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June 14, 2016

Via Electronic Mail
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The Honorable Drew Hirshfield
Commissioner for Patents
Attn: Nicole D. Haines
United States Patent and Trademark Office
Mail Stop Comments—Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re. *Comments on The Application of the Written Description
Requirement to Specific Situations in Design Applications,*
81 Fed. Reg. 22233 (April 15, 2016)

Dear Commissioner Hirshfield:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the “Section”) in response to the request for comments from the United States Patent and Trademark Office published in the Federal Register on April 15, 2016 (“Proposed Guidelines”). These comments have not been approved by the ABA House of Delegates or Board of Governors and should not be considered to be views of the American Bar Association.

While the Section generally supports rules that further the objectives of the patent laws and implement their provisions accurately, the Section does not support rules that unnecessarily burden applicants. In this case, the USPTO’s proposed new approach set forth in Federal Register Notice Vol. 79, No. 25 for determining written description compliance for design patent amendments and continuation practice injects needless uncertainty and complexity into the analysis when the *en banc* Federal Circuit has sufficiently addressed the issue. The existing approach simply and sufficiently serves the public notice function.

In response to the Proposed Guidelines, the Section offers the following comments:

I. The USPTO Should Maintain the Existing Visual Approach to Determining Written Description Compliance for Design Patents.

The existing law for whether a parent design patent application provides the written description support for later amendments and child applications required under 35 U.S.C. § 112(a) or pre-AIA 35 U.S.C. § 112, para. 1 is a simple visual approach that assumes the written description requirement has been met so long as the claimed portions of the later application are depicted in the parent drawings. Federal Circuit precedent asks:

Is a later claimed subset of features *depicted* in an application's original drawing figures?

The *en banc* Federal Circuit in *Racing Strollers* succinctly stated: “As a practical matter, meeting the . . . requirements of § 112 is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application [and formally claimed].” *Racing Strollers, Inc. v. Tri Indus.*, 878 F.2d 1418, 1420 (Fed. Cir. 1989) (emphasis added); *see also In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998) (when analyzing §112 issues for design patent, “one looks to the drawings of the earlier application for disclosure of the subject matter claimed in the later application.”).

The Federal Circuit's visual approach is consistent with the USPTO's longstanding approach as noted in the Manual of Patent Examining Procedure (“M.P.E.P.”). *See, e.g.*, M.P.E.P. § 1504.04 (9th ed. Rev. 7, Oct. 2015) (explaining that “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”).

The existing visual approach and its presumption of written description support sufficiently serves the public notice function. The drawings of the parent application ably and fairly disclose and describe any depicted sub-combinations. There has been no identified problem with this approach, and no identified change in the law, and thus there is no need to change the existing approach to Section 112.

II. The Section Opposes the Proposed Multi-Consideration Approach for Design Patents.

The USPTO has proposed (but not formally implemented) changes to its Section 112 written description support analysis since at least 2013. The Section opposes the USPTO's most recently proposed approach because, like the USPTO's earlier proposals, it injects unwanted uncertainty and unnecessary complexity into the Section 112 written description support analysis.

At Design Day 2013, the USPTO informally announced a policy shift on written description support. The USPTO indicated that in “some situations” the written description support required under 35 U.S.C. § 112(a) for an amendment/child application may not be found in a parent application because the amendment/child claim scope may not be considered *described* even if *disclosed* in the original drawings.

The USPTO proposed a hypothetical example of a checkerboard application and a later child application for a smiley-face. To the Section's knowledge, neither this hypothetical nor anything similar has ever arisen in actual practice.

On February 6, 2014, the USPTO issued Federal Register Notice Vol. 79, No. 25 ("Notice 25"), proposing a multi-factor approach to determining when there is Section 112 written description support. In connection with Notice 25, the USPTO hosted a roundtable meeting on March 5, 2014, to receive feedback from practitioners on the USPTO's proposed multi-factor approach. The general feedback from the practitioners was that the proposed multi-factor approach was not needed because the law was clear. Several practitioners also stressed that the proposed multi-factor approach injected unwanted uncertainty and unnecessary complexity into the Section 112 written description support analysis.

On April 15, 2016, the USPTO issued Notice 73. Although that notice indicated the USPTO would not adopt its previously proposed multi-factor approach, and stressed that section 112 written description support would be found in "the vast majority of cases," it did not adopt the Federal Circuit's visual approach and, instead, proposed general "considerations" that would be used to determine if there is Section 112 written description support. For example, the USPTO said it would look at:

- the "totality" of the circumstances "including the title, any descriptive statements, and the drawings";
- the parent application to see what it "reasonably conveyed to an ordinary designer at the time of the invention";
- "how an ordinary designer in the art would have designed the article that is the subject of the design claim"; and
- "the nature and intended use of the article embodying the claimed design as identified by the title or description."

In the Section's view, this new "multi-consideration" approach raises the same problems as the rejected multi-factor approach. Any problem that exists occurs so infrequently that the cost of the proposed multi-consideration approach far outweighs the benefits of existing law:

- the uncertainty of the proposed multi-consideration approach will force applicants to "front load" applications, which is inefficient;
- USPTO Examiners will have to spend additional time wading through the fact-intensive inquiries of the multi-consideration approach; and
- applicants will have to spend resources securing affidavits and declarations to establish Section 112 support under the proposed multi-consideration approach.

Amendment and continuation practice is a virtue of our patent system, not a problem. A single, hypothetical example should not guide policy towards limiting that practice. The proposed multi-consideration approach will command a large amount of resources for resolving a problem that does not clearly exist and which the USPTO acknowledges will not actually arise in the “vast majority of cases.”

Summary

The Section opposes the USPTO’s proposed multi-factor approach for design patent Examiners to assess compliance with the Section 112 written description requirement in the case of amendments and continuations. Instead, the Section supports the visual approach expressed in the M.P.E.P. and the established case law mentioned in the Notice. *See Racing Strollers Inc. v. TRI Indus.*, 878 F.2d 1418 (Fed. Cir. 1989) (*en banc*); *In re Daniels*, 144 F.3d 1452 (Fed. Cir.1998); M.P.E.P. § 1504.04.

Very truly yours,



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