

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 over 34 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 imposing § 112 rejections for new matter based on a design applicant's change of line type in its drawing.

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: New matter rejections for changing line types in design applications.

Proposal for study: The Office should study the new practice of imposing § 112 rejections for new matter based on a design applicant's change of line type in an application's drawings. This practice is prohibited by the MPEP and the law, and thus leads to unnecessary and wastefully protracted prosecution.

Explanation: Unlike in utility applications, design applicants cannot meaningfully change the words of their claim to change its scope. Instead, they change the line types in their drawings. In general, solid lines in the drawings show a portion of the depicted article that limits the claim, while broken lines show a portion that does not. Applicants may change broken lines into solid lines by amendment to show that the now-solid-line portion limits the claim. And applicants may change solid lines into broken lines to show that the now-broken-line portion no longer limits the claim. Since the entirety of the original disclosure includes both the solid lines and the broken lines, changing one from the other simply changes what is claimed, within the bounds of what was disclosed. Yet the Office frequently rejects claims under 35 USC § 112 as introducing new matter where this kind of amendment is made.

The MPEP could hardly be more clear that any change from a broken line to a solid line or a solid line to a broken line does not introduce new matter: “applicant was in possession of everything disclosed in the drawing at the time the application was filed and the mere reduction of certain portions to broken lines or conversion of broken line structure to solid lines *is not a departure from the original disclosure.*” MPEP § 1504.04. This is consistent with the purpose of § 112's written description requirement: “simply to determine whether the inventor had possession at the earlier date of what was claimed at the later date.” *In re Owens*, 710 F.3d 1362, 1368 (Fed. Cir. 2013) (quoting *In re Daniels*, 144 F.3d at 1456).

But notwithstanding the Office's official policy, it has been the Office's *practice* since mid-2013 to reject some claims under § 112 as introducing new matter when the only change has been an amendment changing broken lines to solid lines or vice versa. The reasons that the Office provides when doing so vary and uniformly have no basis in the law or rules. For example, the Office may allege an insufficient relationship of some sort among broken-line and

solid-line elements, or may find the amendment to have been insufficiently predictable.

The Office's practice of rejecting some design application claims under § 112 as introducing new matter when the only change has been an amendment changing broken lines to solid lines or vice versa 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,

/Tracy Durkin #32,831/

Tracy-Gene G. Durkin, Reg. No. 32,831
Director, Mechanical and Design Practice
Group Leader, Sterne Kessler

/Daniel A. Gajewski #64,515/

Daniel A. Gajewski, Reg. No. 64,515
Associate, Sterne Kessler

1100 New York Avenue
Washington, D.C. 20005-3934
(202) 371-2600

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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