



PTAB Declines to Institute Post-Grant Review Because “New” Figures in Design Patent Were Sufficiently Supported in Parent Application

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The design patent-at-issue (the '723 patent) claimed a “convertible dress” and included eight figures disclosing different views of the claimed dress. The '723 patent was filed on August 10, 2013—after the March 16, 2013, cutoff date for post-grant review. The patent, however, is a divisional of, and claimed priority to, its parent patent (the '548 patent) that was filed on February 12, 2012. The question before the PTAB was whether the '723 patent could claim the effective filing date of the parent patent to escape post-grant review. The petitioner argued that the earlier filing date was improper because the '723 patent included three figures that were different from the corresponding figures in the parent '548 patent. In particular, the petitioner alleged that the length of the “new” dresses in the three figures was longer than the length of the dresses in the counterpart figures in the '548 patent and thus not sufficiently disclosed in the parent patent.

The PTAB rejected the petitioner’s argument. Although the PTAB agreed that the three figures were modified to show a longer-length dress, it recognized that the petitioner’s arguments were improperly focused on “differences between versions of individual figures as opposed to viewing the claimed convertible dress as a whole.” Citing to one of its earlier opinions on design patents, the PTAB reiterated that “the test for new matter is not whether the desired correction was ever specifically illustrated in a particular figure as filed, but whether there is any support anywhere in the drawings for the necessary or desirable figure corrections.” Here, the PTAB found that the parent '548 patent disclosed both a long and short version of the convertible dress, and that the exact same figure of the longer dress from the parent patent (figure 5) was included in the '723 patent (figure 1). Thus, because the parent '548 patent

disclosed the “longer dress” claimed in the new figures in the ’723 patent, the PTAB held that the ’723 patent could rely on the pre-March 16, 2013 effective filing date and denied institution of the post-grant review petition.

David’s Bridal, Inc. v. Jenny Yoo Collection, Inc., PGR2016-00041 (PTAB Feb. 22, 2017) (Paper No. 9).

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