

*Appeal Nos. 18-2029, 18-2030*

---

---

IN THE  
**United States Court of Appeals**  
FOR THE FEDERAL CIRCUIT

---

CAMPBELL SOUP COMPANY,  
CAMPBELL SALES COMPANY,  
TRINITY MANUFACTURING, LLC,

*Appellants,*

*v.*

GAMON PLUS, INC.,

*Appellee.*

---

*On Appeal from the United States Patent  
and Trademark Office, Patent Trial and Appeal Board  
in Nos. IPR 2017-00091 and IPR 2017-00094,  
Entered March 29, 2018  
The Honorable Bart Alex Gerstenblith  
The Honorable Grace Karaffa Obermann  
The Honorable Robert L. Kinder*

---

---

**GAMON PLUS, INC.'S COMBINED PETITION  
FOR REHEARING *EN BANC* AND PANEL REHEARING**

---

---

Andrew L. Tiajolloff  
TIAJOLOFF & KELLY LLP  
*Attorneys for Appellee*  
405 Lexington Avenue, 37<sup>th</sup> floor  
New York, New York 10174  
212-490-3285  
atiajolloff@tkiplaw.com

## CERTIFICATE OF INTEREST

Counsel for Appellee, Gamon Plus, Inc., certifies the following:

1. The full name of parties represented by me:

Gamon Plus, Inc.

2. The name of real party in interest (excluding any real party in interest identified in question 3) represented by me is:

Gamon Plus, Inc. (owner of 100% of title in U.S. patents D612,646 and D621,645), and

Gamon International, Inc., its licensed affiliate.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or *amicus curiae* represented by me are:

None.

4. The names of all law firms and partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

Edward P. Kelly, Tiajolloff & Kelly LLP.

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. See Fed. Cir. R. 47.4(a)(5) and 47.5(b):

*Gamon Plus, Inc. et al. v. Campbell Soup Company, et al.,*

Case No. 15-CV-8940-CRN/YBK

U.S. District Court for the Northern District of Illinois.

October 9, 2019

/Andrew L. Tiajolloff/  
Andrew L. Tiajolloff  
Tiajolloff & Kelly LLP  
Chrysler Building, 37th floor  
405 Lexington Avenue  
New York, NY 10174

**TABLE OF CONTENTS**

	<i>Page</i>
CERTIFICATE OF INTEREST .....	i
STATEMENT OF COUNSEL – FEDERAL CIRCUIT RULE 35(B)(2).....	1
I. INTRODUCTION AND STATEMENT OF THE CASE .....	3
II. POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED BY THE PANEL .....	7
III. ARGUMENT .....	9
A. The Panel ruling did not correctly apply the law of obviousness for design patents to this case because it made impermissible substantial modifications to the proposed primary reference relying on utility-patent functional theories, not aesthetic or ornamental features. ....	9
1. Federal Circuit precedent holds that a reference cannot be substantially modified using utility-patent functional concepts to make it into a primary reference. ....	10
2. The Panel majority modified Linz using utility-patent functional principles without any ornamental or aesthetic considerations to convert Linz into a primary reference. ....	11
B. The Panel failed to determine whether the PTAB had substantial evidence supporting its decision that Linz was not a proper primary reference, but instead improperly substituted the Panel’s own factual interpretation of Linz for that of the PTAB. ....	12
1. Reversal of a PTAB finding of fact on judicial review requires a determination that it is impossible that a reasonable mind would have come to the conclusion based on the record. ....	13
2. The Panel majority reversed the PTAB’s finding without considering the evidence that was before the PTAB, and instead improperly substituted its own reading of the Linz reference for that of the PTAB. ....	14

C. Even if the Panel reversal of the PTAB finding regarding Linz were correct, the Panel should still have affirmed the PTAB ruling because the PTAB’s ultimate determination of nonobviousness was supported by the undisturbed fact finding in the alternative that, even if Linz were accepted as a primary reference, overwhelming secondary considerations nonetheless established nonobviousness. .... 16

IV. CONCLUSION ..... 20

ADDENDUM

CERTIFICATE OF SERVICE

CERTIFICATE OF COMPLIANCE

**TABLE OF AUTHORITIES**

**CASES**

*Apple, Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034 (Fed. Cir. 2016)  
 (*en banc*) .....17

*Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314 (Fed. Cir. 2012) .....10

*Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355 (Fed. Cir. 2016) .....19

*Campbell Soup Co. v. Gamon Plus, Inc.*, No. 2018-2029,  
 2019 WL 4678100 (Fed. Cir. Sept. 26, 2019) ..... passim

*Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294 (Fed. Cir. 2010) .....18

*Dickinson v. Zurko*, 527 U.S. 150, 119 S.Ct. 1816, 144 L.Ed.2d 143  
 (1999) .....2, 8, 13

*Durling v. Spectrum Furniture Co.*, 101 F.3d 100 (Fed. Cir. 1996) .....passim

*Elbit Sys. of Am., LLC v. Thales Visionix, Inc.*, 881 F.3d 1354 (Fed. Cir.  
 2018) .....2, 3, 14

*Game & Tech. Co. v. Activision Blizzard Inc.*, 926 F.3d 1370 (Fed. Cir.  
 2019) .....14

*Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 86 S. Ct. 684,  
 15 L. Ed. 2d 545 (1966) ..... 13

*In re Harvey*, 12 F.3d 1061 (Fed. Cir. 1993) .....passim

*Munoz v. Strahm Farms, Inc.*, 69 F.3d 501, 504 (Fed.Cir.1995) .....16

*Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358 (Fed.  
 Cir.2008) ..... 18

*SAS Institute Inc. v. Iancu*, — U.S. —, 138 S. Ct. 1348, 200 L.Ed.2d 695  
 (2018) .....6

*In re Van Os*, 844 F.3d 1359 (Fed. Cir. 2017) .....19

*Vicor Corp. v. SynQor, Inc.*, 869 F.3d 1309, 1319 (Fed. Cir. 2017) .....13

*In re Watts*, 354 F.3d 1362 (Fed. Cir. 2004) .....2, 16

**STATUTES**

Administrative Procedure Act (APA), 5 U.S.C. § 706 .....18

**STATEMENT OF COUNSEL - FEDERAL CIRCUIT RULE 35(B)(2)**

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

1. In a design-patent obviousness analysis, is it proper to modify a reference using a utility-patent functional theory to make the reference qualify as a primary reference?
2. Is it proper to vacate a fact determination of the PTAB without a determination of whether substantial evidence supported that finding?
3. Is it proper to vacate and remand a PTAB determination of nonobviousness of a design patent based on a ruling that a reference should have been a primary reference where the PTAB also held the patent nonobvious based on the independent factual determination that, even using the reference as a primary reference, secondary considerations of copying and substantial commercial success establish nonobviousness over that reference?

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States



and precedents of this Court: *Dickinson v. Zurko*, 527 U.S. 150, 152, 119 S.Ct. 1816, 144 L.Ed.2d 143 (1999); *In re Watts*, 354 F.3d 1362 (Fed. Cir. 2004); *Elbit Sys. of Am., LLC v. Thales Visionix, Inc.*, 881 F.3d 1354 (Fed. Cir. 2018); *Durling v. Spectrum Furniture Co.*, 101 F.3d 100 (Fed. Cir. 1996); and *In re Harvey*, 12 F.3d 1061 (Fed. Cir. 1993).

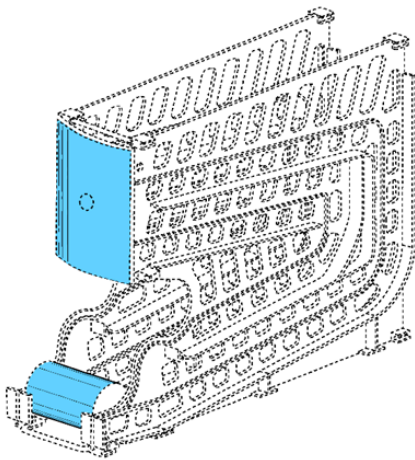
Dated: October 9, 2019

/Andrew L. Tiajolloff/  
Andrew L. Tiajolloff  
TIAJOLOFF & KELLY LLP  
*Counsel for Appellee Gamon Plus, Inc.*

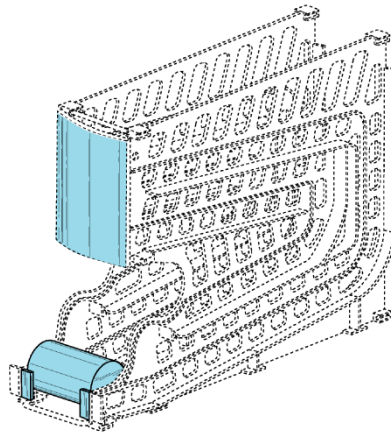
## I. INTRODUCTION AND STATEMENT OF THE CASE

This appeal is a consolidation of appeals from two *inter partes* reviews (“IPRs”) asserted against Appellee Gamon Plus, Inc.’s U.S. Design Patent Nos. D621,645 and D612,646 (hereinafter, “the ‘645 and ‘646 patents”), both of which were held valid and nonobvious over all challenges considered by the Patent Trial and Appeal Board (“PTAB”).

The ‘645 and ‘646 patents are directed to designs of displays developed by Appellee Gamon Plus specifically for the display of Campbell Soup cans in stores. Each patent has a single claim and a single figure, reproduced below with the claimed design of each patent highlighted.

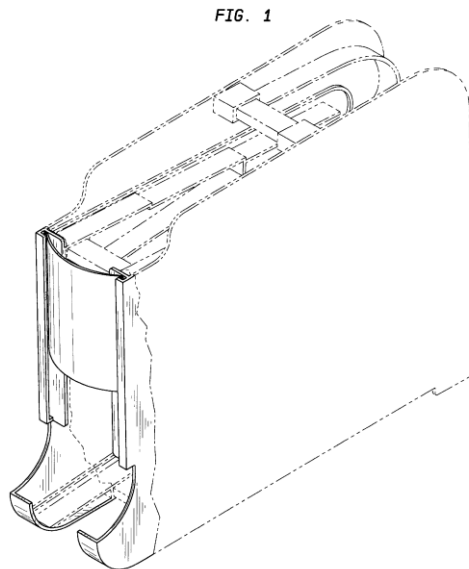


The ‘645 patent, Appx136  
(design highlighted in blue)



The ‘646 patent, Appx133  
(design highlighted in blue)

One of the challenges to the patents considered by the PTAB was an argument that the claims of the '645 and '646 patents were obvious based on U.S. Design Patent No. D405,622 ("Linz"), as a primary reference, in view of British Patent Application No. 2,303,624 ("Samways").



Linz, U.S. Patent No. D405,622  
FIG. 1

The PTAB rejected this obviousness challenge to the '645 and '646 design patents based on two factual findings:

1. that Linz was not a proper primary reference for the design-patent obviousness analysis because Linz did not show the placement or appearance of a cylindrical object in Linz, and therefore did not teach a design "in existence" that created basically the same visual

impression as the patented designs of the '645 and '646 patents.

Appx33-34, Appx94-95.

2. that, even if Linz were modified to supply a cylindrical object and then combined with Samways, it would still not render the '645 and '646 patents obvious due to a finding of overwhelming secondary considerations. Appx34-43, Appx95-104. The findings of secondary considerations included:
  - a. a finding that Appellants had clearly copied the designs of the '645 and '646 patents (Appx41-43, Appx103-104); and
  - b. a finding that the patented designs had experienced great commercial success based on
    - i. Appellee's sale to Appellants of about \$30 million of display racks that provided the patented display appearance (Appx40-41, Appx101-102) , and
    - ii. substantially increased soup sales by Appellant Campbell Soup from the nationwide use of displays using the designs of the '645 and '646 patents (Appx36-40, Appx97-101).

After appeal and argument before this Court, the Panel majority issued a decision on September 26, 2019, with the Honorable Pauline Newman dissenting.

*See Campbell Soup Co. v. Gamon Plus, Inc.*, No. 2018-2029, 2019 WL 4678100 (Fed. Cir. Sept. 26, 2019) (hereinafter, “the Panel Opinion”).

The Panel Opinion vacated the PTAB’s finding that Linz was not a proper primary reference, and, based on that finding, also vacated the PTAB’s conclusion that the claimed designs would not have been obvious over Linz in view of Samways, remanding for further consideration of that issue by the PTAB.<sup>1</sup> See Panel Opinion at 9-11.

Judge Newman dissented, expressing disagreement with the majority’s vacatur of the PTAB’s factual finding that Linz was not a proper primary reference against the ‘645 and ‘646 patents, and also expressing the view that substantial evidence supported the PTAB’s finding that Linz was not a proper primary reference.

---

<sup>1</sup> In addition to remanding to the PTAB to again review obviousness based on Linz in view of Samways, the Panel also directed that “[o]n remand, the Board should also consider the non-instituted grounds for unpatentability consistent with the Supreme Court’s decision in *SAS Institute Inc. v. Iancu*, — U.S. —, 138 S. Ct. 1348, 200 L.Ed.2d 695 (2018).” Panel Opinion at 11.

## **II. POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED BY THE PANEL.**

Pursuant to Federal Circuit Rules 36(e)(3)(F) and 40(a)(4), Appellee Gamon Plus provides this statement of points of law or fact that were overlooked or misapprehended by the Court in its Panel decision:

1. The Panel majority overlooked or misapprehended the import of controlling Federal Circuit decisions on the law of design-patent obviousness, *e.g.*, *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996), which require that there be a single reference that is “something in existence that creates basically the same visual impression as the claimed designs,” when it held that Linz could be modified by addition of a hypothetical can to make it a primary reference against the ‘645 and ‘646 patents.
2. The Panel majority overlooked or misapprehended the import of controlling Federal Circuit decisions, *e.g.*, *In re Harvey*, 12 F.3d 1061 (Fed. Cir. 1993), that prohibit application of utility-patent concepts of functionality in a design-patent obviousness analysis when the Panel majority applied utility-functionality analysis to the ornamental disclosure of Linz to create a hypothetical can in Linz with an aesthetic appearance similar to that of the cylindrical article in the designs of the ‘645 and ‘646 patents.

3. The Panel majority overlooked or misapprehended the binding effect of the United States Supreme Court's decision in *Dickinson v. Zurko*, 527 U.S. 150, 152, 119 S.Ct. 1816, 144 L.Ed.2d 143 (1999) and of the Federal Circuit decision in, e.g., *Elbit Sys. of Am., LLC v. Thales Visionix, Inc.*, 881 F.3d 1354, 1356 (Fed. Cir. 2018), in that, instead of determining whether substantial evidence supported the PTAB's factual finding that Linz was not a proper primary reference, the Panel majority substituted its own factual interpretation of Linz for that of the PTAB.

4. The Panel majority overlooked or misapprehended the fact that the PTAB's decision that the '645 and '646 patents were not obvious was supported by *two independent findings of fact* that each supported the determination of nonobviousness, and that therefore the Panel majority's reversal of only one finding (that Linz was not a proper primary reference) did not justify vacating the PTAB's obviousness decision because the PTAB's decision was also fully supported by the PTAB's other finding (that, even using Linz as a primary reference in combination with Samways, obviousness was not shown due to strong secondary considerations, namely Appellants' clear copying of the designs and the tens of millions of dollars of sales of the displays to Campbell Soup, as well as markedly increased soup sales due to use of the display designs).

### III. ARGUMENT

Rehearing of this appeal *en banc* or by the Panel is needed because the Panel Opinion was a radical departure from established law of obviousness of design patents that relaxes the standard for a primary reference and will impact and complicate both prosecution and litigation of design patents.

Rehearing is also needed because the Panel Opinion erodes the well-established law of the substantial-evidence standard of judicial review of the PTAB's factual findings, without which PTAB determinations and subsequent appeals will tend to be wasteful, unreliable, and dilatory proceedings.

Rehearing also should be ordered because the Panel's reversal of the PTAB's finding, even if correct, did not justify vacatur of the PTAB's entire finding of nonobviousness of the '645 and '646 patents because that ultimate finding of nonobviousness was *also* supported by *another factual finding* expressed by the PTAB in the alternative to the finding vacated by the Panel.

**A. The Panel ruling did not correctly apply the law of obviousness for design patents to this case because it made impermissible substantial modifications to the proposed primary reference relying on utility-patent functional theories, not aesthetic or ornamental features.**

In reversing the PTAB, the Panel majority did not correctly apply the law of obviousness in the design-patent context.

The PTAB found that Linz could not serve as a primary reference against



the '645 and '646 patents because Linz does not show or describe an article in the rack, and the '645 and '646 patents both show a specific exposed portion of the surface of a cylindrical article as a significant part of the patented designs.

Appx29-34, Appx90-104. The Panel Opinion reversed that finding, holding that Linz was designed “for dispensing cans and a can would be used in the system.”

Panel Opinion at 9.

The Panel majority did not determine what the appearance of a hypothetical can would be in Linz, but it nonetheless concluded that the differences of Linz with a hypothetical can from the specific designs of the '645 and '646 patents were “ever so slight”. *Id.*

The Panel Opinion was clearly contrary to the established law of design-patent obviousness.

**1. Federal Circuit precedent holds that a reference cannot be substantially modified using utility-patent functional concepts to make it into a primary reference.**

Design-patent law differs from utility-patent law in that in a design-patent obviousness analysis, before one can begin to combine prior art designs, one must find a single reference, “a something in existence, the design characteristics of which are basically the same as the claimed design.” *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012). Any differences between the proposed primary reference and the claimed design must be *de minimis* in nature

and unrelated to the overall aesthetic appearance of the design. *In re Harvey*, 12 F.3d 1061, 1065-66, 29 U.S.P.Q.2d 1206 (Fed. Cir. 1993).

Unlike the readily available verbal description of the invention and of the prior art that exists in a utility patent case, a design patent case presents the court only with visual descriptions. *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996). Therefore, in considering prior art references for purposes of determining patentability of ornamental designs, the focus must be on appearances and not uses, and it is improper to mix principles of obviousness for utility patents with those for ornamental design patents. *In re Harvey*, 12 F.3d at 1064.

The Panel Opinion disregarded these principles.

**2. The Panel majority modified Linz using utility-patent functional principles without any ornamental or aesthetic considerations to convert Linz into a primary reference.**

The sole finding on which the Panel majority based its determination was that Linz could accommodate a can. *See* Panel Opinion at 9-10. Based solely on that functional theory of uses of the Linz rack, the Panel majority modified the design of Linz by supplying a hypothetical can, in direct violation of the rule of *In re Harvey*, 12 F.3d at 1064. The issues of the aesthetic appearance of a hypothetical can, such as its proportions and positioning, were completely disregarded and not mentioned by the Panel majority, except to state after the fact and without analysis or support, that the differences between Linz (as

impermissibly modified with the hypothetical can) and the ‘645 and ‘646 patents were “ever so slight”. Panel Opinion at 9.

The Panel Opinion was based on an improper legal analysis in that it violated the established Federal Circuit law of design-patent obviousness in two regards.

First, modifying Linz substantially by adding a hypothetical, cylindrical can to create a putative primary reference amounts to creation of a design that is not “in existence”, contrary to *Durling* and other precedent.

Second, using purely utility-patent functional principles unrelated to ornamental or aesthetic appearances to alter the appearance of Linz to make it a putative primary reference violates the design-patent law of *In re Harvey*.

Judge Newman in her dissent correctly identified both of these errors. *See* Panel Opinion, dissent at 5-6.

Rehearing by the Panel or *en banc* should therefore be granted to address these extreme departures from established Federal Circuit law.

**B. The Panel failed to determine whether the PTAB had substantial evidence supporting its decision that Linz was not a proper primary reference, but instead improperly substituted the Panel’s own factual interpretation of Linz for that of the PTAB.**

The determination of the scope and content of the prior art and the differences between the prior art and the claims at issue are findings of fact.

*Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S. Ct. 684, 694, 15 L. Ed. 2d 545 (1966). The PTAB’s determination that Linz was not a proper primary reference was therefore a finding of fact.

This Court reviews decisions by the PTAB under the standards set forth in the Administrative Procedure Act (APA), 5 U.S.C. § 706, which provides, in relevant part, “The reviewing court shall ... (2) hold unlawful and set aside agency action, findings, and conclusions found to be ... (E) unsupported by substantial evidence ... .” See *Vicor Corp. v. SynQor, Inc.*, 869 F.3d 1309, 1319 (Fed. Cir. 2017).

**1. Reversal of a PTAB finding of fact on judicial review requires a determination that it is impossible that a reasonable mind would have come to the conclusion based on the record.**

A finding of fact cannot be reversed simply because it is viewed by the reviewing court as incorrect. Rather, reversal of a finding of fact by the PTAB is only permissible where the finding is unsupported by substantial evidence. *Vicor Corp., supra*, 869 F.3d at 1320.

To determine whether a finding is supported by substantial evidence, the reviewing court must determine “whether a ‘reasonable mind might accept’ a particular evidentiary record as ‘adequate to support a conclusion.’” *Dickinson v. Zurko*, 527 U.S. 150, 162, 119 S. Ct. 1816, 1823, 144 L. Ed. 2d 143 (1999).

Explaining this standard of review, the Federal Circuit held:

If two inconsistent conclusions may reasonably be drawn from the evidence in record, the PTAB's decision to favor one conclusion over the other *is the epitome of a decision that must be sustained upon review for substantial evidence.*

*Game & Tech. Co. v. Activision Blizzard Inc.*, 926 F.3d 1370, 1375–76 (Fed. Cir. 2019), *citing Elbit Sys. of Am., LLC v. Thales Visionix, Inc.*, 881 F.3d 1354, 1356 (Fed. Cir. 2018) [emphasis supplied].

In other words, reversal of a PTAB finding of fact is only proper where *it is effectively impossible* that a reasonable mind would have come to the conclusion based on the record.

That standard of review was not applied in this case.

**2. The Panel majority reversed the PTAB's finding without considering the evidence that was before the PTAB, and instead improperly substituted its own reading of the Linz reference for that of the PTAB.**

The Panel majority simply (and improperly) expressed its view of Linz without addressing the issue of what evidence was before the PTAB.

That evidence included the Linz reference itself, which the PTAB exhaustively analyzed, including a visual comparison of its main figure to that of the '645 and '646 patents. *See* Appx21, Appx82. The PTAB also had before it the cross-examination of Appellants' expert, Mr. James Gandy, who admitted that it

would be “virtually impossible” to determine the size of a cylindrical article used in Linz. Appx1387.

In contrast, the Panel majority referred to none of the evidence before the PTAB, and instead relied exclusively on statements of counsel during oral arguments before the Panel that referred to a can. These statements included comments that were made *arguendo* or unclearly, and, more importantly, *none of those comments were before the PTAB in making its decisions*, and were therefore irrelevant to the proper inquiry of the adequacy of the evidence before the PTAB.

The Panel majority therefore did not apply the proper standard of judicial review in this case.

It should also be noted that Judge Newman in her dissent agreed with the PTAB’s factual findings. *See* Panel Opinion, dissent at 6. That shows that it is indeed *possible* for a reasonable person to come to the same conclusion as the PTAB based on the record here, negating the possibility of reversal on judicial review.

Therefore, contrary to established law, the Panel majority did not properly consider whether substantial evidence supported the PTAB’s finding, and rehearing should be granted to correct this manifest error.

**C. Even if the Panel’s reversal of the PTAB’s finding regarding Linz were correct, the Panel should still have affirmed the PTAB’s ruling because the PTAB’s ultimate determination of nonobviousness was supported by the undisturbed fact finding in the alternative that, even if Linz were accepted as a primary reference, overwhelming secondary considerations nonetheless established nonobviousness.**

To prevail in an appeal from the PTAB or a lower court, an appellant must not only show the existence of error, but also show that the error was in fact harmful because it affected the decision below. *In re Watts*, 354 F.3d 1362, 1369 (Fed. Cir. 2004). *See also, Munoz v. Strahm Farms, Inc.*, 69 F.3d 501, 504 (Fed.Cir.1995) (“The correction of an error must yield a different result in order for that error to have been harmful and thus prejudice a substantial right of a party.”).

Here, the PTAB determined nonobviousness of the ‘645 and ‘646 patents based on a refusal to consider Linz as a primary reference, and also, in parallel, based on reasoning in the alternative that, *even if* Linz were used as a primary reference and combined with Samways as Appellants contended, the extremely strong secondary considerations present established nonobviousness of the ‘645 and ‘646 patents. The PTAB decision stated:

The considerations and analysis discussed above [rejecting Linz as a primary reference] raise close factual questions because Linz’s overall ornamental appearance is similar to the design claim of the

'645 patent once Linz is modified by Samways to include a cylindrical object in the display area. For example, if Linz does qualify as a Rosen reference, the modifications suggested by Samways to the overall ornamental design, such as adding a cylindrical object forward of the label area could potentially create a design that has the same overall visual appearance as the claimed design. In cases such as this, the objective indicia of nonobviousness should be closely considered because "[a] determination of whether a patent claim is invalid as obvious under § 103 requires consideration of all four Graham factors, and it is error to reach a conclusion of obviousness until all those factors are considered." *Apple v. Samsung Elecs. Co.*, 839 F.3d 1034, 1048 (Fed. Cir. 2016) (en banc) (citations omitted).

\* \* \*

Gamon presents evidence of commercial success, praise, and copying attributable to the ornamental features of the patented design. As explained more fully below, Gamon also persuasively establishes a nexus, or relationship, between the ornamental features of the claimed design and the commercial success, praise, and copying of products implementing the design. Although some of the success of the commercial embodiments is attributable to utilitarian features and advertising, Campbell's internal documents and official public filings persuade us that the ornamental aspects of the commercial embodiment contributed to both the success of the sales of the display rack, and also to sales of soup cans displayed as part of the claimed design. On balance, the strength of the objective indicia of nonobviousness convinces us that the claim of the '645 patent would not have been obvious in light of the proposed combination of prior art.

Appx34-35; see also Appx95-96.

The PTAB then cataloged the extensive secondary considerations present, including a record "replete with evidence of copying" and commercial success based on the sale of about \$30 million worth of display racks by Appellee Gamon



Plus to Appellant Campbell Soup, as well as review of the Campbell Soup studies and annual reports showing substantial increases in soup sales due to the patented display designs. Appx36-43, Appx97-104. Indeed, the secondary considerations of copying and commercial success were so substantial and undeniable that Appellants could not meaningfully contest them.

Evidence of secondary considerations “is not just a cumulative or confirmatory part of the obviousness calculus but constitutes independent evidence of nonobviousness.” *Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294, 1310 (Fed. Cir. 2010), *citing*, *Ortho–McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1365 (Fed. Cir. 2008). The PTAB’s analysis of obviousness with secondary considerations was therefore a separate finding that independently supported the PTAB’s determination of nonobviousness. It is clearly separate from the issue of whether Linz was a proper primary reference because the determination of a primary reference does not involve secondary considerations.

Since the PTAB’s determination that the ‘645 and ‘646 patents were nonobvious was based on a parallel finding that was not disturbed by the Panel Opinion, it is respectfully submitted that vacatur and remand of the nonobviousness finding with respect to the Linz in view of Samways challenge was not proper or justified here.

It may be noted that vacatur and remand have sometimes been deemed proper where the PTAB failed to provide an explanation of how it arrived at its conclusions. *See, e.g., In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017) (finding of obviousness without explanation vacated and remanded). However, where, as here, there is an adequate explanation of the PTAB's analysis, remand is not appropriate. *See Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1366 (Fed. Cir. 2016) (no remand because "this is not a case where a more reasoned explanation than that provided by the Board can be gleaned from the record").

The present case has ample explanation of the surviving factual finding of nonobviousness in that the PTAB exhaustively expressed its reasoning regarding secondary considerations in about ten (10) pages of its Final Written Decisions. *See* Appx34-43, Appx95-104.

Vacatur and remand of the conclusion of nonobviousness of the '645 and '646 patents is not proper because the PTAB's ultimate holding of nonobviousness over Linz and Samways is completely supported by a second (and independent) finding of fact addressing the cited references and including secondary considerations of copying and substantial commercial success.

The PTAB's finding of nonobviousness based on Linz and Samways should therefore have been affirmed, not vacated.

**IV. CONCLUSION**

Rehearing *en banc* or panel rehearing should be granted so the Court can consider and resolve the legal principles and standards of review that were overlooked by the Panel majority in this case.

For the foregoing reasons, Appellee Gamon Plus respectfully requests that the Court grant rehearing *en banc* or a panel rehearing of this case, vacate the Panel Opinion, and rehear this appeal.

Respectfully submitted,

Dated: October 9, 2019

/Andrew L. Tiajolloff/  
Andrew L. Tiajolloff  
TIAJOLLOFF & KELLY LLP  
Chrysler Building, 37th Floor  
405 Lexington Avenue  
New York, New York 10174  
tel. 212-490-3285  
fax 212-490-3295  
atiajolloff@tkiplaw.com

*Counsel for Appellee Gamon Plus, Inc.*

# **ADDENDUM**

**United States Court of Appeals  
for the Federal Circuit**

---

**CAMPBELL SOUP COMPANY, CAMPBELL SALES  
COMPANY, TRINITY MANUFACTURING, LLC,**  
*Appellants*

v.

**GAMON PLUS, INC.,**  
*Appellee*

---

2018-2029, 2018-2030

---

Appeals from the United States Patent and Trademark  
Office, Patent Trial and Appeal Board in Nos. IPR2017-  
00091, IPR2017-00094.

---

Decided: September 26, 2019

---

TRACY ZURZOLO QUINN, Holland & Knight LLP, Phila-  
delphia, PA, argued for all appellants. Appellants Camp-  
bell Soup Company, Campbell Sales Company also  
represented by STEVEN E. JEDLINSKI, Chicago, IL.

MARTIN B. PAVANE, Cozen O'Connor, New York, NY, for  
appellant Trinity Manufacturing, LLC. Also represented  
by DARREN SCOTT MOGIL.

ANDREW L. TIAJOLOFF, Tiajoloff & Kelly LLP, New York, NY, argued for appellee.

---

Before PROST, *Chief Judge*, NEWMAN and MOORE, *Circuit Judges*.

Opinion for the court filed by *Circuit Judge* MOORE.

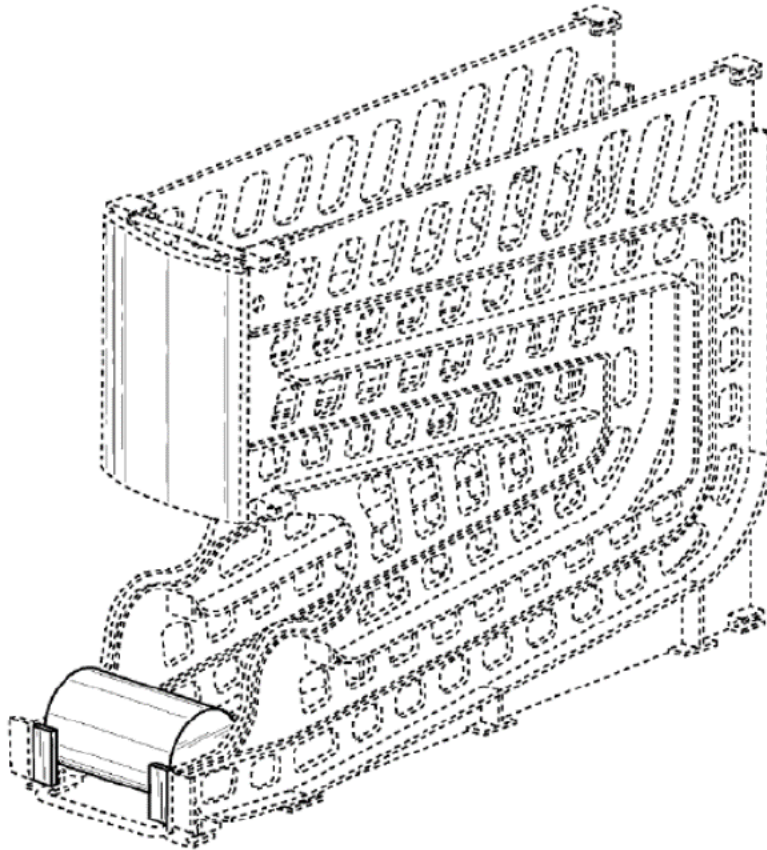
Dissenting opinion filed by *Circuit Judge* NEWMAN.

MOORE, *Circuit Judge*.

Campbell Soup Company, Campbell Sales Company, and Trinity Manufacturing, LLC (“Appellants”) appeal the final written decisions of the Patent Trial and Appeal Board holding Appellants did not demonstrate that the claimed designs of U.S. Patent Nos. D612,646 and D621,645 would have been obvious over U.S. Patent No. D405,622 (“Linz”) and G.B. Patent Application No. 2,303,624 (“Samways”). Because substantial evidence does not support the Board’s finding that Linz is not a proper primary reference, and substantial evidence supports the Board’s finding that Samways is not a proper primary reference, we affirm-in-part, vacate-in-part, and remand.

#### BACKGROUND

Gamon Plus, Inc. owns the ’646 and ’645 patents, which each claim: “The ornamental design for a gravity feed dispenser display, as shown and described.” The sole figure of the ’646 patent is depicted below.



---

J.A. 133. The Board described the claimed design as follows:

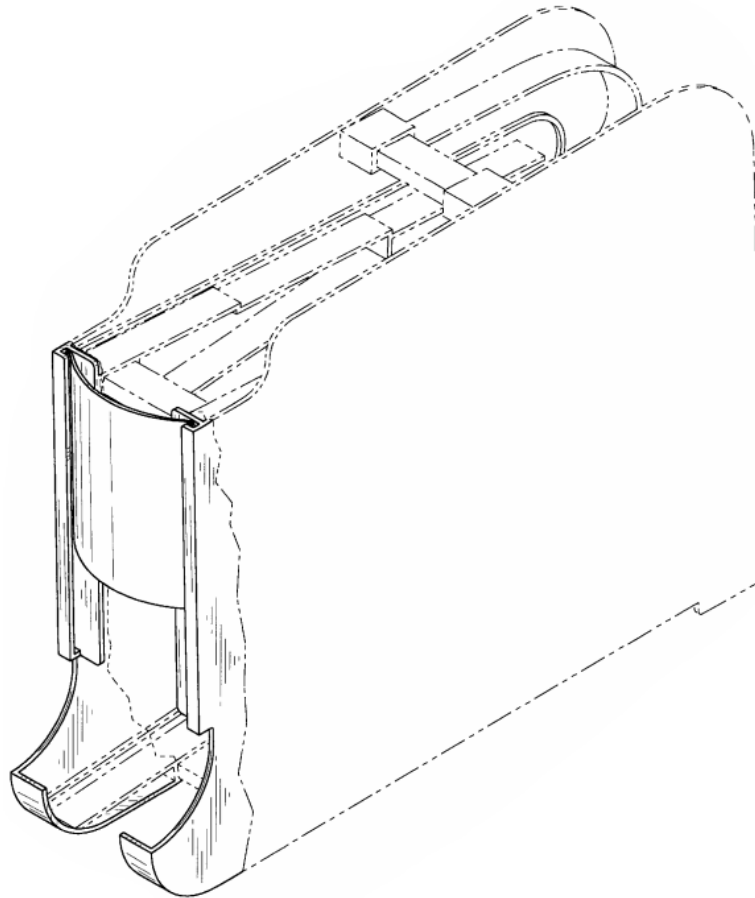
[T]he single embodiment of the patent design illustrates and claims certain front portions of a gravity feed dispenser display. From top to bottom, a generally rectangular surface area, identified by the parties as an access door or label area, is curved convexly forward. . . . The label area is taller vertically than it is wide horizontally, however, the boundary edges of the label area are not claimed. Below the label area there is a gap between the label area and the top of a cylindrical object lying on its side – the gap being approximately the same height as the label area. The width of the label

area is generally about the same as the height of the cylindrical object lying on its side. The height of the cylindrical object (lying on its side) is longer than its diameter. The cylindrical article is positioned partially forward of the label area. Two rectangular lugs, or stops, are positioned in front of the cylindrical object on each bottom side and stand vertically. The rectangular lugs are taller vertically than they are wide horizontally and they stand vertically adjacent the cylindrical object about halfway up the diameter of the cylindrical object.

J.A. 67 (internal citations omitted). The only figure of the '645 patent is identical, except the edges at the top and bottom of the cylindrical object lying on its side and the stops at the bottom of the dispenser are shown in broken lines. Additionally, the figure of the '645 patent includes a small circle shown in broken lines near the middle of the label area.

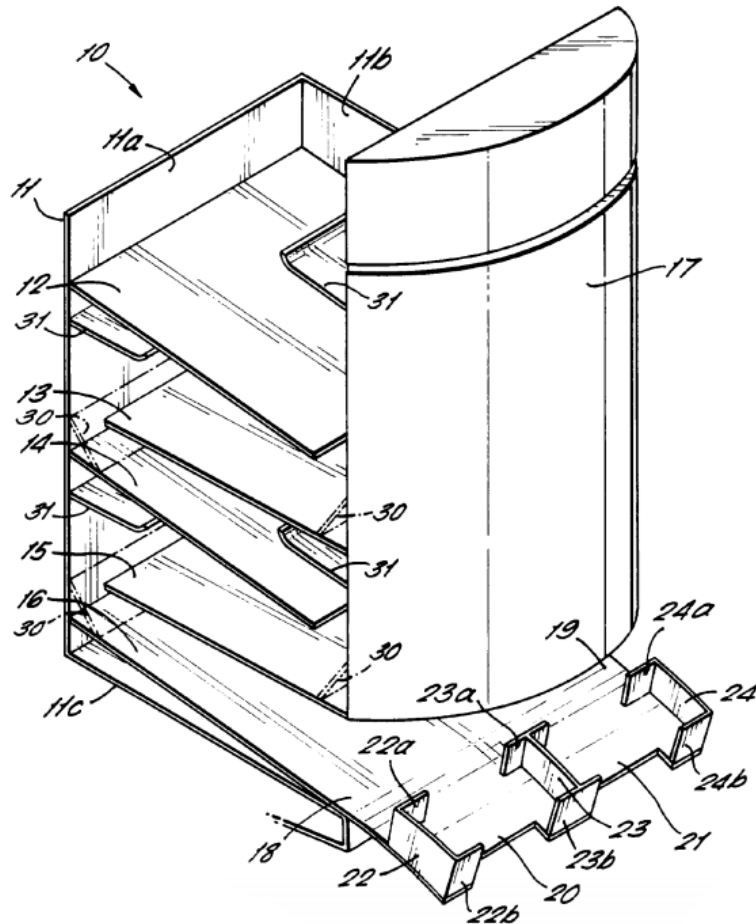
Appellants petitioned for *inter partes* review, and the Board instituted on the grounds that the sole claim in each of the '646 and '645 patents would have been obvious over (1) Linz in view of Samways, (2) Samways, or (3) Samways in view of Linz. Linz discloses a "display rack" as shown in the figure below. J.A. 696.





J.A. 697.

Samways discloses a dispenser with “a serpentine delivery path . . . along which cylindrical objects to be dispensed can move under the action of gravity.” J.A. 701. An example of Samways’ dispenser is shown in the figure below.



J.A. 704.

The Board held that Appellants did not establish unpatentability by a preponderance of the evidence because it found that neither Linz nor Samways was similar enough to the claimed designs to constitute a proper primary reference. Appellants timely appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(4)(A).

## DISCUSSION

We review the Board's legal determinations de novo and its factual findings for substantial evidence. *In re Van Os*, 844 F.3d 1359, 1360 (Fed. Cir. 2017). "Obviousness is a question of law based on underlying facts." *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1358 (Fed. Cir. 2017). The obviousness inquiry requires consideration of the four Graham factors: "(1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the art; and (4) objective considerations of nonobviousness." *Id.* These are questions of fact we review for substantial evidence. *Id.*

"In the design patent context, the ultimate inquiry under section 103 is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved." *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996). "To determine whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design," the fact finder must first "find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design." *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012) (internal quotation marks omitted). To identify a primary reference, one 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." *Durling*, 101 F.3d at 103. If a primary reference exists, related secondary references may be used to modify it. *Id.*

## I

The Board found that Linz was not a proper primary reference. Specifically, it found that "Linz does not disclose any object, including the size, shape, and placement of the

object in its display area” and “fails to disclose a cylindrical object below the label area in a similar spatial relationship to the claimed design.” J.A. 33–34; *see also* J.A. 94–95. It stated that “[a]dding a hypothetical can to Linz before comparing the designs is improper under *Durling* because such comparison does not consider the design ‘in existence’ and the modification has a noticeable impact on the overall design.” J.A. 34 (quoting *Durling*, 101 F.3d at 103); J.A. 95 (same).

Appellants argue substantial evidence does not support the Board’s rejection of Linz as a primary reference. They argue unrebutted testimony shows that a designer of ordinary skill would have understood the Linz dispenser was designed to hold cylindrical objects and that six of the seven references cited on the first page of Linz are directed to dispensers for cylindrical objects. They argue the Board’s rejection of Linz for needing modification was improper where it “otherwise conveys basically the same visual impression as the claimed designs.” Appellants’ Br. 36.<sup>1</sup>

Appellee argues the Board correctly rejected Linz as a primary reference because Linz (1) does not have basically

---

<sup>1</sup> The parties also raised a dispute regarding claim construction. Appellants argue the Board failed to give the claims their broadest reasonable interpretation by including portions of the drawings shown in broken lines that are unclaimed. They argue the unclaimed portions are “directed to particular spatial relationships between the label area, the can, the gap between the label area and the can, and the relative height and width of the label area itself.” Appellants’ Br. 31–32. Appellee argues the construction was proper, and the spatial relationship between the label area and the cylindrical object forms part of the claimed invention even though the boundary of the label area is unclaimed. We see no error in the Board’s claim construction.

the same design characteristics as the claimed design absent substantial modifications, and (2) cannot be modified as Appellants argue absent impermissible hindsight, improper application of utility patent principles, and misleading artwork. First, it argues Linz does not show or describe its displayed article. Second, it argues Appellants' drawing of Linz with a hypothetical cylindrical object is based on irrelevant utility patent principles having "no regard for appearance of an object" and hindsight bias, and there was nothing in Linz to suggest the appearance of articles to be displayed. Appellee's Br. 26-27.

This case presents the unusual situation where we reverse the Board's factual finding that Linz is not a proper primary reference for lack of substantial evidence support. The parties do not dispute that the claimed designs of the '645 and '646 patents and the design of Linz are for dispensing cans and that a can would be used in the system. Instead, they dispute the dimensions of a can that would be used in Linz in comparison with that in the claimed designs. Oral Argument at 26:16–20 (Counsel for Gamon arguing the "size of the can or what it would look like in this [Linz] device is not clear"); 26:30–33 ("It would be a Red Bull can, but it would be in a different position. It wouldn't be as far forward."); 26:38–48 ("One [distinction] is that the sign has dimensions which are kind of analogous to the shape and the height and width of the Campbell Soup can, which is lying sideways there."); 27:39–46 (Counsel for Gamon disagreeing that Gamon's patents claim any type of can, rather than just the Campbell Soup can and stating "we're talking about the actual dimensions of this can and the associated height and location of the sign above it"); 31:13–16 (Counsel for Gamon stating, with respect to Linz, "[t]he question is what size can are you going to put in there and what's it going to look like.").

Accepting the Board's description of the claimed designs as correct, the ever-so-slight differences in design, in light of the overall similarities, do not properly lead to the

result that Linz is not “a single reference that creates ‘basically the same’ visual impression” as the claimed designs. *See Durling*, 101 F.3d at 103. The parties do not dispute that Linz’s design is made to hold a cylindrical object in its display area. In light of these facts, the Board’s finding that Linz is not a proper primary reference is not supported by substantial evidence.

## II

The Board further found that Samways was not a proper primary reference. Specifically, it found that “significant modifications would first need to be made to Samways’ design, such as combining two distinct embodiments of the utility patent,” which is “not a design in existence.” J.A. 44; J.A. 105. It found that “[c]onsidering the designs as a whole, the design characteristics of Samways are not basically the same as the claimed design.” J.A. 50; J.A. 110. It pointed to Samways’ (1) “dual dispensing area with the addition of central tabs, or stops”; and (2) its front label area, which “extends across both of the dual dispensing areas” and is “taller than the label area of the claimed design with a small gap between the cylindrical objects and the label area.” J.A. 50; J.A. 110–11.

Appellants argue the Board “wrongly limited its analysis to only the particular illustrations in Samways, rather than the teachings of Samways as a whole.” Appellants’ Br. 38. They argue “Samways in its entirety clearly discloses a dispenser having design characteristics that are basically the same as those of the claimed . . . designs.” *Id.* at 39. They argue considering Samways as a whole does not constitute “modification” of the reference through “impermissible hindsight.” Reply Br. 18.

Appellee argues the Board correctly rejected Samways as a primary reference. It argues Appellants’ proposal is a major modification because it changes the shape and dimensions of Samways’ jars and removes parts to make it function with the changed articles. It argues even with the

CAMPBELL SOUP COMPANY v. GAMON PLUS, INC.

11

modification, Samways “would not give basically the same visual impression as the claimed designs.” Appellee Br. 36.

Accepting the Board’s description of the claimed designs as correct, substantial evidence supports the Board’s finding that Samways is not a proper primary reference. Samways has a dual dispensing area, compared to the single dispensing area of the claimed designs, and has a front label area with different dimensions that extends across both dispensing areas. Given these differences, substantial evidence supports the Board’s finding that Samways does not create basically the same visual impression as the claimed designs.

#### CONCLUSION

As to Linz, substantial evidence does not support the Board’s finding that Linz is not a proper primary reference. In light of this finding, we vacate the Board’s conclusion that the claimed designs would not have been obvious over Linz in view of Samways. Because substantial evidence supports the Board’s finding that Samways is not a proper primary reference, we affirm the Board’s conclusions that the claimed designs would not have been obvious over Samways or Samways in view of Linz. We do not reach Appellants’ remaining arguments. On remand, the Board should also consider the non-instituted grounds for unpatentability consistent with the Supreme Court’s decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

#### **AFFIRMED-IN-PART, VACATED-IN-PART, AND REMANDED**

#### COSTS

No costs.

**United States Court of Appeals  
for the Federal Circuit**

---

**CAMPBELL SOUP COMPANY, CAMPBELL SALES  
COMPANY, TRINITY MANUFACTURING, LLC,**  
*Appellants*

v.

**GAMON PLUS, INC.,**  
*Appellee*

---

2018-2029, 2018-2030

---

Appeals from the United States Patent and Trademark  
Office, Patent Trial and Appeal Board in Nos. IPR2017-  
00091, IPR2017-00094.

---

NEWMAN, *Circuit Judge*, dissenting.

The Patent Trial and Appeal Board (“Board” or “PTAB”) correctly applied the law of design patents, and held that neither the reference design of Linz nor that of Samways creates a visual impression substantially similar to the claimed design. Substantial evidence supports the Board’s findings, leading to correct conclusions of law. From my colleagues’ contrary finding as to the Linz design and the ensuing remand, I respectfully dissent.

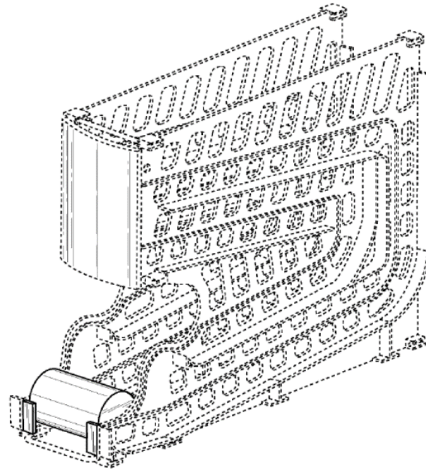


## DISCUSSION

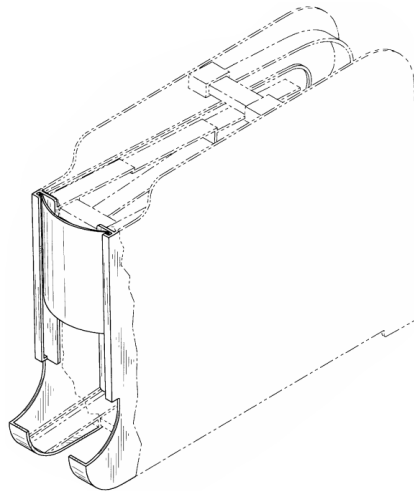
Design patents are evaluated from the viewpoint of the ordinary observer or, when appropriate, the ordinary designer. Ordinary observation resolves this case.

Obviousness of a design requires the threshold existence of a “primary reference,” *see In re Rosen*, 673 F.2d 388, 391 (CCPA 1982) (“[T]here must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness.”). To determine whether this threshold is met by a reference design, the observer 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.” *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1312 (Fed. Cir. 2013) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)). That is, the reference design and the patented design must be basically the same, *see MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014) (“The ‘basically the same’ test requires consideration of the ‘visual impression created by the patented design as a whole.’” (citation omitted)).

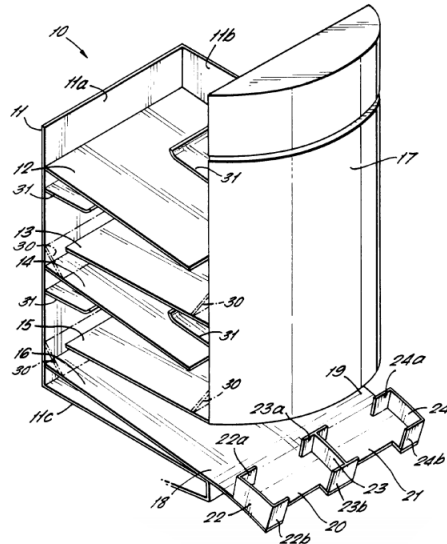
Gamon claims “The ornamental design for a gravity feed dispenser display,” shown as follows in Gamon’s Design Patent No. D612,646:



The cited prior art is two dispenser designs, the Linz dispenser and the Samways dispenser; the PTAB found that neither of these designs constitutes a primary reference in design patent terms. The Linz design is shown in Design Patent No. D405,622, for “[t]he ornamental design for a display rack, as shown and described:”



The Samways reference is G.B. Patent Application No. 2,303,624, entitled “Serpentine dispenser,” with the following drawing:



The Board held that neither the Linz nor the Samways design is substantially the same as the Gamon design, and thus is not a primary reference. My colleagues agree with the Board as to Samways, and I share that view. With respect to the Linz design, the Board similarly concluded that an ordinary observer would not reasonably find “substantial identity of design,” the words of *Gorham Co. v. White*, 81 U.S. 511, 527 (1871). The Board stated that “examining the design of Linz in existence, Petitioner has not established persuasively that the designs of Linz and the ’645 patent are substantially the same.” Board Op. at 32. Although my colleagues disagree, the Board’s conclusion is correct.

Gamon had stated that only the front portion of its dispenser design is free of dashed lines; that is, the label area

and the cylindrical object lying on its side. The Board examined the Gamon design from this viewpoint, and held that even if the Gamon dispenser design is deemed limited to the label area and the horizontal cylinder, Linz is not a primary reference for it shows no cylinder at all. The Board explained:

The biggest difference between the designs is that Linz does not disclose a cylindrical object in its display. The claimed cylindrical object, and its spatial relationship to the label area in the '645 patent, is half of the scope of the design claim.

*Id.* at 33. The Board concluded that Campbell Soup “failed to establish sufficiently how a designer of ordinary skill in the art would first consider Linz a primary reference.” *Id.*

My colleagues propose that since “Linz’s design is made to hold a cylindrical object in its display area,” Maj. Op. at 10, the Linz design must be viewed with judicial insertion of the missing cylindrical object. This analysis is not in accordance with design patent law. Only after a primary reference is found for the design as a whole, is it appropriate to consider whether the reference design may be modified with other features, selected to match the patented design. *See In re Jennings*, 182 F.2d 207 (CCPA 1950):

In considering patentability of a proposed design the appearance of the design must be viewed as a whole, as shown by the drawing, or drawings, and compared with something in existence—not with something that might be brought into existence by selecting individual features from prior art and combining them.

*Id.* at 208; *see also Durling*, 101 F.3d at 103 (“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.”).

The Board correctly stated that “[a]ny reasoning that first requires a modification to Linz in order to arrive at a substantially similar design is improper under *Durling*.” Board Op. at 30. My colleagues hold that the designs are substantially the same despite the absence in Linz of the cylindrical object, reasoning that it may be assumed that the Linz dispenser is for a cylindrical object. However, even on Gamon’s position that its only claimed design elements are the label area and the cylindrical object, the cylindrical object is a major design component. The absence from the primary reference of a major design component cannot be deemed insubstantial.

The Board correctly explained that Campbell Soup “improperly molds concepts of utility obviousness into the design patent obviousness analysis. For example, [Campbell Soup] alleges that if Linz ‘does not inherently disclose a cylindrical can, it would be obvious to a designer of ordinary skill in the art to use the display rack of Linz to dispense cylindrical cans.’” Board Op. at 30 (quoting Petition for Inter Partes Review at 30). The Board stated that “[Campbell Soup’s] analysis considers not a design currently in existence, but a potential design based on [the witness’s] assumption of how utilitarian features like curved rails indicate that a can could be displayed.” *Id.* at 31 (quoting Gandy Decl. ¶ 50 (stating “that the Linz display rack is intended for use with cylindrical cans”))).

My colleagues err in design patent law—in modifying the Linz design by adding a can, Maj. Op. at 10, in order to create a design more similar to the Gamon design. Whether viewing the designs in their entirety, or only the portion that Gamon enclosed in solid lines, substantial evidence supports the Board’s finding that Linz does not “create basically the same visual impression” as the claimed design. *MRC Innovations*, 747 F.3d at 1331. Thus Linz cannot serve as a primary reference. From my colleagues’ contrary finding and its action based thereon, I respectfully dissent.

**CERTIFICATE OF SERVICE**

I, Andrew L. Tiajolloff, hereby certify that on October 10, 2019, the foregoing brief was filed using the Court's CM/ECF system and a copy served on the parties' counsel of record via ECF.

Dated: October 10, 2019

**/Andrew L. Tiajolloff/**  
Andrew L. Tiajolloff  
TIAJOLLOFF & KELLY LLP  
Chrysler Building, 37th Floor  
405 Lexington Avenue  
New York, New York 10174  
tel. 212-490-3285  
fax 212-490-3295

*Counsel for Appellee Gamon Plus, Inc.*

## CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 35(b)(2)(A).
2. This submission contains 3,872 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 35(c)(2).
3. This submission complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) or Federal Rule of Appellate Procedure 28.1(e) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6) because this submission has been prepared in a proportionally-spaced typeface using Microsoft Word in a 14-point Times New Roman font.

Dated: October 9, 2019

*/Andrew L. Tiajloff/*  
Andrew L. Tiajloff  
TIAJOLOFF & KELLY LLP  
Chrysler Building, 37th Floor  
405 Lexington Avenue  
New York, New York 10174  
tel. 212-490-3285  
fax 212-490-3295  
atiajloff@tkiplaw.com

*Counsel for Appellee Gamon Plus, Inc.*