

February 12, 2016

Commissioner for Patents of the United States Patent and Trademark Office
Attn: Michael Cygan
Senior Legal Advisor, Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy
Mail Stop Comments Patents
P.O. Box 1450
Alexandria, VA 22313-1450
via email: TopicSubmissionForCaseStudies@uspto.gov

**Re: Submission of Topic in response to USPTO's Request for Submission
of Topics for USPTO Quality Case Studies, Fed. Reg. Vol. 80, No.
244 (December 21 2015)**

Dear Commissioner:

We are attorneys with Sterne Kessler Goldstein & Fox, an intellectual property law firm with more than 170 IP professionals in Washington, DC. In 2015 alone, our firm filed over 3200 design applications worldwide, nearly 500 of which were filed at the USPTO. Together we have nearly 30 years' experience filing and prosecuting design patent applications before the USPTO on behalf of over 100 companies and individuals, including 2 companies that are regularly among the top 50 annual US design patent grantees.

As a firm and as individual practitioners we regularly contribute to efforts to shape and improve design prosecution practice. We work with the USPTO and foreign patent offices, and with nongovernmental intellectual property groups around the world.

We write today to suggest that the Office study its new practice of objecting to a drawing or issuing a § 112 rejection based on a design applicant's change of broken-line weight or pattern in its drawings

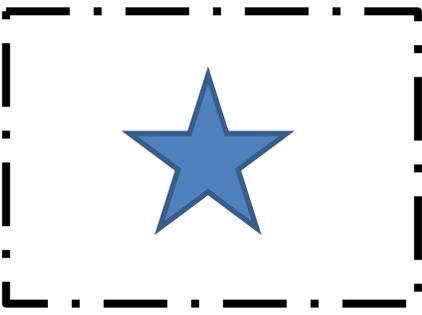
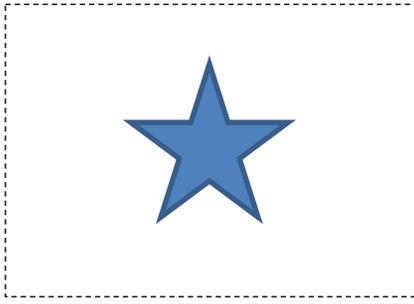
We believe investigation of this topic will result in identification of areas in which the Office can improve the quality and efficiency of its examination.

PROPOSED CASE STUDY

Title: Drawing objections and new matter rejections for changing broken-line weight or pattern in design applications.

Proposal for study: The Office should study the new practice of objecting to a drawing or issuing a § 112 rejection based on an assertion of new matter introduced by amending broken-line weight or pattern in design applications. This practice is prohibited by the MPEP and the law, and thus leads to unnecessary and protracted prosecution.

Explanation: A design applicant may desire to change the line weight and/or pattern of broken lines in the original disclosure for a number of reasons, including consistency or to make a more standard presentation for better printing on an issued patent. A hypothetical example is shown below. This example was not taken from a patent application, but was created for this paper as a visual aid to help represent the issue being raised. When applicants submit drawing figures that change only the broken-line weight and/or pattern relative to the original disclosure, the Office has recently been issuing a § 112 new matter rejection, an objection to the drawings, or both.

Original Disclosure	Replacement Figure
	

A § 112 new matter rejection and a drawing objection to this type of drawing amendment are improper and result in unnecessarily protracted prosecution. In design applications, broken lines are used to indicate portions of the design that form no part of the claimed design. See MPEP § 1503.02, subsection III and *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980). Therefore, the fact that broken-line weight and/or pattern in replacement figures differ from

its presentation in the original disclosure's drawings is of no moment because broken lines form no part of the claimed design.

The Office's practice of objecting to a drawing and issuing a § 112 rejection based on a design applicant's change of broken-line weight or pattern in its drawings should be studied to help determine the most effective way to discontinue this practice.

It is suggested that review of these practices be undertaken by personnel outside of the design unit to ensure consistency with Office-wide standards and practices.

Respectfully submitted,

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The views expressed herein are our own and are not to be attributed to any other person or entity including Sterne, Kessler, Goldstein & Fox P.L.L.C., or any client of the firm.
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