

2019 WL 3385172 (Patent Tr. & App. Bd.)
Only the Westlaw citation is currently available.

INFORMATIVE

SATTLER TECH CORP., Petitioner,
v.
HUMANCENTRIC VENTURES, LLC, Patent Owner.

Patent Trial and Appeal Board.
Case PGR2019-00030
Patent D823,093 S
Entered: July 26, 2019

Attorneys and Law Firms

For PETITIONER: Michael L. Greenberg, GREENBERG & LIEBERMAN, LLC, michael@aplegal.com

For PATENT OWNER: James M. Heintz, Dale S. Lazar, DLA PIPER LLP, jim.heintz@dlapiper.com, dale.lazar@dlapiper.com

Before SCOTT A. DANIELS, BART A. GERSTENBLITH, and CHRISTOPHER G. PAULRAJ, Administrative Patent Judges.

DECISION

Institution of Post-Grant Review

35 U.S.C. § 324

GERSTENBLITH, Administrative Patent Judge.

I. INTRODUCTION

A. Background

*1 Sattler Tech Corp. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting institution of a post-grant review of the design claim of U.S. Patent No. D823,093 S (Ex. 1001, “the ‘093 patent”). Humancentric Ventures, LLC (“Patent Owner”) did not file a preliminary response.

We review the Petition under 35 U.S.C. § 324(a), which provides that a post-grant review may not be instituted unless “it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a). Upon consideration of the present record and for the reasons explained below, we determine Petitioner has satisfied its burden under § 324. Thus, we institute a post-grant review.

B. Related Proceedings

The parties indicate the sole related matter involving the ‘093 patent is Case No. 2:18-cv-09332¹-PSG-JPR (N.D. Cal.). Pet. 3; Paper 6, 2.

¹ Patent Owner mistakenly identifies the case number as “2:18-cv-09322” in its Mandatory Notice. Paper 6, 2.

C. Real Parties in Interest

Petitioner identifies itself as the sole real party in interest. Pet. 2. Patent Owner similarly identifies itself as the sole real party in interest. Paper 6, 1.

D. The '093 Patent

The '093 patent is titled “VESA MOUNT ADAPTER BRACKET” and claims “[t]he ornamental design for a VESA mount adapter bracket, as shown and described.” Ex. 1001, [54], [57]. The '093 patent includes six figures, each of which is reproduced below. The '093 patent explains that “[t]he broken lines [in the figures] represent portions of the article and form no part of the claimed design.” *Id.* at DESCRIPTION.

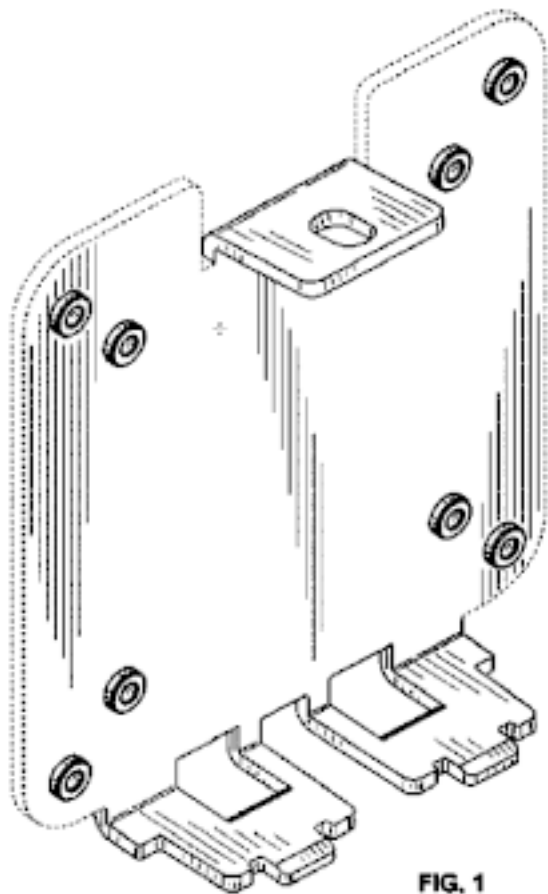


Figure 1, reproduced above, shows “a perspective view of a VESA mount adapter bracket.” *Id.*

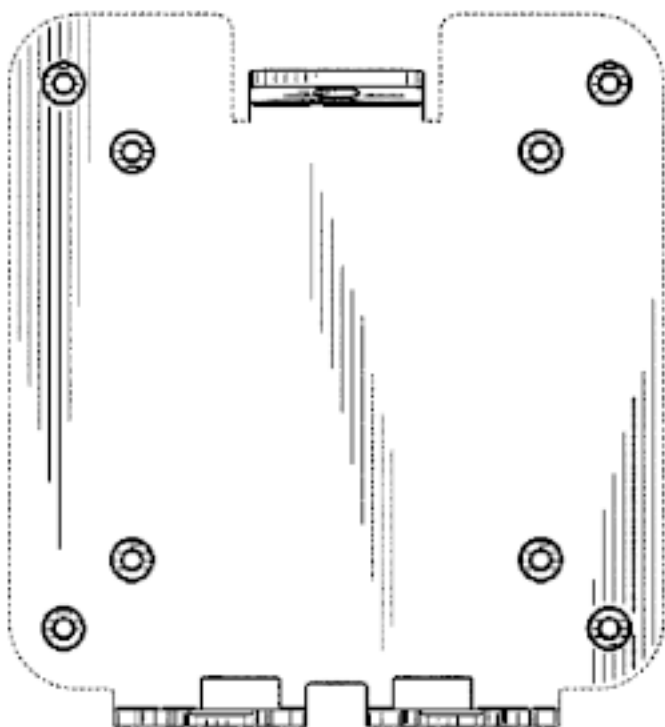


FIG. 2

Figure 2, reproduced above, shows “a front view.” *Id.*

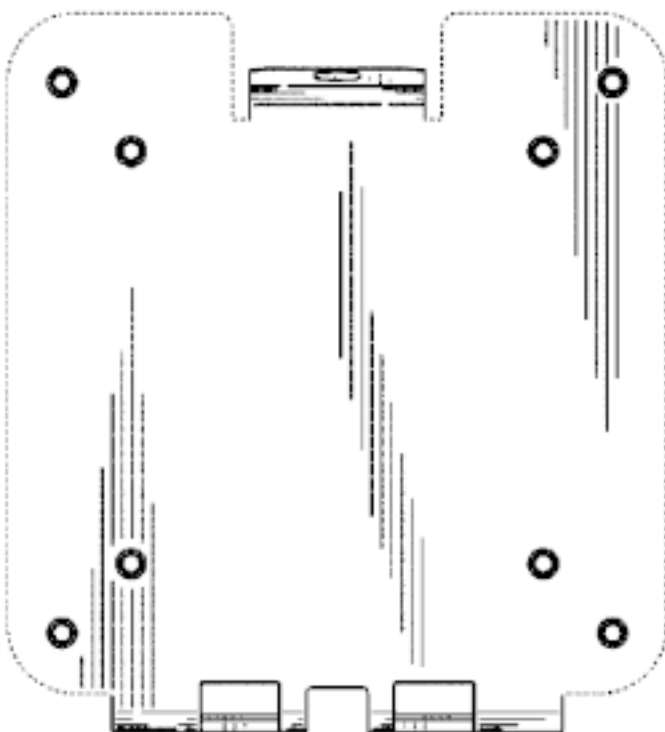


FIG. 3

Figure 3, reproduced above, shows “a back view.” *Id.*

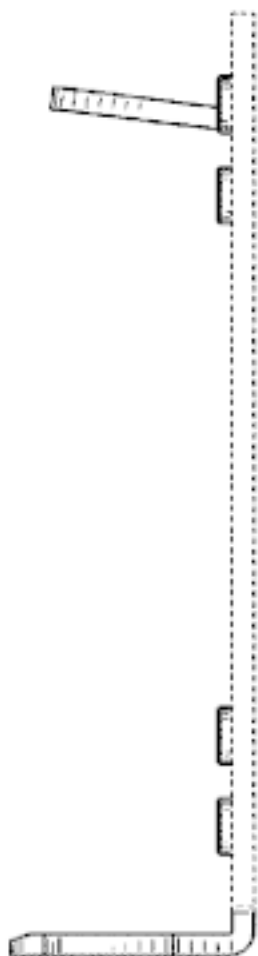


FIG. 4

Figure 4, reproduced above, shows “a right side view.” *Id.* The '093 patent explains that “the left side view” is “a mirror image of FIG. 4.” *Id.*

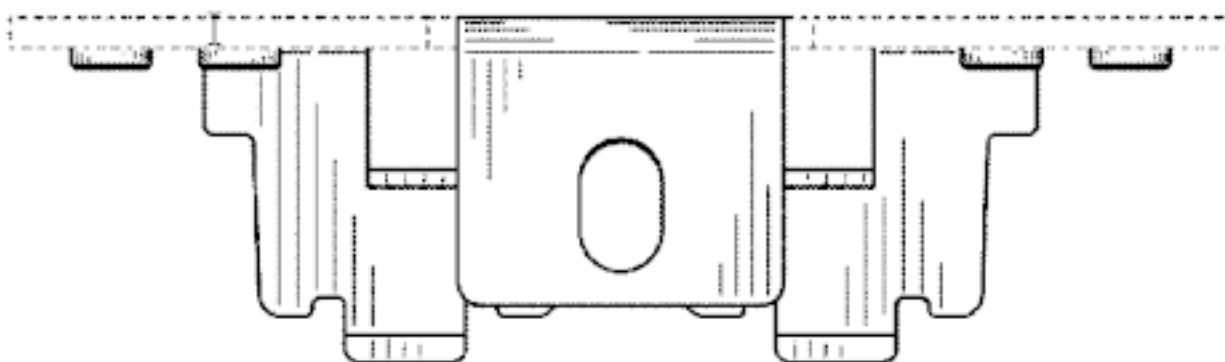


FIG. 5

Figure 5, reproduced above, shows “a top view.” *Id.*

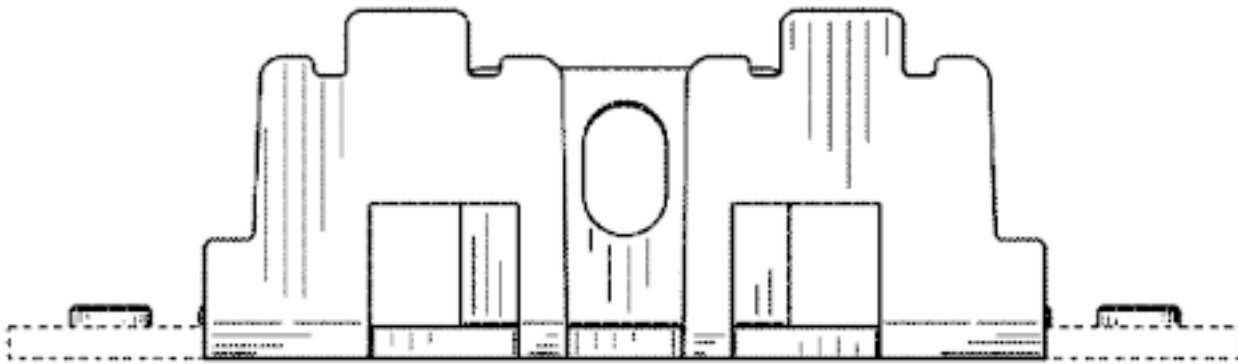


FIG. 6

Figure 6, reproduced above, shows “a bottom view.” *Id.*

As reflected in the figures above, the claimed portions of the design include: (1) top and bottom tabs and (2) eight raised grommets arranged in diagonal pairs toward the four corners of the plate.²

² The plate is the portion of the adapter bracket shown in broken lines and, thus, is not part of the claimed design.

E. The Asserted Ground of Unpatentability

Petitioner's sole challenge as set forth in the Petition is that the claim of the '093 patent is unpatentable under 35 U.S.C. § 171 for lacking ornamentality. Pet. 3, 17.

II. ELIGIBILITY OF PATENT FOR POST-GRANT REVIEW

The post-grant review provisions of section six of the Leahy-Smith America Invents Act (“AIA”), Pub L. No. 112-29, 125 Stat. 284 (2011), apply only to patents subject to the first inventor to file provisions of the AIA. AIA § 6(f)(2)(A). Specifically, the first inventor to file provisions apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time a claim to a claimed invention that has an effective filing date on or after March 16, 2013. AIA § 3(n)(1). Furthermore, “[a] petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be).” 35 U.S.C. § 321(c); *see also* 37 C.F.R. § 42.202(a) (setting forth the same).

*2 The '093 patent issued on July 17, 2018. Ex. 1001, [45]. The Petition was filed on January 15, 2019. Paper 3, 1. Therefore, the Petition was filed within nine months of the '093 patent issuance.

Additionally, the earliest effective filing date for the '093 patent is February 17, 2017. Ex. 1001, [22]. Therefore, the '093 patent is subject to the first inventor to file provisions of the AIA.

Petitioner certifies that the '093 patent “is available for post-grant review and that Petitioner is not barred or estopped from requesting a post-grant review of the '093 Patent.” Pet. 1. At this stage of the proceeding, Patent Owner has not challenged Petitioner's contentions as to the eligibility of the '093 patent for post-grant review.

On this record, we agree with Petitioner that the '093 patent is eligible for post-grant review.

III. ANALYSIS

A. Legal Standard

Section 171(a) of Title 35 of the United States Code provides: “Whoever invents any new, original and *ornamental* design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 171(a) (2018) (emphasis added). “[A] design patent can be declared invalid if the claimed design is primarily functional rather than primarily ornamental, i.e., if the claimed design is dictated by the utilitarian purpose of the article.” *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1315 (Fed. Cir. 2013) (internal quotations and citations omitted). “An article of manufacture necessarily serves a utilitarian purpose, and the design of a useful article is deemed to be functional when the appearance of the claimed design is dictated by the use or purpose of the article.” *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.3d 1117, 1123 (Fed. Cir. 1993) (citation omitted). “If the particular design is essential to the use of the article, it can not [sic] be the subject of a design patent.” *Id.* “While analyzing elements of the design may be appropriate in some circumstances, the determination of whether the patented design is dictated by the function of the article of manufacture must ultimately rest on an analysis of its overall appearance.” *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed. Cir. 1997).

The U.S. Court of Appeals for the Federal Circuit has explained that although there is no “particular test for determining whether a claimed design is dictated by its function[,] [the court] has often focused ... on the availability of alternative designs as an important—if not dispositive—factor in evaluating the legal functionality of a claimed design.” *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1329–30 (Fed. Cir. 2015); *see PHG Techs., LLC v. St. John Cos.*, 469 F.3d 1361, 1367 (Fed. Cir. 2006) (“When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose.” (quoting *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002))). “[A] full inquiry with respect to alleged alternative designs includes a determination as to whether the alleged ‘alternative designs would adversely affect the utility of the specified article,’ such that they are not truly ‘alternatives’ within the meaning of [the Federal Circuit’s] case law.” *PHG*, 469 F.3d at 1367 (quoting *Rosco*, 304 F.3d at 1378).

*3 In *Berry Sterling*, the Federal Circuit provided additional factors to consider in a situation “where the existence of alternative designs is not dispositive of the invalidity inquiry.” *Ethicon*, 796 F.3d at 1330. Those factors include:

- [1] whether the protected design represents the best design;
- [2] whether alternative designs would adversely affect the utility of the specified article;
- [3] whether there are any concomitant utility patents;
- [4] whether the advertising touts particular features of the design as having specific utility; and
- [5] whether there are any elements in the design or an overall appearance clearly not dictated by function.

Berry Sterling, 122 F.3d at 1456, *quoted in PHG*, 469 F.3d at 1366–67. The Federal Circuit, however, explained that although evaluating these other factors “ ‘might’ be relevant to assessing whether the overall appearance of a claimed design is dictated by functional considerations. ...[,] an inquiry into whether a claimed design is primarily functional should begin with an inquiry into the existence of alternative designs.” *Ethicon*, 796 F.3d at 1330 (citations omitted).

B. Discussion

Petitioner explains that VESA mount adapter brackets are used in connection with “the Video Electronics Standards Association (VESA) Flat Display Mounting Interface Standard, Copyright 2006” (“the VESA FDMI Standard”). Pet. 9 (citing Ex. 1002). As Petitioner explains, the purpose of the VESA FDMI Standard is “to provide industry standard mounting interfaces for Flat Displays (FDs) such as flat panel monitors, flat displays and flat TVs.” Ex. 1002, 1; *see* Pet. 9. Petitioner contends the claimed VESA mount adapter bracket “is designed specifically to fit onto the back of certain video monitors so they can attach to VESA [monitor] mount systems [i.e., using the VESA FDMI standard,] instead of a stand that came with the monitors.” Pet. 9.

1. Functionality of the Claimed Design

Petitioner argues that the appearance of several, if not all, components of the claimed adapter bracket are dictated by their use and purpose, and, therefore, the claimed design is, as a whole, functional. *Id.* at 10–17. In particular, Petitioner discusses the tabs and the grommets.

a. Tabs

Petitioner contends that the top tab of the VESA mount adapter bracket “fits atop a lower bulge on the back of a video monitor to secure the top tab via screw to the video monitor.” *Id.* at 10. Petitioner provides the following pictures to illustrate this arrangement from the Amazon.com webpage (<https://www.amazon.com/dp/B01DNCP7HW>) where an alleged commercial embodiment of the VESA mount adapter bracket design of the '093 patent is offered for sale. *Id.* (citing Ex. 1004, 1; Ex. 1005, 1).



The two pictures reproduced above show the top tab of the VESA mount adapter bracket connected to the back of a video monitor via a screw. *See* Ex. 1004, 1; Ex. 1005, 1.

Petitioner contends the bottom tabs of the VESA mount adapter bracket of the '093 patent “fit into preexisting slots on the back of a video monitor,” as shown in the picture below from the same Amazon.com webpage. Pet. 12 (citing Ex. 1003, 6).



*4 The picture reproduced above shows the bottom tabs of the VESA mount adapter bracket inserted into slots in the back of a video monitor. *See* Ex. 1003, 6.

Petitioner asserts “the tabs must be positioned and sized as they are – else they won't fit the monitor.” Pet. 12. Petitioner contends “[t]he top tab is shaped as minimally as possible to provide support for the bracket of the '093 Patent.” *Id.*

b. Grommets

Petitioner contends that at least three features of the grommets are dictated primarily by function: (a) spacing, (b) size, and (c) raised edges. *Id.* at 13–17. Petitioner asserts that the VESA FDMI Standard dictates the claimed spacing and size of the grommets as discussed below. *Id.* at 13–16.

i. Grommet Spacing

Petitioner asserts that the grommets of the VESA mount adapter bracket of the '093 patent “are shown to be VESA standardly-spaced (via the manufacturer's blue notations in the below figure) to fit for mounting at the back of a video monitor.” *Id.* at 13.



The picture reproduced above shows that one set of four grommets is positioned 75 mm x 75 mm apart, whereas the other set of four grommets is positioned 100 mm x 100 mm apart. Ex. 1003, 3.

Petitioner explains that Section 5.2.1 of the VESA FDMI Standard describes the same two patterns for the “Screw Mounting Interface Dimensions” on the back of a monitor: (1) 100 mm x 100 mm, for displays weighing up to 14 kg; and (2) 75 mm x 75 mm, for smaller displays, weighing less than 8 kg. Pet. 13–14 (quoting Ex. 1002, 28).

ii. Grommet Size

Petitioner asserts that the size of the grommets of the VESA mount adapter bracket of the '093 patent are also “dictated by VESA Standards.” *Id.* at 15. Petitioner points to the following chart from Section 5.6 of the VESA FDMI Standard, which indicates a 5 mm hole size in the plate³:

³ Petitioner refers to this structure as a “plate” (*see* Pet. 9), whereas the VESA FDMI Standard refers to it as a “pad” (*see* Ex. 1002, 32). For consistency with the Petition, we refer to the structure as a “plate.”

Interface Mounting Pad Specifications	100 mm x 100 mm Screw Mounting Pattern	75 mm x 75 mm Screw Mounting Pattern
Hole spacing	100 mm x 100 mm (3.937")	75 mm x 75 mm (2.953")
Hole spacing tolerances	+/- .25 mm (.010")	+/- .25 mm (.010")
Pad size	115 mm x 115 mm (4.527"), 6 mm R (4)	90 mm x 90 mm (3.543"), 6 mm R (4)
Flat mounting area required	117 mm x 117 mm (4.606"), 0 – 7 mm R (4)	92 mm x 92 mm (3.622"), 0 – 7 mm R (4)
Pad thickness	2.6 mm or 12 GA (0.102"-0.105")	2.6 mm or 12 GA (0.102"-0.105")
Hole size in pad (4 ea.)	5 mm ø (0.197"ø)	5 mm ø (0.197"ø)
Pad material	Steel *	Steel *
Mounting screws (4 ea.)	4 mm ø, .7 pitch x 10 mm long **	4 mm ø, .7 pitch x 10 mm long **

Ex. 1002, 32. Thus, Petitioner contends that the grommets “must be standardly-sized – else they won't confirm to VESA standards.” Pet. 16.

iii. Grommet Raised Edges

Petitioner asserts that “[h]aving raised edges for grommets is known to increase the strength of the sheet to which the grommets are attached.” *Id.* Petitioner quotes a paper from the 17th International Conference on Metal Forming that states: “For the purposes of improving fatigue strength of the steel sheet, the edge of the hole was thicken[ed]. Thus[,] the fatigue strength was improved as compared to the normal piercing hole without thickening.” *Id.* (quoting Ex. 1006, 5). Accordingly, Petitioner contends “the grommets [of the '093 patent] have raised edges as reinforcement so the sheet to which the grommets are attached will not break under heavy monitor weight.” *Id.* at 17.

2. Availability of Alternative Designs

Petitioner contends that, in addition to the design being dictated by the functionality discussed above, alternative VESA mount adapter brackets “all have the same design or appearance as the black-lined portions of the figures of the '093 Patent.” *Id.* at 20 (emphasis omitted). Petitioner asserts:

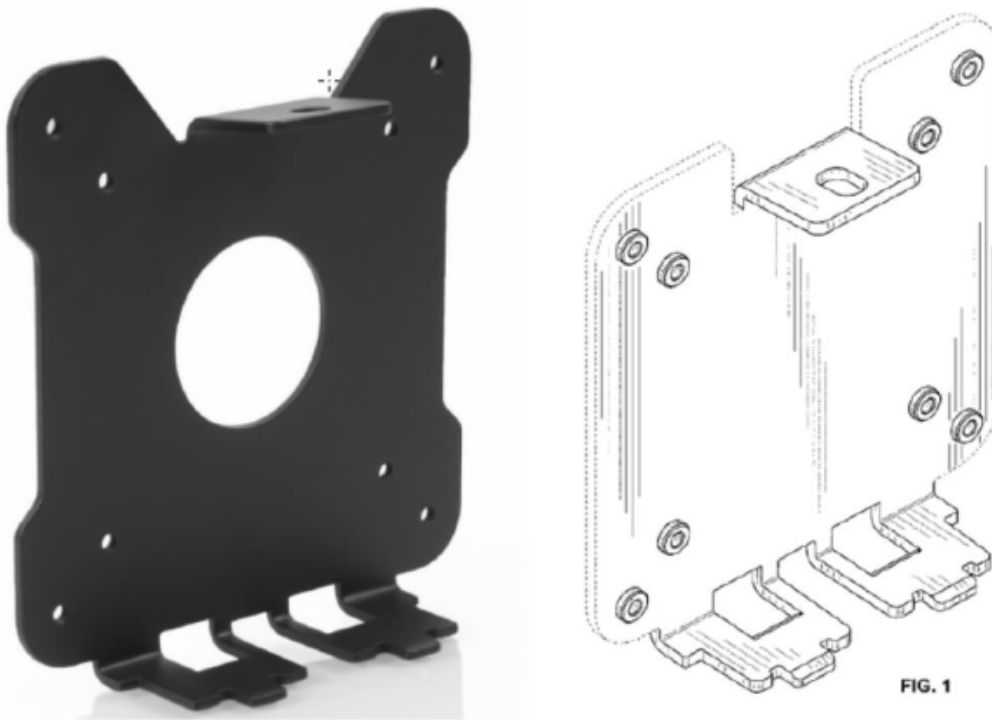
*5 This is because the black-lined portions of the figures of the '093 Patent are necessary for the bracket to function. The black-lined portions of the figures of the '093 Patent are not anything but the functional requirements that are common to similarly marketed brackets for the same function – this is because to function, the bracket of [the] claimed design of the '093 Patent must have tabs and grommets that meet VESA standards and are sized and positioned for a specific line of flat panel displays.

Id.

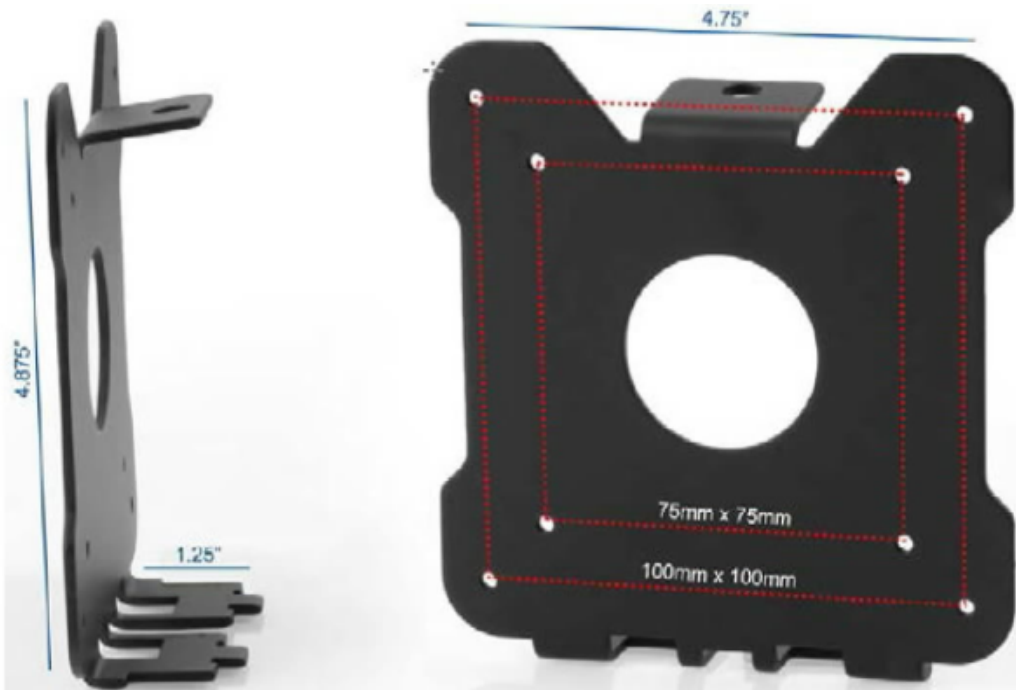
Petitioner provides two examples of other VESA mount adapter brackets. First, Petitioner points to an “HP Pavilion Monitor VESA Adapter,” from Gladiator Joe, that Petitioner asserts is “identical, but for raised grommet edges, to the bracket protected by the '093 Patent.” *Id.*; see Ex. 1007, 1. The Petition includes side-by-side images of Gladiator Joe's product and Figure 1 of the '093 patent, which are reproduced below. Pet. 21.



Gladiator Joe's product (on the left) is shown next to Figure 1 of the '093 patent (on the right). *Id.* Second, Petitioner points to a VESA Adapter for certain HP monitors made by VIVO. *Id.* at 21–23 (citing Exs. 1008 and 1009). Petitioner asserts that the VIVO product has the same tabs and grommets as those shown in the '093 patent. *Id.* at 21. The Petition includes side-by-side images of VIVO's product and Figure 1 of the '093 patent, which are reproduced below. *Id.* at 22; *see* Ex. 1008.



VIVO's product (on the left) is shown next to Figure 1 of the '093 patent (on the right). Petitioner further points to VIVO's identification of the “exact spacing/ positioning of grommets as the bracket of the '093 Patent,” which “match[] the VESA standard measurements,” as shown below. Pet. 22 (citing Ex. 1009, 1).



VIVO's product is shown above in two images: the first (on the left) shows a side view and indicates the vertical dimension of the bracket and length of the bottom tabs, the second (on the right) shows a front/back view and indicates the width of the bracket and the spacing between the grommets, which are shown as 75 mm x 75 mm and 100 mm x 100 mm. *See id.* (citing Ex. 1009, 1). Additionally, Petitioner contends that Patent Owner's webpage offering for sale an alleged commercial embodiment of the design claimed in the '093 patent similarly indicates that the product comports with “Standard VESA Hole Patterns: 75 mm x 75 mm, 100 mm x 100 mm.” *Id.* at 24–25 (citing Ex. 1010, 1 (emphasis omitted)). Petitioner asserts the product description

of the alleged commercial embodiment further indicates that it fits the same HP monitors as the VIVO product. *Compare* Ex. 1008, *with* Pet. 25.⁴

⁴ Petitioner omits the HP Pavilion 24 cw monitor from its list of monitors compatible with VIVO's product. *See* Pet. 21. VIVO's product description on ebay.com, however, includes the HP Pavilion 24 cw monitor. *See* Ex. 3001, 2. Thus, we agree that the two products have the same compatibilities.

Petitioner contends that the overall appearance of the patented bracket is the same as the other bracket products because the overall appearance is dictated by the functional requirements of the VESA FDMI Standard. Pet. 25–26. Petitioner asserts:

The grommets of the '093 Patent are required by VESA standards ... ; and the tabs of the '093 Patent are required to be angled at roughly ninety degrees to fit onto (in the case of the top tab) and into (in the case of the bottom tabs) the back of the flat panel which the bracket of the '093 Patent supports.

*6 *Id.* Petitioner further contends that “the bottom tabs are required to be shaped in such a way in order to interlock with the slots in the back of the flat panel into which the bracket of the '093 Patent supports.” *Id.* at 26. And, Petitioner again explains that raised edges for grommets was “known to increase the strength of the sheet to which the grommets are attached.” *Id.*

In light of the discussion above, Petitioner contends that “there is no availability of alternative designs because [the] claimed design of the '093 [patent] is dictated by VESA standards and needing to fit on and into monitors made by Hewlett Packard.” *Id.* Additionally, Petitioner asserts that the overall appearance of the article, i.e., the claimed design viewed in its entirety, is similarly dictated by function because “there does not appear to be anything that is not dictated [by] VESA standards and the Hewlett Packard monitors that it is designed to fit.” *Id.* Accordingly, Petitioner contends:

In short, if the claimed design of the '093 Patent did not have the overall appearance that it does, then the claimed design of the '093 Patent would not function. The elements of the claimed design of the '093 Patent – viewed in isolation as well as together – must appear as they do so that the bracket of the '093 Patent can function. Without the elements of the claimed design of the '093 Patent – viewed in isolation as well as together – the claimed design of the '093 Patent would not fit the very standard monitors that it must fit to function.

Id. at 26–27 (emphasis omitted); *see id.* at 29 (“The tabs and grommets are disposed where they are and positioned where they are because of functional – not ornamental – considerations. Nothing about the overall shape or the design and placement of individual elements, for instance, can serve an ornamental purpose because they are dictated by a functional purpose.”). Thus, Petitioner asserts “the claimed design is primarily functional and cannot be the subject of a design patent.” *Id.* at 29.

3. Analysis

On the record before us, we find that Petitioner has shown that it is more likely than not that the challenged claim of the '093 patent is unpatentable. First, the claimed portions of the design include the tabs and the grommets. Petitioner explained in detail how the spacing, size, shape, and angle of the tabs are dictated by their function to attach to the back of certain monitors. Petitioner further explained how the spacing, size, and shape of the grommets are similarly dictated by their function and the VESA FDMI Standard. On this record, we agree with and adopt Petitioner's reasoning as to these elements as our findings. The only design element that appears to be optional, i.e., not required to perform the mounting function, is the raised edges of the grommets. Petitioner, however, sufficiently supports its argument that it was known that raising the edges of grommets

increases their strength, and, therefore, provides a functional (not ornamental) benefit. Therefore, on the present record before us, we find that each of the individual elements of the claimed design appears to be dictated solely by function.

Second, focusing on the overall appearance of the article, *see Berry Sterling*, 122 F.3d at 1456, we are persuaded that, on the present record, the claimed design for the adapter bracket as a whole appears primarily functional, rather than primarily ornamental. Of particular significance is Petitioner's evidence that other mounting brackets contain the same individual elements of the claimed design as well as the same overall appearance of the bracket. Any differences, besides the raised grommets, between the other bracket designs known in the art and that of the design claimed in the '093 patent appear to lie solely in unclaimed features, e.g., the specific shape of the bracket plate's perimeter. *See, e.g.*, Pet. 22 (showing the side-by-side pictures of VIVO's bracket and Figure 1 of the '093 patent). Thus, on this record, there appears to be a lack of alternative designs, which weighs strongly in Petitioner's favor.

*7 Accordingly, on this record, we determine that the particular design is “essential to the use of the article,” *L.A. Gear*, 988 F.3d at 1123, and, thus, primarily functional.

IV. CONCLUSION

For the foregoing reasons, Petitioner has shown that it is more likely than not that the challenged claim of the '093 patent is unpatentable for lacking ornamentality. 35 U.S.C. § 324(a). At this stage of the proceeding, however, we have not made a final determination as to the unpatentability of the challenged claim or any underlying factual or legal issue.

V. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 324(a), a post-grant review of the claim of the '093 patent according to the ground raised in the Petition is hereby instituted; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 324(d) and 37 C.F.R. § 42.4, a post-grant review of the '093 patent will commence on the entry date of this Decision, and notice is hereby given of the institution of a trial.