

Design Patent Case Digest

[Munchkin, Inc. and Toys "R" US, Inc. v. Luv N' Care, LTD.](#)



Decision Date: April 21, 2014 and April 14, 2015

Court: Patent Trial and Appeal Board and U.S. Court of Appeals for the Federal Circuit

Patents: [D617,465](#)

Holding: Claimed design is obvious and therefore UNPATENTABLE, summary affirmance by the Federal Circuit

Opinion:

Petitioners Munchkin, Inc. and Toys "R" Us, Inc. filed a petition requesting *inter partes* review of the sole claim of patent D617,465. Patent owner, Luv N' Care, Ltd., did not respond to the petition. The petition was granted on April 25, 2013 on the grounds that the patent was obvious. The D617,465 patent, entitled "Drinking Cup," claims "the ornamental design for a drinking cup." The patent was the subject of three litigations and an *inter partes* reexamination. Luv N' Care asserted the D617,465 patent against Toys "R" Us in one of the litigations.

In initiating *inter partes* review, the Board considered two references that raised a question of claim validity. The references are U.S. Patent Application [2007/0221604 A1](#) and U.S. Patent No. [6,994,225](#). Luv N' Care did not argue that its patent's claim was patentably distinct from the references. Instead, it argued that the references should not be considered prior art. The '604 application published on September 27, 2007 and the '225 patent issued on February 7, 2006. The patent at issue was filed on October 31, 2007. However, the application was filed as a continuation of U.S. Application [10/536,106](#) which is the national stage of PCT Application, [PCT/US2003/024400](#), filed August 5, 2003. Thus, Luv N' Care argued that the claim of the '465 patent should be awarded an effective filing date of August 5, 2003, thereby disqualifying the two references as prior art.

A continuation must comply with the written description requirement to claim the benefit of the parent application's effective filing date. The written description requirement is satisfied if what is expressed in the application "reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter." For design patents, drawings provide the disclosure. Therefore, the ultimate question in a design patent priority inquiry is whether the drawings of the earlier application disclose the subject matter claimed in the later application.

Munchkin claimed that the '106 application does not satisfy the written description requirement necessary to support the '465 patent. Specifically, Munchkin argued that the spout of the claimed design and the spout in the '106 application are different. The Board noted three key differences between the two spouts. First, the outer boundary of the spout disclosed in the '465 patent is larger than that disclosed in the '106 application. Second, the spout of the '465 patent is more oval in shape than the '106 application that discloses a more "racetrack shape." Third, the '465 patent discloses three concentric rings that the '106 application does not. Luv N' Care

argued that the specifications provide that the drawings were simply a “preferred embodiment” and that “another shape may be provided if desired.” The Board rejected this contention saying that the design and statement does not “reasonably convey to those skilled in the art that the inventor had possession of the claimed design.” As such, the Board held that the patent is not entitled to the earlier priority date and thus the two references are prior art.

In an attempt to save the patent, Luv N' Care proposed to amend the five drawings to which the claim refers. The amended drawings sought to claim an embodiment that would be supported by the initial disclosure made in the '106 application. One of the proposed amendments was to narrow the spout tip to a racetrack-shaped design. The Board rejected the proposed amendment on two grounds. First, the Board held that the proposed amendment was not responsive to a ground of unpatentability raised at trial as required. Second, the Board held that the proposed amendment impermissibly enlarged the scope of the claim in *inter partes* review. The Board noted that an amendment enlarges the scope of the claim if an item would not have infringed prior to amendment but could infringe after the amendment. In the context of the current patent, the Board held that “a drinking cup, having the racetrack-shaped spout tip and raised rim vent of the proposed amended claim, could infringe the proposed amended claim based on its overall design, yet not infringe the issued claim.” The Board rejected the proposed amendment and held the patent invalid.

After the Board issued its decision finding the claimed design of the '465 patent unpatentable, Luv N' Care appealed the decision to the Federal Circuit. But the Federal Circuit simply issued a summary affirmance of the Board's decision under Rule 36. On May 12, 2015, Luv N' Care requested an *en banc* rehearing by the Federal Circuit.

If you have any questions or would like additional information on this topic, please contact:

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