

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](mailto: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 priority, instead of issuing a § 112 rejection, based on an assertion of new matter introduced by amendment in continuing design applications.

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:** Objecting to priority, rather than issuing a § 112 rejection, based on an assertion of new matter introduced by amendment in continuing design applications.

**Proposal for study:** The Office should study the new practice of objecting to priority, rather than imposing a § 112 rejection, based on an assertion of new matter introduced by amendment in continuing design applications. This practice is prohibited by the MPEP and the law, leads to unnecessary and inefficient prosecution, and denies design applicants the fair opportunity to appeal.

**Explanation:** In prosecuting continuing design applications that at filing disclose a design that is identical to design in a prior pending design application, we frequently face two Office practices that are improper and result in protracted prosecution. First, the Office's usual response to an amendment that allegedly introduces new matter in the continuing application is a priority objection requiring that the continuing application be designated a continuation-in-part. Second, the Office does not issue a § 112 new matter rejection.

With respect to the priority objection, MPEP § 201.07 provides guidance on how to properly determine whether an applicant is entitled to its benefit claim under 35 U.S.C. § 120: “the disclosure *presented* [emphasis added] in a continuation application must not include subject matter which would constitute new matter if submitted as an amendment to the parent application.” MPEP § 201.07. A continuation-in-part application differs in that it may, at filing, “add[] matter not disclosed” in the earlier application. MPEP § 201.08. Therefore, if the continuing design application at filing discloses a design that is identical to a design disclosed in the prior pending application, the continuing application is properly designated a continuation application, and no objection to priority should be raised if a subsequent amendment is believed to introduce new matter.

The proper Office response to an amendment believed to introduce new matter is a § 112 new matter rejection, not a priority objection. However, the Office seldom raises a § 112 new matter rejection in design applications, and instead improperly issues a priority objection. The Office's failure to raise a § 112 new matter rejection in response to an amendment believed to introduce new matter denies applicants a fair opportunity to appeal the issue to the Patent

Trial and Appeal Board, which would be the proper forum for addressing an issue that touches on the statutory provision of 35 U.S.C. § 112.

The Office's practice of objecting to priority, rather than issuing a § 112 rejection, based on an assertion of new matter introduced by amendment in continuing design applications, 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.

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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