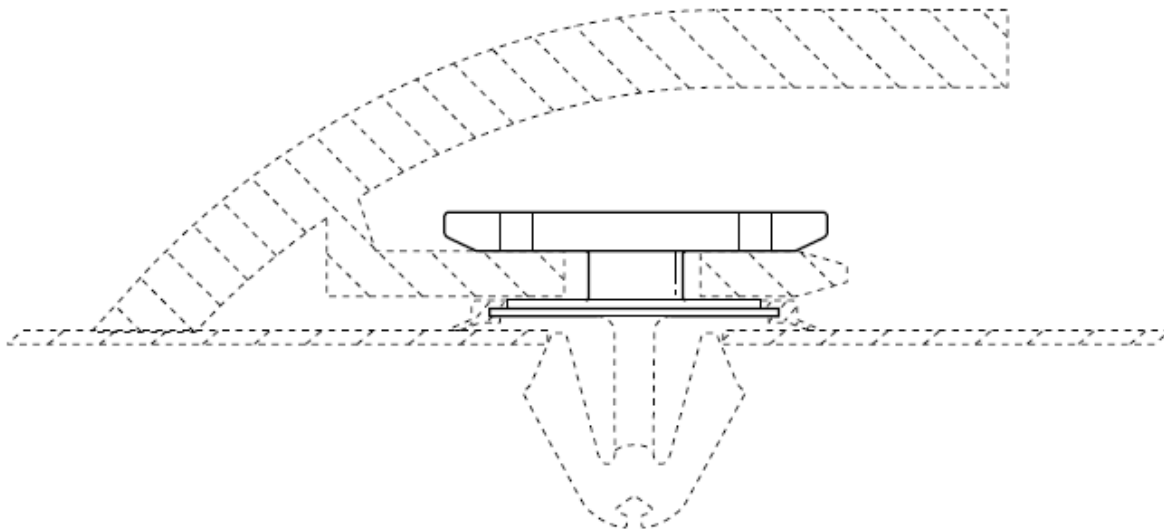


FIG. 4

The written description indicates that Figure 4 is an “environmental front elevational view” of the fastener of Figure 1. *Id.* Figure 4 depicts a

¹ Since “right side” cannot appear both as depicted and as a “mirror image” thereof, we note this is a drafting error. Accordingly, we interpret the description to be either a right or left side, and the mirror image to be the other of the right or left side of Figure 2.

side view of the fastener in the environment used. Namely, Figure 4 has solid lines illustrating the upper and lower platforms and post positioned therebetween of Figure 1 and dashed lines illustrating the clip and seal portions of Figure 1, along with the environment in which the fastener is used that is depicted with hatching demonstrating the environment is in cross-section.

B. Asserted Grounds of Unpatentability

Petitioner asserts grounds² under 35 U.S.C. §§ 102 and 103,³ as follows:

Ground	Claims Challenged	Basis	Reference(s)
1	1	102	Scroggie ⁴
2	1	103	Scroggie
3	1	103	Scroggie, Benedetti ⁵
4	1	103	Benedetti, Scroggie

Pet. 28.

Petitioner relies on the Declaration of Robert Wheelock. Ex. 1005. Patent Owner admits that Mr. Wheelock may be sufficiently qualified to opine as an ordinary observer, but asserts that Mr. Wheelock is not a designer and thus is not qualified to opine as to what an ordinary designer

² While a design patent only has a single, unnumbered claim to an ornamental design, we use the number “1” to refer to the sole design claim of the ’826 patent when represented in table form.

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (Sept. 16, 2011), includes revisions to Sections 102 and 103 that became effective on March 16, 2013. Because the ’826 patent issued from an application filed after March 16, 2013, we apply the AIA versions.

⁴ US Pub. No. 2008/0066266 A1, pub. March 20, 2008 (Ex. 1003).

⁵ US Patent No. 8,561,265 B2, issued October 22, 2013 (Ex. 1004).

would have considered in reviewing the prior art. Prelim. Resp. 57–58. As a preliminary matter, based on Mr. Wheelock’s statements of qualifications, we find Mr. Wheelock qualified to opine about who constitutes an ordinary designer in the art at the time of the invention and to opine based on his experience “participat[ing] in the development of a wide variety of fastener products, including umbrella clips having flexible skirt seals, and a variety of tether clips and high retention clips used with Roof Rail Air Bag deployment” as well as his “significant interaction with a number of third-party plastic fastener manufacturers.” *See* Ex. 1005 ¶¶ 7–14 (Mr. Wheelock’s statement of qualifications and experience); Ex. 2002, 13:9–16 (Mr. Wheelock describes his experience working with suppliers “to develop a product that would fit our environment, whatever the specifications were.”); *see also id.* at 14:22–19:23 (describing both purchasing fasteners off the shelf and his work to develop component fasteners when required). Further, relying on Mr. Wheelock’s experience in selecting suitable fasteners for vehicle parts (Ex. 1005 ¶¶ 7–14; Ex. 2002, 14:22–19:23), we find Mr. Wheelock qualified to opine as to the experience of the ordinary observer.

III. ANALYSIS

A. Principles of Law

1. Anticipation

The test for determining anticipation of a design patent claim is the ordinary observer test. *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.” *Id.* at 1239 (quoting *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871) (ordinary observer test applied in context of infringement)). “[T]he ordinary observer test requires consideration of the design as a whole.” *Id.* at 1243 (citations omitted). “The mandated overall comparison is a comparison taking into account significant differences between the two designs, not minor or trivial differences that necessarily exist between any two designs that are not exact copies of one another . . . [and] minor differences cannot prevent a finding of anticipation.” *Id.*

2. Obviousness

“In addressing a claim of obviousness in a design patent, the ultimate inquiry is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Apple, Inc. v. Samsung Elec. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012) (internal quotation and citations omitted); *see also High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1313 (Fed. Cir. 2013) (“The use of an ‘ordinary observer’ standard to assess the potential obviousness of a design patent runs contrary to the precedent of this court and our predecessor court, under which the obviousness of a design patent must, instead, be assessed from the viewpoint of an ordinary designer.”). This obviousness analysis generally involves two steps: first, “one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design”; second, “once this primary reference is found, other references may be used to modify it to create a design that has the same

overall visual appearance as the claimed design.” *High Point Design*, 730 F.3d at 1311 (internal quotation and citations omitted). In performing the first step, we must “(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates basically the same visual impression.”⁶ *Id.* at 1312 (internal quotation and citations omitted). In the second step, the primary reference may be modified by secondary references “to create a design that has the same overall visual appearance as the claimed design.” *Id.* at 1311 (internal quotation and citations omitted). However, the “secondary references may only be used to modify the primary reference if they are ‘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.’” *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

When evaluating prior art references for purposes of determining patentability of ornamental designs, the focus must be on actual appearances and specific design characteristics rather than design concepts. *In re Harvey*, 12 F.3d 1061, 1064 (Fed. Cir. 1993); *see also Apple*, 678 F.3d at 1332 (“Rather than looking to the ‘general concept’ of a tablet, the district court should have focused on the distinctive ‘visual appearances’ of the reference and the claimed design.”).

⁶ A single reference that creates “basically the same” visual impression is often referred to as *Rosen* reference. *See In re Rosen*, 673 F.2d 388, 391 (C.C.P.A. 1982).

B. Ordinary Designer in the Art

Petitioner asserts that “a designer of ordinary skill in the art would be a person having at least a Bachelor’s degree in Mechanical Engineering and at least three years of experience in push-in fastener engineering, and specifically sealing fasteners, as used in the assembly of vehicle trims.” Pet. 9–10 (citing Ex. 1005 ¶ 37).

Patent Owner argues that the Petitioner’s definition leaves out a key detail “that the person actually has to be a ‘designer’” and “incorrectly alleges that the person at issue need only be someone with ‘experience’ with push-in fastener ‘engineering,’ without any experience whatsoever in designing them.” Prelim. Resp. 11–12. However, Patent Owner also asserts that an ordinary designer is “[a] *person having an engineering degree and at least three years of experience in designing fasteners with designs similar to the ‘D826 patent, or comparable qualifications acquired through work experience.’*” *Id.* at 12 (bold emphasis added).

Because Patent Owner’s definition includes qualifications acquired through “work experience” broadly, we think the parties’ definitions are quite close. In particular, neither definition strictly requires three years of design experience in fasteners; rather, each includes comparable qualifications through other work experiences in fastener technology. Accordingly, the result is not impacted based on whether we rely on Petitioner’s definition or Patent Owner’s definition of the skilled artisan. Further, based on the limited record before us, we note that the level of ordinary skill is reflected in the prior art designs of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (recognizing that the prior art itself may reflect an appropriate level of skill in the art).

C. Claim Construction

In this *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b) (2021). With regard to design patents, it is well-settled that a design is represented better by an illustration than a description. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)). Although preferably a design patent claim is not construed by providing a detailed verbal description, it may be “helpful to point out . . . various features of the claimed design as they relate to the . . . prior art.” *Egyptian Goddess*, 543 F.3d at 679–80; *cf. High Point Design*, 730 F.3d at 1314–15 (remanding to district court, in part, for a “verbal description of the claimed design to evoke a visual image consonant with that design”).

Petitioner quotes Mr. Wheelock’s summary of the claimed design as follows:

A fastener having an upper, generally rectangular platform, or head, with two pairs of aligned outwardly-open block-U-shaped notches along the upper platform’s length, the head being of uniform thickness, except that a bottom of the head inclines toward a top surface of the head along leading and trailing ends. The top perimeter of the head is beveled. A cylindrical post extends downward from the head. An annular rib is present at a base of the cylindrical post.

A one-stepped circular lower platform, or collar, extends radially outwardly from the base of the cylindrical post, parallel to the head. A lowermost circular portion of the collar has a larger diameter than the uppermost circular portion.

Pet. 11–12 (quoting Ex. 1005 ¶¶ 48–49). Petitioner further notes that “[t]he stem, wings, and the perimeter seal that mates with the lower collar, are

shown in dashed lines, as are the connected molding and supporting panel. None form part of the claimed design.” *Id.* at 12 (citing Ex. 1005 ¶ 45).

Patent Owner does not provide a verbal description and does not contradict this description. Rather, Patent Owner contends that Petitioner’s description is “not needed or helpful.” Prelim. Resp. 13. Patent Owner further states that “the alleged ‘scope’ of the claims as they relate to the prior art . . . is more appropriately addressed in the context of the asserted prior art and not as part of claim construction.” *Id.* at 14.

We adopt Petitioner’s description for the purposes of naming and identifying the various parts that make up the claimed design as a whole. However, we agree with Patent Owner that “[i]n construing a design patent claim, the scope of the claimed design encompasses, ‘its visual appearance as a whole,’ and in particular ‘the visual impression it creates.’” *See Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1376 (Fed. Cir. 2002) (quoting *Durling*, 101 F.3d at 104–05).

Petitioner and Patent Owner further address the role of functionality in claim construction. Because the case turns substantially on this issue, we address it separately below.

D. Functionality

Petitioner asserts that “it is necessary when construing the claim of the design patent to distinguish between the primarily functional elements (which are not considered part of the construed claim) and ornamental elements,” such that “[t]he scope of a design patent claim cannot extend to functional aspects of the claimed article.” Pet. 13. Petitioner further asserts that “the shape and configuration of the lower stepped circular platform of the D’826 Patent are dictated primarily by function,” and, thus, “the

particular configuration of the lower platform should be excluded from the scope of the claimed design.” *Id.* at 16. In particular, the Petitioner asserts that “the stepped configuration of the lower platform’s edge is dictated by the internal geometry of the unclaimed perimeter seal.” *Id.* at 17.

Specifically, Petitioner argues that “[a]lternative designs are not available” for the lower platform because “it must mate” with “the internal geometry of the circular perimeter seal.” *Id.* at 16. Petitioner provides an annotated version of a close-up of Figure 3 reproduced below. Pet. 21 (annotating Figure 3 by removing all portions of the fastener, except for the lower platform and the unclaimed seal in cross-section, and adding red lines where the lower level of the claimed lower platform contacts the unclaimed seal on the left and right sides of the figure and adding red arrows pointing thereto).



The annotated close-up portion of Figure 3 includes only where the claimed stepped lower platform is depicted in solid lines engaging with an unclaimed annular seal depicted in dashed lines and in cross-section. The stepped lower platform is illustrated forming a flush upper surface with the seal, and the lowermost circular portion with a larger diameter engaged in a notch or channel within the unclaimed annular seal, such that the seal

surrounds an annular region of the lowermost circular portion and touches an annular region around the bottom surface of the stepped lower platform.

Petitioner further argues that it is the “best design” because it provides “the best adhesion for the overlying seal,” and other shaped lower platforms “would result in a misfit” with the perimeter seal. *Id.* at 21. Further, according to Petitioner, the mating of the stepped lower platform with the perimeter seal creates “an uninterrupted connection,” which “dampen[s] vibrations by transmitting vibrations to larger body parts of a vehicle” and “help[s] reduce noise.” *Id.* at 22. Referencing Figure 4, reproduced above, Petitioner contends that the stepped platform and the seal “maintain a flush surface preventing interference between the seal and the doghouse connector when inserted.” *Id.* Indeed, Figure 4 depicts an unclaimed “doghouse” connector in dashed lines and cross-section, extending, in part, between the upper and lower platforms, on both sides of the claimed post, and lying flush with the unclaimed seal and upper surface of the stepped lower platform. Petitioner contends that lower platforms with different geometries would “adversely affect the utility of the fastener,” “defeat the seal’s purpose,” and “cause the seal to project unacceptably into the space intended for the dog house connector.” *Id.* at 23.

Petitioner points out that the shape and configuration of the lower platform was specifically claimed in corresponding utility patents, for example as “stepped,” with an “interior portion and reduced thickness outer annular lip,” and the seal’s relationship as “at least partially cover[ing] the outer lip.” *Id.* (citing, *e.g.*, claim 12 of the ’694 patent).

Petitioner further notes that “at all times during the fastener’s normal use, the configuration of the lower platform is hidden from view.” *Id.* at 24

(citing '826 patent, Fig. 2). Petitioner asserts this is true for “manufacture, sale, and installation” of the fastener, and as such “[t]he ornamental appearance of the lower platform is not a matter of concern at any time during its useful life.” *Id.* at 25–26 (citing Ex. 1005 ¶ 65).

Patent Owner asserts that Petitioner improperly argues an unpatentability ground under 35 U.S.C. § 171, which is not an argument based on prior art patents and publications in accordance with 35 U.S.C. § 311, and, thus, is improper for an *inter partes* review. Prelim. Resp. 19–21 (comparing the similarities of Petitioner’s argument to considerations of indefiniteness, which are not proper to “back-door” into an *inter partes* review).

In this aspect, we disagree with Patent Owner. It is true a design patent must claim an “ornamental” design, not one “dictated by function,” and thus an entire design patent may be deemed invalid under 35 U.S.C. § 171 for not being an “ornamental design.” *See, e.g., High Point Design*, 730 F.3d at 1315. Accordingly, “a design patent may not claim a ‘primarily functional’ design. *Automotive Body Parts Assn. v. Ford Glob. Techs., LLC*, 930 F.3d 1314, 1318 (Fed. Cir. 2019). Nonetheless, “a valid design may contain some functional elements. After all, ‘a design patent’s claim protects an article of manufacture, which “necessarily serves a utilitarian purpose.”’” *Id.* (quoting *Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1320 (Fed. Cir. 2016) and *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993)).

Here, however, Petitioner does not propose any grounds based on 35 U.S.C. § 171, but rather clearly proposes grounds based on a prior art patent and patent application publication. *See* Pet. 28 (identifying the

proposed grounds). Thus, we need not address whether the entire patent design is “primarily functional” and thus not ornamental, so as to be invalid under 35 U.S.C. § 171.

Yet, we are not absolved from considering Petitioner’s identification of allegedly functional aspects of the invention as part of our claim construction of a design patent claim. Indeed, our reviewing court has stressed that we must consider, as a part of claim construction, “the functional features of the design, as well as the functional purpose of the [device] as a whole.” *Lanard Toys Ltd. v. Dolgencorp LLC*, 958 F.3d 1337, 1342 (Fed. Cir. 2020). We are indeed encouraged to “acknowledge[] the ornamental aspects of each functional element” as part of claim construction for design patents. *Id.* Further, we must “flesh[] out and reject[an] attempt to distinguish [a] patent from the prior art by importing the [function of the design] into the construction of the claim.” *Id.* Indeed, “[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.” *Sport Dimension*, 820 F.3d at 1320 (quoting *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997)). The court instructs us to note the ornamental features that produced the overall visual appearance and properly limit the scope of the patent to its “overall visual *ornamental* impression, rather than the broader general design concept.” *Id.* at 1321 (quoting *OddzOn Prods.*, 122 F.3d at 1405).

Patent Owner contends that the design of the lower platform is not primarily dictated by function. Prelim. Resp. 24–34. On the present record before us, we agree with Patent Owner.

We are not persuaded that the seal substantially relied upon by Petitioner as dictating the function of the lower platform is necessary to the fastener's function. We agree with Patent Owner that the claimed design is directed to a "fastener" generally, and not to a fastener having any specific use. *Id.* at 12. Thus, the device itself need only fasten one object to another. In this respect, Patent Owner has provided examples of fasteners that do not include a seal, including the prior art relied upon by Petitioner. Prelim. Resp. 24–26. Moreover, we recognize seals might be useful to keep out moisture or serve another purpose when used for securing vehicle exterior or interior trim as argued by Petitioner (Pet. 21, 23 (citing the related utility patents)), we also note that a generic fastener of the claimed design *might* be used for a generic fastening purpose, such as fastening paper together, and that the unclaimed seal serves no role in the device's generic ability to fasten. Petitioner's arguments and Mr. Wheelock's opinions rest on the combined purpose of a seal and lower platform only to the extent they are limited to a fastener used for a vehicle and are not directed to the broader subject matter of the claimed device. Pet. 21–22 (asserting the lower platform and seal mate to form "strong and moisture-impermeable connections" and "to dampen vibrations . . . to larger body parts of a vehicle").

On that note, we further agree with Patent Owner that Petitioner's reliance on *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563 (Fed. Cir. 1996), is misplaced. Prelim. Resp. 30. Petitioner argues that *Best Lock* supports its position that the lower platform's appearance is primarily dictated by the shape of the unclaimed seal, because it is analogous to a key blank design being invalid as dictated by the lock into which it fits. Pet 19–

20. In addition to addressing invalidity under 35 U.S.C. § 171, not as a matter of claim construction, *Best Lock* is distinguishable because a lock is necessary for a key to function, where, as noted above, a seal is not necessary for a generic fastener to hold two things together.⁷

Similarly, we are not persuaded by Petitioner’s position that the lower platform is not visible “at all times during the fastener’s normal use,” but is “hidden from view.” Pet. 24. Again, the use of the fastener is not limited to use with a seal for a vehicle. Petitioner provides no evidence of manufacturing techniques, sales, advertising, or installation, to support the contention that “[f]rom manufacture, sale and installation, the lower platform is enshrouded by the perimeter seal.” *Id.* at 25 (citing Ex. 1005 ¶ 65). And, although Petitioner relies on Mr. Wheelock’s testimony, that testimony is unsupported on the record before us. *See* Ex. 1005 ¶ 65 (failing to identify any support for his opinion). Accordingly, we give Mr. Wheelock’s testimony on this point little weight. *See* 37 C.F.R. § 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.”). Additionally, as noted above, we are not persuaded that a seal is a necessary component for a general fastener, and, thus, we are not persuaded that fasteners are not manufactured or sold without seals attached. Moreover, we agree with Patent Owner that such a position is not supported by case law.

⁷ We further agree with Patent Owner that Petitioner has not shown that the seal shape, which allegedly dictates the lower platform’s appearance, was necessary to provide a sealing function, or that the designer did not have control over the overall visual appearance of both the seal and the lower platform such that other configurations, alone or together, would perform the same function. Prelim. Resp. 30–31.

See Seiko Epson Corp. v. Nu-Kote Int’l, Inc., 190 F.3d 1360, 1368 (Fed. Cir. 1999) (“The validity of a design patent does not require that the article be visible throughout its use; it requires only that the design be of an article of manufacture and that the design meets the requirements of Title 35.”).

We are further, and primarily, persuaded by Patent Owner’s demonstration, through citations to multiple prior art references, that prior art fasteners are replete with lower platforms having a variety of appearances. Prelim. Resp. 25–30. Indeed, Patent Owner presents fasteners with lower platforms with rectangular, round or oval shapes, stepped, ribbed or striped surfaces, reverse stepped structure, beveled edges, larger and smaller diameters, and thicker and thinner relative platforms. *Id.*

In construing the design claim, if the particular appearance of a design aspect is dictated by its function, the functional element’s appearance cannot significantly contribute to an ornamental design because it would *necessarily* have the same appearance in any other device where it serves the same function. *Sport Dimension*, 820 F.3d at 1321 (“[T]he fact finder should not focus on the particular designs of these elements when determining infringement, but rather focus on what these elements contribute to the design’s overall ornamentation.”). Accordingly, if a feature is shown in the prior art as a whole having a variety of appearances and yet serves the same function, the appearance is likely not critical to its function, or that feature would have looked identical in each device’s design. *See Best Lock*, 94 F.3d at 1566 (“A design is not dictated solely by its function when alternative designs for the article of manufacture are available.”); *L.A. Gear*, 988 F.2d at 1123 (“When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily

ornamental purpose.”). Thus, to determine what visual aspects of a design are primarily functional, any analysis must consider how that feature appears throughout the prior art and whether and what aspects of that feature appear consistently.

We find significant the evidence put forth by Patent Owner of lower platforms shown elsewhere in the prior art as a whole having a variety of visual appearances. Petitioner does not point out or discuss the prior art as a whole or the apparent alternatives of lower platform appearances therein, with or without seals, in its assertions that the lower platform’s appearance is primarily dictated by function. *See generally* Pet. To the contrary, Mr. Wheelock’s opinion regarding the functionality of the appearance of the lower platform is solely based on the ’826 patent’s figures, with no analysis of alternative fastener designs in the art. Ex. 1005 ¶¶ 56–61 (pointing only to Figure 3 of the ’826 patent). While the related utility patents claim a “second platform” having a “stepped construction” and that is “annular” (Ex. 1005 ¶ 63), we note that Mr. Wheelock does not cite to the utility patents as expressly describing a reason for this particular structure. *See generally* Ex. 1005. Rather, Mr. Wheelock provides no evidence to support the functions he alleges are served by the lower platform in combination with the unclaimed seal. *Id.* at ¶¶ 56–61. For the purpose of this initial determination, we do not find Mr. Wheelock’s unsupported opinions persuasive over evidence in the art as a whole of a variety of fastener lower platform appearances. 37 C.F.R. § 42.65(a); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985) (“Lack of factual support for expert opinion going to factual determinations” is

sufficient to “render the testimony of little probative value in a validity determination.”).

Accordingly, we do not construe, and do not eliminate or discredit, the appearance of the lower platform as an aspect of the overall appearance of the claimed fastener as being primarily dictated by function.

E. Analysis of the Patentability Challenges

(1) Asserted Anticipation by Scroggie (Ex. 1003)

Scroggie is a utility patent application directed to a fastener for securing a first panel to a second panel. Ex. 1003 ¶ 5. Scroggie includes ten figures. *Id.* ¶¶ 20–29. Figure 4 is representative of the fastener.

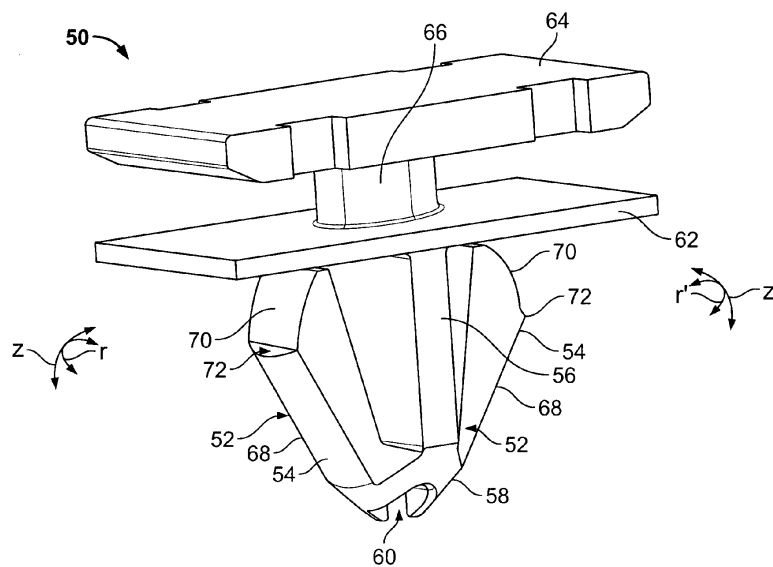


FIG. 4

Figure 4 of Scroggie depicts, in perspective view, a fastener illustrating upper and lower platforms connected by a post and a lower clip portion disposed beneath the lower platform. The upper, generally rectangular platform, or head, has two pairs of aligned outwardly-open

block-U-shaped notches along the upper platform's length, the head is generally of uniform thickness, except that a bottom of the head inclines toward a top surface of the head along leading and trailing ends. The top surface of the head is beveled on the shorter rectangular ends. A post extends downward from the head. A rectangular lower platform that is aligned and substantially the same size as the upper head is present at a base of the cylindrical post. The rectangular lower platform is uniform in thickness along its length. The fastener further includes a w-shaped clip, having a central arm and two wings extending from the central arm, that extends below the lower platform.

Petitioner's argument that the claimed design is anticipated by Scroggie is based entirely on the premise that we cannot consider the appearance of the lower platform. *See* Pet. 32 ("Factoring out unclaimed features and the functional aspects of the lower platform, a side-by-side comparison of the remaining aspects of the claimed design . . . illustrates the D'826 design is identical in all material respects to Scroggie and is anticipated . . ."). Indeed, on the record before us, Petitioner does not address the design as a whole, to the extent that it includes the appearance of the lower platform, in order to show that an ordinary observer, giving such attention as a purchaser usually gives, would deem the design depicted in Scroggie to have the same overall visual appearance as that claimed in the '826 patent. Rather, Petitioner asserts that "there are no differences between Scroggie and the claimed design." Pet. 41. Indeed, on the record before us, we agree with Patent Owner that the lower platform is significant to the overall appearance of the fastener design, and thus Petitioner's analysis is not sufficient on this record.

Because we disagree with Petitioner’s premise that the lower platform’s appearance is primarily dictated by function, Petitioner has not established a reasonable likelihood of prevailing as to this ground.

(2) Asserted Obviousness over Scroggie

Petitioner sets forth an alternative argument based on obviousness over Scroggie—“[t]o the extent any differences exist between the claimed design (as properly construed to factor out the stepped lower platform).” Pet. 45. However, again Petitioner’s argument is based entirely on the premise that we cannot consider the appearance of the lower platform, with which we disagree as a matter of claim construction. Accordingly, for the same reasons discussed above, Petitioner has not established a reasonable likelihood of prevailing as to this ground.⁸

(3) Asserted Obviousness over Scroggie in View of Benedetti (Ex. 1004)

Petitioner contends that Scroggie is “basically the same” as the claimed design, even if interpreted to include the stepped lower circular platform, and, thus, is a proper primary reference. Pet. 50. Petitioner asserts that “[t]he only discernible difference between the two is the geometry of their respective lower platforms,” which Petitioner asserts “is not sufficient to preclude a finding that Scroggie is ‘basically the same’ as the claimed design.” *Id.* at 53. However, rather than addressing the effect of the lower platforms of the claimed design and of Scroggie on their overall

⁸ For the reasons noted here and below, because we determine that Petitioner has not established, even without considering any alleged evidence of secondary considerations, a reasonable likelihood of prevailing as to any obviousness proposed grounds, we decline to address Patent Owner’s further argument directed to copying as a secondary consideration of non-obviousness. *See* Prelim. Resp. 68–70.

appearances, Petitioner merely asserts that “[t]he Federal Circuit has concluded disclosures presenting far less similarity to the claimed design to nevertheless be sufficiently similar to serve as primary obviousness references.” *Id.* at 54. Petitioner next addresses the specific facts of other Federal Circuit cases, but does not then demonstrate how those facts weigh upon the claimed design as compared to that of Scroggie, except to baldly assert that “[t]he differences described above are far more extensive than any differences evident between the claimed design and that disclosed in Scroggie.” *Id.* at 54–56.

Petitioner and Mr. Wheelock point to eight common design characteristics, all of which are directed to only the head and the post of the fasteners, finding no common design characteristics with respect to the lower platform. *Id.* at 44; Ex. 1005 ¶ 130. Mr. Wheelock notes the differences in the lower platforms with respect to shape, one being round and the other rectangular, and states that “the perimeters of the lower platforms differ slightly, with one having a stepped configuration forming a lip, and the other having a uniform edge thickness.” Ex. 1005 ¶ 131. Mr. Wheelock opines that “these differences are outweighed by the similarity of the designs such that they are basically the same for purposes of the test for obviousness, considering the visual impression created by the patented design *as a whole*.” *Id.*

Patent Owner asserts that Scroggie cannot qualify as a primary reference because the claimed design and that of Scroggie are not basically the same. Prelim. Resp. 48. Patent Owner asserts that the lower platform is “completely different” and “accounts for nearly 50% of [the] overall designs – not a ‘slight’ difference.” *Id.* Patent Owner again points to the various

appearances of other lower platform designs in the fastener art to show “the shape and size of a fastener’s lower platform is a very material design difference. It is one of the most fundamental ways to distinguish between different fastener designs.” *Id.* at 49–50. Patent Owner further asserts that the shape of the lower platform contributes to the overall design by pointing to designs in the art as a whole that particularly use “differently-sized platforms” as compared to “similarly-sized platforms.” *Id.* at 50–51.

We agree with Patent Owner that the lower platform’s appearance contributes significantly to the overall visual impression of the design. Because Petitioner does not address how the admitted differences affect the design as a whole, or provide any explanation as to why the differences do not affect the overall visual appearance of the fastener, on the present record, Petitioner has not shown that the design of Scroggie is basically the same as the claimed design to qualify as a primary reference.

Even if Scroggie would qualify as a primary reference, we further disagree with Petitioner, on the present record, that Benedetti is “so related” that it would have “suggest[ed] to and motivate[d] such a designer to interchange the stepped circular lower platform of Benedetti for the rectangular lower platform of Scroggie.” Pet. 68.

Benedetti is a utility patent directed to an interior trim fastener. Ex. 1004, code (57). Benedetti includes ten figures. *Id.* at 2:52–3:4. Figure 4 is representative of the fastener.

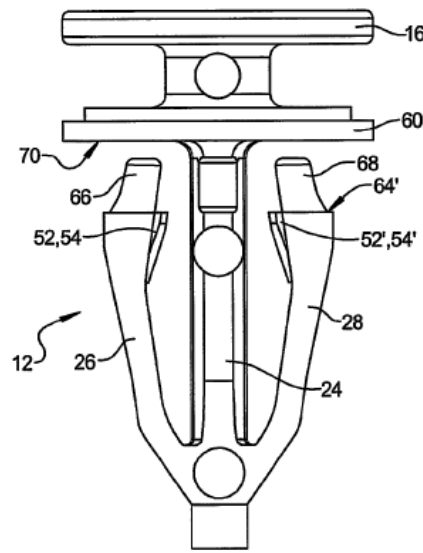
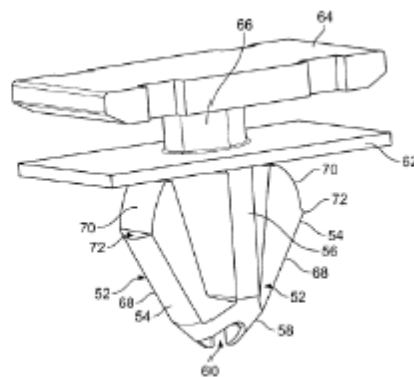
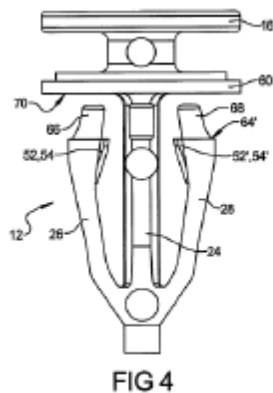


FIG 4

Figure 4 of Benedetti depicts a front view of a fastener illustrating upper and lower platforms connected by a post and a lower clip portion disposed beneath the lower platform. The upper, generally circular platform, or head, is generally of uniform thickness, except that it appears to have a rounded upper edge and a rounded lower edge, which are perhaps beveled. A post extending downward from the head appears to be generally cylindrical in the middle gradually increasing in size to form a sloping surface adjacent both the upper platform and lower platform. A circular lower platform that is aligned and substantially the same size as the upper head is present at a base of the cylindrical post. The lower platform has two stepped levels, with a first, upper level having a smaller diameter than a second, lower level having a larger diameter. The lower level appears to have a slightly larger thickness than the upper level of the lower platform. The fastener further includes a w-shaped clip, having a central arm and two

wings extending from the central arm, that extends below the lower platform.

Petitioner points out similarities between Scroggie and Benedetti. Namely, both are vehicle fasteners having upper and lower platforms that are planar and parallel that are joined by a central, cylindrical post of lesser diameter, an annular rib at the base of the post, and bevels on the “exposed ends” of the upper platform. Pet. 57–58; Ex. 1005 ¶ 134. We reproduce from the record, a side-by-side comparison of Figure 4 of Benedetti (left) and Figure 4 of Scroggie (right).



Further, Petitioner argues that “other aspects,” beyond “visual similarities” or “mere aesthetic similarities,” suggest the modification of Scroggie to include the stepped platform of Benedetti. *Id.* at 58. In particular, Petitioner points to the teaching in Benedetti of “an improved umbrella seal” and contends that a designer of ordinary skill in the art would have used the seal taught by Benedetti in the fastener of Scroggie, which also teaches using a seal around a round opening, because a circular umbrella seal having the same geometry as the opening would “provide an aesthetically attractive symmetry” with the opening. *Id.* at 59, 61. Petitioner further contends that the umbrella seal of Benedetti would have

been a known substitute for a different round seal taught in Scroggie, which would also be more effective and reliable. *Id.* at 62. According to Petitioner, since the improved umbrella seal is mounted on a circular lower platform, having the same shape and stepped edge configuration as the claimed design, to ensure a strong liquid-tight and air-tight seal and a flush transition, the claimed design would have been obvious as the combination would result in a design providing the same visual appearance. *Id.* at 60, 65. Petitioner further relies on Benedetti’s express teaching that the upper platform “is circular but is not limited to any geometric shape.” *Id.* at 66 (citing Ex. 1003, 3:28–30).

Patent Owner contends that Benedetti is not a proper secondary reference because it is not sufficiently close in visual appearance that the presence of appearance of certain features of one would suggest the application of those features to the other. Prelim. Resp. 54. Patent Owner argues that Petitioner only considers whether the references are related in function and does not show that the overall appearance of Benedetti is related to the overall appearance of Scroggie. *Id.* at 54–56. Patent Owner asserts that Petitioner does not address “the glaring differences in overall appearance,” which are fundamental differences in the design of the fasteners, noting “the two fastener designs could hardly be more different.” *Id.* at 56, 57. In particular, Patent Owner points to the upper and lower platform shapes (both rectangular versus both circular), the tapering of the central post in Benedetti, the two-stepped versus one level lower platform, and the presence of a hole or circle on the post in Benedetti, all as fundamental differences. Prelim. Resp. 56. We note further differences,

namely the lack of notches in the head of Scroggie and the limited underside beveling to only the ends of the head in Scroggie.

We find, on the record before us, that Petitioner has not established that Benedetti is so related to Scroggie that an ordinary designer of fasteners would have been motivated to replace the entire lower platform of Scroggie with that of Benedetti.

We cannot agree with Petitioner's interpretation of the law that "other aspects," other than the ornamental appearance of two designs as a whole, are relevant to what would have been suggested to an ordinary designer. Pet. 58–59. For utility patents, indeed, we look to the function of a given element to explain why a skilled artisan would have been motivated to substitute one element for another within the prior art. For design patents, however, the Federal Circuit has made clear that the motivation to modify one design with another is limited to whether the articles are "so related" (i.e., so similar in appearance) that an ordinary designer would be naturally led to incorporate the features of one in the other. *See MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326 (Fed. Cir. 2014) ("In other words, it is the mere similarity in appearance that itself provides the suggestion that one should apply certain features to another design.").

Here, we find that the notable similarities between Scroggie's and Benedetti's fastener designs are (1) that the same elements (head, stem, and lower platform) are present in some form and (2) that the head and base of each fastener create a symmetrical appearance around a stem, in that they are roughly the same dimensions. Other alleged similarities noted by Petitioner (cylindrical post of lesser diameter, an annular rib at the base of the post, and bevels on the "exposed ends" of the upper platform) do not appear to be

features that clearly represent similarities in the designs. Instead, they highlight the distinctions: Benedetti's curved post with smooth lines versus Scroggie's strictly cylindrical post with single notable rib adjacent the lower platform and the curved bevel around Benedetti's circular head appearing almost smooth versus the straighter angled bevels around Scroggie's head.

The presence of the same elements does little to show the two fastener designs are so related. Scroggie's rectangular shaped platforms, with the notches in the upper platform, and the cylindrical stem, with subtle rib adjacent the lower platform, give the fastener an overall blocky and industrial appearance. Meanwhile, the rounded, circular-shaped upper platform and generously sloping stem of Benedetti create a sleeker, smoother appearance that diminishes the boxier stepped, yet circular portion of the lower platform. Indeed, because they have the same elements, and yet overall have such different visual appearances, we find that the designs, i.e., the ornamental visual impression, are not "so related" to each other.

Further, the notably consistent symmetrical nature of both designs would not suggest that a skilled designer would destroy that symmetry by using a rounded platform with a rectangular platform. *See Apple*, 678 F.3d at 1331 (quoting *Rosen*, 673 F.2d at 391, as holding that "rejecting the primary reference where 'modifications of [it] necessary to achieve [the patented] design would destroy the fundamental characteristics' of that reference," when finding a secondary reference "so different in visual appearance from the [primary] reference that it does not qualify as a comparison reference under [the so related] standard").

Petitioner and Mr. Wheelock's⁹ emphasis, on the improved function of a seal and argument that a skilled artisan would functionally need a particular-shaped lower platform in light of that functional improvement, is not relevant and unavailing to an obviousness analysis for a design patent. The seal is not a claimed element of the invention, and Petitioner has not persuasively shown that the element is necessary for the fastener to function as a generic fastener, as discussed above. Similarly, we are not persuaded by Benedetti's express teaching that the upper platform "is circular but is not limited to any geometric shape." Pet. 66 (citing Ex. 1003, 3:28–30). Indeed, this merely reflects that the circular appearance of Benedetti's head is not critical to its function, which is merely further evidence of the head's appearance being a design element. Petitioner conflates functional utility with ornamental appearance.

Because Petitioner has not established that Scroggie is a proper primary reference and, even if it is, that Benedetti is so related to Scroggie to provide a suggestion to modify Scroggie as argued by Petitioner, Petitioner has not established a reasonable likelihood of prevailing as to this ground.

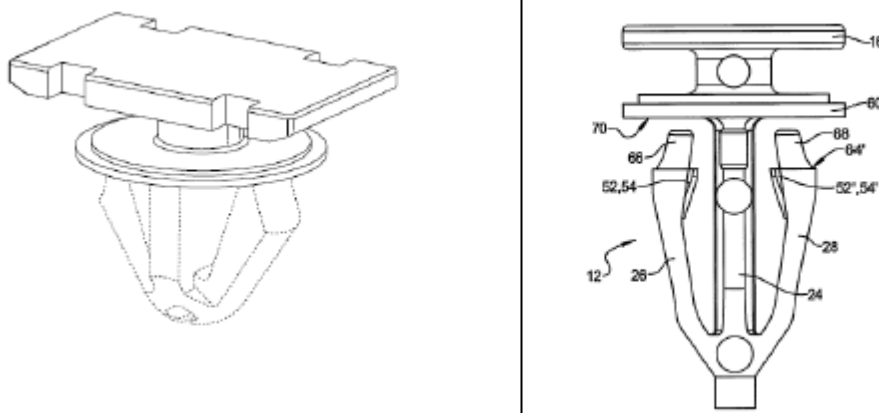
(4) Asserted Obviousness over Benedetti in View of Scroggie (Ex. 1004)

Petitioner contends that, in the alternative, Benedetti is a proper primary reference because a skilled designer of fasteners would find it "basically the same" design as the claimed design. Pet. 74. Petitioner then asserts that Scroggie is so related to Benedetti that a skilled designer would

⁹ We note that Mr. Wheelock's opinion appears to be based on the functional improvements of an umbrella seal and the functional relationship of a lower platform that would fit with such a seal. Ex. 1005 ¶¶ 151, 156, 167.

be motivated to modify Benedetti with the head and post design of Scroggie. *Id.* at 78–79.

With respect to Benedetti as a primary reference, Petitioner and Mr. Wheelock point to some common aspects between the claimed design and Benedetti, namely the presence of a head, post and lower platform, the spacing of the head and lower platform from each other, beveling of the head around the top perimeter, the general shape of the lower platform, and the presence of an annular rib at a base of the cylindrical post. *Id.* at 74–75; Ex. 1005 ¶ 171. We reproduce from the record, a side-by-side comparison of Figure 1 of the '826 patent (left) and Figure 4 of Benedetti (right).



Patent Owner argues that Petitioner has not shown that the designs are “basically the same” because Petitioner focuses only on the shared similarities and that, when properly considered, the differences “are major, fundamental differences.” Prelim. Resp. 61. Again, Patent Owner points to the prior art as a whole to show that “the difference between a circular and rectangular upper platform [head] is a basic, core difference in the overall appearance of fasteners.” *Id.* at 63–67 (noting differently sized and shaped upper and lower platforms, as well as various surface treatments contribute to the overall appearance of a fastener).

On the present record, we agree with Patent Owner that the overall visual appearance of the claimed design and Benedetti are not “basically the same.”

We find that the notable similarities between the claimed design and Benedetti’s fastener designs are (1) that the same elements (head, stem, lower platform) are present in some form and spaced relatively the same, and (2) that the lower platforms are circular and stepped. Other alleged similarities noted by Petitioner (an annular rib at the base of the post and beveling of the head around the top perimeter) do not appear to be features that clearly represent similarities in the designs. Instead, they highlight the distinctions: Benedetti’s curved post with smooth lines versus the claimed design’s strictly cylindrical post with single notable rib adjacent the lower platform and the curved bevel around the entire perimeter of both the top and bottom surfaces of Benedetti’s circular head appearing almost smooth versus the straighter angled bevels on only the bottom ends of the claimed design’s head. Further, we note that Benedetti’s design has a sense of symmetry in that the overall circular shape of the head and lower platform and that both the head and lower platform appear to have similar diameters in their outer dimensions. Meanwhile, the claimed design has a notably asymmetric overall appearance, with a rectangular head having a longer dimension much larger than the diameter of the circular lower platform. While the lower platforms taken as a single element, which we are instructed not to do without the overall context of the design, have a similar shape, we observe that Benedetti has a lower level appearing subtly larger than the upper level. No such distinction is clear in the claimed design, and may even be the opposite, with the upper level being subtly thicker than the lower

level, as best noted in the elevation view of Figure 4. The overall thickness of the lower level of Benedetti appears to be similarly dimensioned to the thickness of the head of Benedetti, again contributing to the symmetrical appearance. On the other hand, the claimed design has a head that is notably thicker than the lower platform further contributing to the asymmetry of the design.

Further, the claimed design's rectangular-shaped head, with the notches and angled bevels, and the cylindrical stem, with subtle rib adjacent the lower platform, give the fastener an overall blocky and industrial appearance that is highlighted by the blocked stepped construction of the circular lower platform. Meanwhile, the rounded, circular-shaped upper platform and generously sloping stem of Benedetti create a sleeker, smoother appearance that emphasizes the circular aspects of the lower platform, while the boxier step of the lower platform is subtly contrasted therewith.

Thus, we find that Petitioner has not established that Benedetti is a proper primary reference for an obviousness analysis.

Petitioner argues that Scroggie is a proper secondary reference because it is so related to Benedetti for the same reasons noted above. Pet. 78–79. As discussed above, we find that Scroggie and Benedetti have such substantially different overall visual appearances, with notable differences that are highlighted by the minor similarities, such that they are not so related to suggest a skilled designer combine the designs thereof as noted by Petitioner.

Petitioner further argues that a skilled designer would have been motivated to use the head of Scroggie, as it would be an aesthetic

improvement “visually communicating directionality, and creating [an] agreeable sense of movement” and provide “a counterpoint to the lower platform, visually communicating the difference between these components of the fastener.” Pet. 79. While we agree these are aspects that characterize the claimed design and distinguish the claimed design from the symmetrical impressions of both Benedetti and Scroggie, these notable distinctions support the non-obviousness of the claimed design and do not explain why a skilled designer would have arrived at these benefits from Benedetti and Scroggie.

Petitioner and Mr. Wheelock’s further argument, that the improved function of the notched rectangular head of Scroggie, namely to maintain the fastener in a particular orientation with respect to a panel, would have suggested a skilled artisan to incorporate that functionality, is not relevant and unavailing to an obviousness analysis for a design patent. Pet. 79–80; Ex. 1005, ¶¶ 176–77. That such aspects may have a function does not provide motivation for a designer to incorporate that feature into a design when the prior art as a whole (including those with circular or other-shaped head designs) demonstrates that the shape is not critical to the generic function of a fastener.

Because Petitioner has not established that Benedetti is a proper primary reference and, even if it is, that Benedetti is so related to Scroggie to provide a suggestion to modify Benedetti as argued by Petitioner, Petitioner has not established a reasonable likelihood of prevailing as to this ground.

F. Discretionary Denial

Patent Owner contends that we should exercise discretion to deny institution under 35 U.S.C. § 314(a) based on “a balanced assessment of all

relevant circumstances in the case, including the merits.” Prelim. Resp. 71 (quoting PTAB Consolidated Trial Practice Guide at 58 (Nov. 2019); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12–16 (PTAB Mar. 20, 2020) (designated precedential)); *see id.* at 71–75. Petitioner preemptively argued against such denial. Pet. 83–85.

Because we deny based on the merits as discussed above, we decline to address the arguments raised for discretionary denial.

IV. CONCLUSION

For the above reasons, we *deny* the Petition and do not institute an *inter partes* review.

V. ORDER

It is

ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

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