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STANDARD FOR TRIAL EXTENSIONS BEFORE TTAB

By [Subaru R. Kanesaka](#)


[Araujo v. Framboise Holdings Inc.](#), Appeal No. 2023-1142

(Fed. Cir., April 30, 2024, [Lourie](#), Linn, and Stoll)

- The Trademark Trial and Appeal Board is not required to consider detailed facts in order to grant a motion for extension of an opposer’s trial period.
- 標審理判部は、異議申立人の審理期間を延長する動議を認めるための詳細な事実を考慮することを要求されていない。
- 상표심판부는 이의신청인의 심리기간 연장신청을 인정하기 위해 상세한 사실관계를 고려할 필요가 없다.
- 商标评审委员会无需考虑详细的事实即可批准异议人延长审判期限的动议。

Background:

On December 3, 2019, Jalmar Araujo (hereinafter “Araujo”) filed U.S. Trademark Application Serial No. 88/712823 to register #TODECACHO as a standard character mark for hair combs based on intent to use the mark in commerce. Framboise Holdings Inc. (hereinafter “Framboise”) filed opposition to the registration of Araujo’s mark at the Trademark Trial and Appeal Board (“the Board”), asserting

that it would likely cause confusion with its #TODECACHO design mark: . Framboise alleged ownership of the #TODECACHO design mark based on its prior use of the mark in the United States in connection with various hair products (*i.e.*, shampoo, conditioner, hair mask treatments, hair

cream, curly hair activator, hair jelly). Framboise argued that its prior use began as early as March 24, 2017.

The final day of the 30-day trial period in which Framboise could submit its case to the Board, Framboise moved to extend its trial period by seven days. Four days after filing that motion, Framboise served Araujo with the declaration of Adrian Extrakt, Director of Framboise. Araujo opposed the motion and the late submission of the Extrakt declaration, but the Board granted the extension. Framboise then relied on the Extrakt declaration to support its first use date of the #TODECACHO design mark.

The Board held that Framboise had met its burden to establish prior use by a preponderance of evidence, found a likelihood of confusion between the two marks, sustained the opposition, and refused registration of Araujo's mark. Araujo timely appealed.

Holding:

The Federal Circuit concluded that (i) the Board did not abuse its discretion in granting the extension and (ii) the Board's determination that Framboise established its prior use of the #TODECACHO design mark was supported by substantial evidence.

Discussion:

The Federal Circuit held that the Board applied the correct good cause standard and reasonably found good cause to grant the extension based on the record, because (a) the motion for extension was filed prior to the close of the discovery period, so the applicable standard for the extension is good cause; (b) it was Framboise's first extension request and there was no evidence of record that Framboise was guilty of negligence or bad faith; and (c) although the motion did not provide the particular facts surrounding the need for an extension, the email correspondence between the opposing counsels indicated that Framboise "was experiencing an unexpected delay." Therefore, the Federal Circuit concluded that the Board did not abuse its discretion in granting the extension.

The Federal Circuit also held that the Board's decision finding that Framboise was entitled to a priority date of March 24, 2017, was supported by substantial evidence. The Extrakt declaration provides a list of products and a specific date on which Framboise began using the #TODECACHO design mark in connection with those products, and also provides representative examples of the mark as displayed on products in stores in the United States. The court found that a reasonable mind could conclude, from the Extrakt declaration alone, that Framboise had established priority, so the Board's decision was supported by substantial evidence.

ROSEN-DURLING OVERRULED

By [Chang Yang](#)

[LKQ Corp. v. GM Global Tech. Operations LLC](#), Appeal No. 2021-2348

(Fed. Cir. May 21, 2024, *En Banc*)

- The Court of Appeals for the Federal Circuit, sitting en banc, overrules the *Rosen-Durling* Test for evaluating obviousness of design patents as improperly rigid, returning to the approach set forth in prior Supreme Court cases such as *Smith v. Whitman Saddle*, 148 U.S. 674 (1893),

Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966), and *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007).

- 連邦巡回控訴裁判所の大法廷は、意匠特許の自明性を評価する *Rosen-Durling* テストが不適切に厳格であるためこれを覆し、最高裁判所における先の事件、例えば *Smith* 対 *Whitman Saddle*, 148 U.S. 674 (1893), *Graham* 対 *John Deere Co. of Kansas City*, 383 U.S. 1 (1966), および *KSR Int'l Co. 対 Teleflex, Inc.*, 550 U.S. 398 (2007), で定められた手法に立ち返るものとする。
- 연방순회항소법원 대법원은 디자인 특허의 자명성을 평가하는 *Rosen-Durling* 테스트가 지나치게 엄격하다는 이유로 이를 뒤집고, 대법원 판례, 예를 들어 *Smith v. Whitman Saddle*, 148 U.S. 674 (1893), *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), *KSR Int'l v. Teleflex, Inc.*, 550 U.S. 398 (2007), 에서 규정한 방법으로 돌아갔다.
- 联邦巡回上诉法院全庭推翻了用于评估外观设计专利显而易见性的罗森-德林测试，认为其过于死板，回归了先前最高法院案件中阐明的方法，如 *Smith* 诉 *Whitman Saddle* 案 148 U.S. 674(1893)、*Graham* 诉 *John Deere Co. of Kansas City* 公司案 383 U.S. 1(1966) 和 *KSR* 国际公司诉 *Teleflex, Inc.* 公司案 550 U.S. 398(2007)。

Background:

LKQ was a licensed part vendor for GM until failed license renewal negotiations. The unlicensed parts allegedly infringed GM's design patent (D797,625, hereinafter "D'625 patent"). LKQ petitioned the Patent Trial and Appeals Board ("Board") for Inter Partes Review ("IPR") of the D'625 patent under 35 U.S.C. §§ 102 and 103. The Board found no anticipation because the accused part and the claimed design are not substantially the same. Regarding obviousness, the Board applied the two-step *Rosen-Durling* test (*Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100 (Fed. Cir. 1996); *In re Rosen*, 673 F.2d 388 (C.C.P.A. 1982)) and held that at the first step LKQ failed to identify a *Rosen* reference that is basically the same as the claimed design. Since no *Rosen* reference was found, the Board ended its obviousness analysis without considering the second step whether the prior art that was "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. LKQ appealed to the Federal Circuit and argued that the analysis used in *KSR* to evaluate obviousness of utility patents, rather than the *Rosen-Durling* test, should apply to design patents. A panel of the Federal Circuit affirmed and explained that "it could not "overrule *Rosen* or *Durling* without a clear directive from the Supreme Court" and "it is not clear" that the Supreme Court had done so." The Federal Circuit granted rehearing en banc.

Holding:

The Federal Circuit overruled the *Rosen-Durling* approach to analyzing obviousness of design patents as improperly rigid, holding that the approach used in *Graham* should be used instead. The Board's finding of no anticipation was affirmed, and the Board's determination of non-obviousness of the D'625 patent was vacated and remanded.

Discussion:

The Federal Circuit rejected the *Rosen-Durling* test, finding that the two steps of that test represent an improperly rigid approach to obviousness analysis. The court reasoned that the statutory rubric and the Supreme Court precedent in *Whitman Saddle*, *Graham*, and *KSR*, all require a more flexible approach than the *Rosen-Durling* test when analyzing obviousness of a patent. The court specifically noted that the Supreme Court rejected a rigid application of the “teaching, suggestion, motivation” test applied by the Federal Circuit in the utility patent context of *KSR* as being too rigid.

Finding particular fault with the combination of the *Rosen* “basically the same” standard and the *Durling* “so related” standard, the Federal Circuit confirmed that obviousness of design patent claims should be evaluated based on the more flexible factors used in *Graham*. The *Graham* factors require that the fact finder consider “the scope and content of the prior art; differences between the prior art and the claims at issue; and the level of ordinary skill in the pertinent art.”

The scope and content of prior art to be considered is that within the knowledge of an ordinary designer in the field of the design, without any threshold similarity requirement, but subject to a requirement that the prior art be analogous, broadly similar to the two-part approach used for utility patents. The Federal Circuit noted, however, that analysis of a problem to be addressed by a design patent, in order to evaluate whether a reference is analogous, is not straightforward, since design patents have no written description that can reveal such motivation. The court declined to elucidate a full approach to determining whether a reference is analogous in the design context, but noted that obviousness analysis requires identifying a primary reference design that is actually in existence in the prior art.

Since design patents protect the appearance of a design, the court stated that, in determining the differences between the prior art design and the design claim at issue, the fact finder should determine the differences in visual appearance between the claimed design and prior art designs from the perspective of an ordinary designer in the field. The level of ordinary skill in the art is resolved based on the knowledge of a designer of ordinary skill who designs articles of the type involved. After ascertaining the knowledge of the ordinary designer in the relevant field, obviousness is evaluated by ascertaining whether the ordinary designer would have been motivated to modify the prior art design to create the same overall visual appearance as the claimed design, an inquiry that can rely upon more than one prior art reference.

The Federal Circuit also confirmed that secondary considerations like commercial success and copying can be considered in resolving whether a design patent is obvious.

ADDITIONAL INFORMATION

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