

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASIMO CORPORATION,
Petitioners,

v.

APPLE INC.,
Patent Owner.

IPR2023-00831
Patent D735,131 S

Before KEN B. BARRETT, SCOTT A. DANIELS, and
ROBERT L. KINDER, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of Decision Denying Institution
37 C.F.R. § 42.71(d)

I. BACKGROUND

In a Decision entered November 21, 2023, we denied institution of trial with respect to the sole claim of U.S. Design Patent No. D735,131 S (“the ’131 patent”) on any ground of unpatentability asserted in the Petition. Paper 9 (“Dec.” or “Decision”). The Decision stated that the Petition asserted the following grounds of unpatentability:

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	1	103 ¹	Lee ²
2	1	103	Lee, Chiang ³
3	1	103	CN-470 ⁴
4	1	103	CN-470, Chiang
5	1	103	Murray ⁵
6	1	103	Murray, Chiang
7	1	103	Chiang

On December 21, 2023, Petitioner filed a Request for Rehearing (“Request” or “Req. Reh’g”) (Paper 10). First, Petitioner requests that we reconsider the denial of the Petition based on our claim construction because “[t]he Board ignored most of the *Berry Sterling* factors (concomitant utility

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103, effective March 16, 2013. Given that the application from which the ’131 patent issued was filed after this date, the current version of § 103 applies.

² Ex. 1006, UK Registered Design No. 4032616 (reg. date Nov. 2, 2013)

³ Ex. 1009, U.S. Design Patent No. 720,289 S (iss. Dec. 30, 2014).

⁴ Ex. 1007, China Design Patent Application, CN 201330531838, (published July 2, 2014)

⁵ Ex. 1008, U.S. Design Patent No. 718,236 S (iss. Nov. 25, 2014).

patents, etc.), Decision at 13-21, which the Federal Circuit has explained are “a useful guide for claim construction functionality.” Req. Reh’g 2 (citing *Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1322 (Fed. Cir. 2016); *see also Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed. Cir. 1997)).⁶ Petitioner argues that with respect to functionality, we only addressed alternative designs, and not for example, the Apple utility patents relating to the claimed “Charger.” *Id.*

Second, Petitioner argues that we misapprehended Petitioner’s argument that “aspects of the D’131 Patent’s claimed design were functional and should thus be ‘factored out’ of the claimed design’s scope.” *Id.* Petitioner argues that by “factoring out” functional aspects of the claimed design, it simply “proposed limiting the scope of the D’131 Patent to the non-functional (i.e., ornamental) aspects of the claimed design.” *Id.* at 3 (citing Dec. at 14–30). In this regard, Petitioner argues, specifically, that “[t]he Decision erred by refusing to account for the functional aspects of the claimed design in construing the scope of the claim.” *Id.* (citing *Sport Dimension*, 820 F.3d at 1320).

On request for rehearing, the burden of showing a decision on whether to institute trial should be modified lies with the party challenging the decision. 37 C.F.R. § 42.71(d). “When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R.

⁶ For the factors, the Petition (Pet. 11–12) cites, *inter alia*, *Sport Dimension*, 820 F.3d at 1322, which quotes a list of factors set out in *Berry Sterling*, 122 F.3d at 1456; *see also* Pet. 11 (citing *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1329–30 (Fed. Cir. 2015) for the first factor—whether alternative designs exist)). The Request refers to those as the “*Berry Sterling* factors.” *See, e.g.*, Req. Reh’g 2.

§ 42.71(c). “The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.”

37 C.F.R. § 42.71(d). For reasons discussed below, we decline to modify the Decision. Thus, Petitioner’s Request is denied.

II. ANALYSIS

A. *Alleged Misapprehension and Berry Sterling Factors*

As an initial matter, we disagree with Petitioner’s position in its Request that “by ‘factored out’ Masimo did not propose eliminating entire features from the claimed design’s scope.” Req. Reh’g 2–3. In its Petition, Petitioner stridently argued that alleged functional aspects of the claimed design should be “factored out.” *See* Pet. 14 (Petitioner arguing that “[t]he claimed Apple Watch charger design includes numerous design elements that are functional and should thus be ‘factored out’ of the Challenged Claim’s scope.”). Petitioner cited to *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288 (Fed. Cir. 2010), arguing that “when a design patent contains functional and ornamental elements, the claimed design’s “scope is limited to [the ornamental] aspects alone and ***does not extend to any functional elements of the claimed article.***” *Id.* at 11 (citing *Richardson*, 597 F.3d at 1293-94). Indeed, the Petition was unambiguous about the meaning of “factored out.” Petitioner summarized its functionality arguments, expressing that functional aspects of the charger design should be “disregarded” in the same manner as unclaimed aspects of the design shown in broken lines:

[E]ach of the above-discussed design elements is dictated by function and should thus be “factored out” of the Challenged Claim’s scope. *Richardson*, 597 F.3d at 1293-94, *see, e.g.*,

Campbell, IPR2017-00096, Paper 28 at 14; EX1014 ¶55. Broken lines are expressly disclaimed and *should also* be disregarded. EX1001, Description.

Pet. 30 (emphasis added). We did not misapprehend Petitioner’s arguments in this regard.

To the extent that Petitioner has now changed the thrust of its argument, and is, in this Request, attempting to soften its position in the Petition as to disregarding functional elements, as we discuss below, our consideration of functional elements as part of the overall ornamental appearance of the claimed design is appropriately consistent with *Sport Dimension* and *Berry Sterling*.

Turning to the *Berry Sterling* factors, contrary to Petitioner’s arguments in its Request, we agreed, essentially, in our Decision with Petitioner that there are aspects of the claimed design which are functional. For example, we considered the testimony of Brian Land, an Apple Engineer who described during an ITC hearing that

[t]he Apple Watch charges wirelessly through a dock that has a complementary shape, and the dome-shape, when in combination with the charging cradle, in addition to providing additional space for the charging coils, it also provides a self-centering mechanism so that, when you place it on the cradle, it aligns itself well to the other -- the charger for efficient wireless charging.

Dec. 16 (citing Ex. 1021, 959:21–960:2). We explained in our decision that “[t]o the extent it is functional, the alignment, or self-centering feature of the charger does not mean that we are to ignore the ornamentality of the front face of the charger including a recessed center portion as illustrated in the claimed design.” *Id.* (citing Pet. 14–24). To be clear, there was no need in our Decision to set forth, in excruciating detail, the multiple functional

aspects of the claimed design because we did not, and do not now, disagree that there are aspects of at least the commercial embodiment of the design, if not the claimed design, for instance the complementary “self-centering” concave shape of the charger in combination with the watch, which are functional.⁷

Notably, our claim construction does not include most, if not all, functional characteristics which Petitioner described in detail as functional features of the claimed design. For example, Petitioner spends almost ten pages arguing that the *concave* recessed center portion is functional. Pet. 14–24. Some of those arguments are based on the appearance and function of the purported commercial embodiment. *See, e.g., id.* at 13. For example, Petitioner argues with respect to the particular self-centering feature of the recessed center portion, “that the recessed center portion is sized and shaped to receive and align with the convex surface on the back of the Apple Watch.” *Id.* at 15. Further, Petitioner argues, *inter alia*, that Apple’s marketing on its website describes that “[t]he concave end of the charging cable’ mates with the ‘back of the Apple Watch and aligns it properly.’” Pet. 18 (citing Ex. 1022). We did not discount these arguments and evidence, and we gave that evidence the weight it is due. In this regard, our claim construction does not include any functional aspects such as the “self-centering” nature of the recessed center portion. Our claim construction states, in part:

Considering the overall visual impression of the claimed charger as shown in Figures 1–11 of the ’131 patent, . . . [t]he top face is dominated by a prominent circular recess that is inset relative to

⁷ We pointed out in our Decision that “we cannot discern from the figures that the circular recess as illustrated in the Figures is concave.” Dec. 19.

a flat ring having a distinct proportional width relative to the circular recess.

Dec. 18. Indeed, Petitioner’s reliance on the Apple watch and concave/convex characteristics for alignment with the Apple charger appear to be derived from the commercial Apple charger embodiments, but these characteristics do not appear as elements of the claimed design. *See Berry Sterling*, 122 F.3d at 1455 (In *Berry Sterling* the Federal Circuit explained that “the court cannot use the limitations of the commercial embodiment of the underlying article of manufacture to impose limitations on the scope of the design patent.”).

Our Decision and claim construction are consistent with case law requiring that a proper claim construction evaluate the overall ornamental aspects of the claimed design including at least some consideration of functional elements that should not be disregarded, or “factored out” as Petitioner argues. *See Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1323 (Fed. Cir. 2016) (The Court explaining that for a personal flotation device, where “the armbands and side torso tapering serve a functional purpose, so the 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.”).

Lastly, Petitioner’s Request for Rehearing does not propose that we misapprehended or overlooked any matter in our assessment that a designer of ordinary skill in the art would have determined that the prior art fails to teach the claimed design of the ’131 patent. *See* Dec. 21–80.

Accordingly, we have considered Petitioner’s Request for Rehearing but conclude that it does not establish that we misapprehended or overlooked any matter in declining to institute *inter partes* review based on the Petition.

B. Request to Defer Decision on Request for Rehearing

Petitioner requests that “[t]he Board should defer deciding this Request for Rehearing until the Federal Circuit issues its en banc opinion in *LKQ [Corp. v. GM Glob. Tech. Operations LLC*, 71 F.4th 1383 (Fed. Cir. 2023)].” Req. Reh’g. 3. Petitioner contends that because some change in the law may occur at some later date, it would be a waste of the Board’s resources to decide the Request for Rehearing based on current law, and also Petitioner would be subject to “undue prejudice” and “unfairness” unless any decision is deferred. *See id.* at 8.

As noted above, Petitioner has the burden to show that a decision should be modified by identifying matters that the Board misapprehended or overlooked in reaching its original decision. *See supra* § II.A.; 37 C.F.R. § 42.71(d). Petitioner’s request for a deferred decision on its Request for Rehearing is not a basis within our rules for granting a request for rehearing. Moreover, the Board construes its rules “to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). It is difficult to discern how those principles are fulfilled based on Petitioner’s deferral request. Petitioner prepared and filed its Petition based on current law governing design patents, Patent Owner responded via its Preliminary Response (Paper 8), and we denied institution after considering those filings based on current law. The parties, thus, had their say on the matter and this proceeding is now resolved. Furthermore, Petitioner was afforded ample opportunity to make its case, which ultimately was unsuccessful. Petitioner does not explain credibly why any matters of “undue prejudice” or “unfairness” arise simply because Petitioner has a speculative belief that a

potential different outcome might result from some possible future change in the law pertaining to design patent obviousness.

Accordingly, we decline to defer reaching a decision on Petitioner's Request for Rehearing.

III. CONCLUSION

For the reasons set forth above, Petitioner's Request for Rehearing is *denied*.

IV. ORDER

It is

ORDERED that Petitioner's Request for Rehearing is denied

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