

# **U. S. Patent and Trademark Office (PTO) Roundtable on 35 U.S.C. ' 112 Requirements for Design Patents**

## **Speaker=s Paper**

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**I. Summary.** This paper provides a brief review of current law on this topic, followed by comments on the questions asked. The approach is to review several key cases to provide a discussion framework. A check list uses key words identifying the law used to analyze some of the slide designs. Discussion may develop around these starter materials. Topic suggestions for further roundtables are given.

**II. Introduction.** This paper is based on the requested by the PTO, in the Federal Register, Vol.79, No.25, Thursday, February 6, 2014, 7171-7173 (FR Notice) which is incorporated into this paper by this reference. This paper is primarily an outline of my answers on the main topics with opportunity for the readers to try their hand in applying the law and get my feedback.

The Roundtable Format asked for comments on a set of Power Point slides presented at the 2013 PTO Design Patent Day (Slides Group I), by Joel Sincavage, PTO Design Patent Specialist. Questions were addressed also to another set of Power Point Slides (Slides Group II) that presented further examples of design drawing amendments. Both of these Power Point presentations were on the PTO Roundtable web site, [http://www.uspto.gov/patents/init\\_events/design\\_roundtable\\_2014.jsp](http://www.uspto.gov/patents/init_events/design_roundtable_2014.jsp) under the heading Additional Information. Questions were asked in the FR Notice on Factors that might help a PTO Examiner evaluate whether the requirements of ' 112 had been met. A final set of questions related to whether there were other ways to comply with the ' 112 requirements and the impact of any proposals or other considerations on PTO operation and design patent effectiveness.

History will show that PTO has addressed most of these topics before, in one form or another. Improvements in design patent effectiveness have occurred as a result of this type of discussions taking place in this roundtable. Also, the discussions have international interest, towards design patent procedure harmonization, a topic of current interest as the Hague Agreement on designs is becoming a very significant way to obtain international design protection. It is my privilege participate in this roundtable discussion

### III. Fryer v PTO Roundtable- ' 112 and Design Patents v Brief Review of Key Resources on the Law

A. *In re Blum*, 374 F.2d 904 (CCPA 1967). Judge Giles Rich wrote this opinion. He was a leader in developing design patent law. He emphasized the importance of clarity in design patent drawings to show what is protected.

B. *In re Zahn*, 617 F.2d 261 (CCPA 1980). It is a basic case on design patent protection with solid lines in a drawing and use of broken lines to show the environment of the design without claiming that part of the design.

C. Fryer *Amicus Brief for In re Daniels*, 144 F.3d 1452 (Fed. Cir. 1998), WestLaw legal resource, court document. Also found on web site URL [www.fryer.com](http://www.fryer.com) Newsletter No. 3 (Jan 5, 1999), brief describes the history of ' 112 and design patent practice ( a resource is William C. Robinson, The Law of Patents for Useful Inventions(1890), 65-66, brief p. 6. Product design can have combination of designs, and a sub-combination that is **independent and distinct**. The sub-combination can be protected in a continuation application if it is independent and distinct, p. 8 of brief.

D. *In re Daniels*, 144 F.3d 1452 (Fed. Cir. 1998). Also in Newsletter No 3 (See para. C next above); case cites ' 112 principle that a design application is entitled to the filing date of an earlier application as to **common subject matter**, 144 F.3d at 1456, if the sub-combination is not obscured; Daniels possessed the sub-combination design invention, 144 F.3d at 1457.

E. *In re Owens*, 710 F.3d 1366 (Fed. Cir. 2013). This case interprets *In re Daniels* (See item D next above); Protected design must be Aclearly visible@ 710 F.3d at 1367, **common subject matter** must be found in both applications, 710 F.3d at 1367. AClearly visible@ ... Ademonstrates to the artisan viewing that application that Daniels has possession at that time of the later claimed design of that article,@ 710 F.3d at 1367.

#### **IV. Fryer B PTO Roundtable- ' 112 and Design Patents B Selected Review of Slide Group I (Design Patent Day 2013)**

Check List and Rating System (For reader use to evaluate and find applicable cases)

##### **Example on page 8 (Truncated Plate with two U-shaped brackets spaced apart B Baby Bottle Strap.**

Yes, No Clearly visible?

Yes, No Obscured?

Yes, No Independent and Distinct?

Yes, No Common Subject Matter

Conclusion: Yes, No Independent and Distinct?

Comment: While the product has a difference in appearance, the single bracket version is clearly disclosed, independently. The amendment design is common with the original design. *In re Daniels* is the most relevant case. *In re Owens case* backs up Daniels in a strong way.

My answers on Example 8, page 8, in order of the questions, are Y, N, Y, Y, Y

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##### **Example on page 6 (Strap fastener for Travel goods)**

Yes, No Clearly visible?

Yes, No Obscured?

Yes, No Independent and Distinct?

Yes, No Common Subject Matter

Conclusion: Yes, No Independent and Distinct?

My answers inn order of the questions: N, Y, N, N, N

Comment: The addition of the broken line at the break may violate the *In re Owens* requirement that the feature must be shown. There is no common design. Even without that issue, my answer would be the same: there is no common. *In re Owens* states, essentially, that a product design cannot be rearranged, to change the appearance. The designs must be the same.

**V. Fryer B PTO Roundtable- ' 112 and Design Patents B Selected Review of Slide Group II (Web site Additional Examples) B Discussion topics and tentative answer (space to write ).**

Example 1 Y B Can protect amended design

2 Y

3 Y

4 Y

5 N

6 Y

7 Y

8 Y

9 N

**VI. VII. Fryer Comments B PTO Roundtable - ' 112 and Design Patents B Proposed Factors**

I suggest the best way for the PTO to proceed is not to create new factors explaining the case law principles. In stead the case law principles should be clearly explained, as I have tried to do in my examples. Several of the proposed factors are the same, essentially, the principles stated in the cases. Some are confusing to me. Others seem to be redundant. Several followed the independent and distinct plus common approach used in the cases I reviewed.

Where there is a need for clarification on a legal point, I urge Group 2900 to challenge the interpretation the PTO should take the key cases to the Federal Circuit for prompt resolution. Overall, Group 2900 has been very effective in finding workable approaches on basic issues.

## **VII. Fryer Comments B PTO Roundtable- ' 112 and Design Patents B Ways to demonstrate possession of design claimed in amended drawing B Use of written description**

This topic is a useful one to discuss. I recommend considering a tightly controlled use of a written description to explain the parts that would form a different design than shown in the original drawings. I note that the GUI MPEP provision uses a statement approach that builds a visual image of the GUI timing sequence. I suggest limiting the number of alternative designs that are created this way, and charging for the alternative descriptions.

I am slow to recommend this approach, but I think it is worth studying, because it is used in other countries, and it may be a way to bridge to some foreign systems to make claim amendment come more closely to the U. S. practice. Everyone wins with cheaper cost of application work.

In the history of U. S. design patent practice other ways to add designs in an application were tried (See Robinson treatise cited above).

## **VIII. Fryer B PTO Roundtable- ' 112 and Design Patents B Specific suggestion on working with China, on interfacing with their new design patent law that requires written description.**

I chaired the ABA committee that reviewed this new Chinese design patent law and mandatory description requirement was a big issue for some people. I spoke to the head of the Chinese IP Office Patent Law Revision Committee about this topic, and receive some strong advice that was their view a written description can be very useful. I think they have a point. It would be good to explore their flexibility and to talk with other governments that use descriptions to see if any mutual interest proposals develop.

The PTO suggestion to consider the written description claim relation topic, may be a good way to explore as a part of the WIPO SCT harmonization work.

## **IX. Fryer B PTO Roundtable- ' 112 and Design Patents B Addition topic for later roundtable B Design Patents Impact on from AIA**

The 2013 article I published on my web site ([www.fryer.com](http://www.fryer.com)) that introduced the topic of AIA design patent impact has a part related to design patent drawing amendments. The filing date for subject matter is based on when a design is claimed m under AIA, not at the time of disclosure, as pre-AIA. Since drawing amendments may change the claim scope to create a new design, that issue is a part of the strategy to prevent publications from becoming effective for amended designs. The pros and cons of design patent application drawing amendment have a longer lists now.

Since AIA is closely related to the topic of this roundtable. Attorneys, PTO and others examiners need to discuss this issue.

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