

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re: Application of the Written  
Description Requirement to Specific  
Situations in Design Applications

Docket No. PTO-P-2016-0001  
81 Fed. Reg. 22233

**COMMENTS OF PUBLIC KNOWLEDGE**

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Public Knowledge respectfully submits the following comments in response to the Notice and Request for Comments dated April 15, 2016.

The commenter thanks the USPTO for continuing to consider this important issue of written description for design patent applications. As the USPTO is no doubt aware, design patents are receiving increased interest and attention, particularly in view of the ongoing *Apple v. Samsung* litigation. This increased attention makes it likely that applicants will seek out new strategies for increasing the value and scope of their design patents. The broadening techniques that are the focus of this Notice are likely at the heart of those strategies.

But as discussed in these comments, the written description requirement of § 112 imposes strict limitations on the degree to which design applicants may broaden their applications through excision of features from the drawings. While certain commenters have suggested that any degree of excision is permissible so long as the remaining features are merely “clearly visible,” their cited case law is unreliable and does not support that broad view of applicants’ abilities under § 112. Instead, the jurisprudence on written description for utility applications provides substantial guidance on what sorts of broadening claims are permissible; this jurisprudence should inform practice in design applications.

## I. A Broad View of Applicants' Ability to Disclaim Elements of a Design Application Is Not Warranted Under Federal Circuit Jurisprudence

The question raised in this Notice is the extent to which an applicant may amend a design patent application or seek a continuation application that claims a subset of the elements disclosed and claimed in the original application as filed.<sup>1</sup> Several commenters previously advocated for a very broad reading of design patent applicants' ability to broaden their applications within the bounds of the written description requirement of § 112.<sup>2</sup> These broad readings would suggest that in almost all cases, an amendment or continuation would satisfy § 112 if it converted solid lines to broken ones, regardless of how much of the original design was excised or how little of the original remained.

The cited case law, however, does not support this broad standard. The primary case relied upon is *Racing Strollers, Inc. v. TRI Industries, Inc.*,<sup>3</sup> which stated:

As a practical matter, meeting the remaining requirements [i.e., other than best mode] 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 claimed therein by the prescribed formal claim.

While this quote might seem to suggest that any degree of replacement of solid lines for dashed ones would be acceptable under § 112, *Racing Strollers* is unreliable as precedent. For one thing, *Racing Strollers* concerned a specific question of law, namely whether the provision for continuation applications<sup>4</sup> applied to design applications. The matter of the scope of § 112 was irrelevant to the case, and thus the quotation above is nonbinding dicta.<sup>5</sup>

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<sup>1</sup> These comments primarily deal with the situation where a design applicant seeks to broaden the scope of the claims through removal of previously disclosed or claimed features. Applicants may obviously also seek to narrow their claims by replacing dashed lines with solid lines. Such situations should be treated according to the same principles of law as discussed in these comments.

<sup>2</sup> APLA recommended that a later-claimed design would satisfy the requirement as long as the claimed element is "reasonably discernible" from the original disclosure. IPO goes further to argue that § 112 is satisfied any time the design is "depicted" in the original.

<sup>3</sup> 878 F.2d 1418 (Fed. Cir. 1989).

<sup>4</sup> 35 U.S.C. § 120.

<sup>5</sup> Of note, no appellate case appears to cite *Racing Strollers* for this proposition of dicta, meaning that the quote has not been incorporated into a binding holding of the Federal Circuit.

Second, and perhaps more importantly, it is not clear that written description was even recognized as an independent patentability requirement at the time of *Racing Strollers*. Although § 112 is now understood to include written description and enablement as to separate and distinct elements, cases prior to *Racing Strollers* were not clear as to that distinction, sometimes suggesting that the two elements ran together. “The purpose of the description requirement of this paragraph is to state what is needed to fulfil the enablement criteria,” as a 1987 case held.<sup>6</sup> It was not until 1991 that the Federal Circuit clearly enunciated that the written description requirement was “separate and distinct from the enablement requirement.”<sup>7</sup>

Thus, it is unclear whether the *Racing Strollers* characterization in 1989 of “the remaining requirements of § 112” was directed to written description, enablement, or some incorrect conflation of the two. Since the statement was nonbinding dicta based on a confused state of existing law, *Racing Strollers* should not be considered a reliable precedent on written description law.

*In re Daniels* also does not support the idea that any excision of matter from a design application is an appropriate amendment under § 112. *Daniels* concerned a design application to a device, where the prosecutor had (improperly and likely unethically) added a superfluous leaf pattern to the drawings to facilitate allowance.<sup>8</sup> Upon discovering this, the inventor filed a continuation application deleting the leaf pattern, and the Federal Circuit held this proper.

While the Federal Circuit did note that the device was “clearly visible in the earlier design application,” it is apparent from the decision that mere visibility is not the test under § 112. Instead, the court noted that “[t]he leaf design is a mere indicium that does not override the underlying design.”<sup>9</sup> And furthermore, the court’s specific reference to the improper behavior of the prosecutor who added the leaf pattern bolstered the view

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<sup>6</sup> *Kennecott Corp. v. Kyocera Int’l, Inc.*, 835 F.2d 1419, 1421 (Fed. Cir. 1987).

<sup>7</sup> *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991); see also Margaret Sampson, *The Evolution of the Enablement and Written Description Requirements Under 35 U.S.C. § 112 in the Area of Biotechnology*, 15 Berkeley Tech. L.J. 1233, 1253 (2000) (“The written description requirement had a shaky start in the Federal Circuit, but the court finally laid the controversy to rest in *Vas-Cath, Inc. v. Mahurkar*.”).

<sup>8</sup> 144 F.3d 1452, 1454–55 (Fed. Cir. 1998).

<sup>9</sup> *Id.* at 1457.

that the leaf pattern was separate and distinguishable from the design of the device; indeed to have held otherwise would have suggested a probable inventorship defect with the application. *Daniels* thus suggests that something more than mere “visibility” is required for § 112.

And *In re Owens* fully lays to rest the idea that written description is satisfied as long as the claimed design is “clearly visible” in the originally filed application. In *Owens*, the design applicant introduced a new boundary line, suggesting that only the portion of the drawings within the boundary line was to be claimed.<sup>10</sup> The applicant argued that this was permissible because the claimed portion was “clearly visible” and thus satisfactory for written description purposes under *Daniels*.

The Federal Circuit disagreed, stating that the applicant “misconstrues” the holding of *Daniels*. The court rejected the notion that “an applicant, having been granted a claim to a particular design element, may proceed to subdivide that element in subsequent continuations however he pleases.”<sup>11</sup> *Owens* thus recognizes that § 112 places certain limits on where an applicant may excise parts of a design to thereby obtain broader design patent coverage.

## **II. Existing Law on the Written Description Requirement in Utility Applications Should Inform the USPTO’s Approach to Design Applications**

While the Federal Circuit’s decisions thus undoubtedly suggest that the written description requirement places limits on the ability of applicants to amend or seek broader continuations, the case law on design applications unfortunately does not make clear what those limits are exactly. But that does not mean that the USPTO must act blindly in establishing rules for examination. Indeed, the Office can and should apply existing guidance on the written description requirement in utility applications.<sup>12</sup>

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<sup>10</sup> 710 F.3d 1362, 1367 (Fed. Cir. 2013).

<sup>11</sup> *Id.* at 1368.

<sup>12</sup> Without question, such law applies to design patent applications. See 35 U.S.C. § 171 (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”).

## A. Utility Patent Case Law Shows that § 112 Limits the Breadth of Claims

MPEP § 2163 lays out the guidelines for examination under the written description requirement. Specifically, § 2163.05(I) relates to omission of limitations or additions of generic claims. These situations are precisely what happen when a design applicant chooses to replace solid lines in a drawing with dashed ones: the applicant omits certain limitations (i.e., originally disclosed design features), thereby leaving a more generic claim to a broader set of potentially infringing designs.

That section of the MPEP identifies relevant case law for when a generic claim will be permissible. For example, it notes that for a generic claim, the written description requirement “may be satisfied through sufficient description of a representative number of species.”<sup>13</sup> Similarly, removing an element of a claim is impermissible where that element is “an essential or critical feature of the invention.”<sup>14</sup>

These statements are consistent with Federal Circuit law. As the court has said, it is an “unremarkable proposition that a broad claim is invalid when the entirety of the specification clearly indicates that the invention is of a much narrower scope.”<sup>15</sup> Thus, the written description requirement has been explained as requiring demonstration “that the inventor possesses the **full scope** of the invention.”<sup>16</sup> And in one utility decision of potential relevance to the design context, patent claims to artificial hip sockets with cup implants were invalidated under § 112, where the specification described only conical cups but the claims were generically directed to cups of any shape.<sup>17</sup>

Although differences between the specifications of utility and design applications may raise questions of how to apply the law of one to the other, at least two key principles may be drawn from the extant case law:

- **First**, under § 112, the inventor must not merely show possession of a single embodiment within the scope of a claim, but in addition must show

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<sup>13</sup> MPEP § 2163.05(I)(B); see *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956 (Fed. Cir. 2002); *AbbVie Deutschland GmbH & Co., KG v. Janssen Biotech, Inc.*, 759 F.3d 1285 (Fed. Cir. 2014).

<sup>14</sup> MPEP § 2163.05(I)(A); see *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998).

<sup>15</sup> *Cooper Cameron Corp. v. Kvaerner Oilfield Products*, 291 F.3d 1317 (Fed. Cir. 2002).

<sup>16</sup> *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336 (Fed. Cir. 2005) (emphasis added).

<sup>17</sup> See *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158–60 (Fed. Cir. 1998).

possession of the full scope of the claim. Thus, § 112 imposes an upper bound on the scope of a patent claim.

- **Second**, the case law identifies several ways in which a specification may demonstrate possession of that full scope. The patent application may show several embodiments representative of the full scope of the claim sought, or the application may demonstrate that a feature disclosed but omitted from the claim is not essential or critical.

## **B. The Claim Breadth Limits of § 112 Are Applicable to Design Patents**

These two principles strongly inform the correct practice of examining design applications for compliance with the written description requirement. Based on Federal Circuit case law, the USPTO should adopt a test as follows:

Whether an ordinary designer would recognize upon reviewing the complete original/earlier application that the inventor had possession of the **full scope of the later-claimed design** in the original/earlier disclosure.

This standard is based on the proposed test in the Request for Comments,<sup>18</sup> with an addition to emphasize the need for proof of possession of the full scope. While the examiner still has the burden to show a lack of written description in a rejection, it is incumbent upon the applicant to have drafted an original specification that makes apparent the full scope of the claims sought in the continuation or amendment.

Several nonexclusive considerations might enter into examination for whether a design application demonstrates possession of the full scope of a later-claimed design. First, if an applicant discloses multiple embodiments per MPEP § 1504.05 in the original application, that may give rise to an appropriately broader claim, since a “representative number of species” may have been shown.<sup>19</sup> Second, even where only one embodiment

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<sup>18</sup> See 81 Fed. Reg. at 22235-36.

<sup>19</sup> Cf. *In re Rubinfeld*, 270 F.2d 391, 396 (C.C.P.A. 1959) (permitting multiple embodiments to be shown in a single application, but rejecting a “generic claim” directed to the “common appearance” of those embodiments for being “apparently directed to some broad concept which is not illustrated”). It is noted that certain older decisions hold that the genus/species distinction does not apply to design patent claims. See *Ex parte Adams*, 83 O.G. 1994 (1898) (“there is no such distinction of generic and specific design patents as there is in mechanical patents”). These decisions likely have limited applicability in view

is illustrated, the originally-filed application may have signals or indications of what features of the design are essential or crucial to the invention. For example, the drawings may include unclaimed boundary lines, as suggested by the USPTO in *Owens*, that demonstrate the inventor's possession of the idea that only a subset of features is essential to the invention.<sup>20</sup> Third, the totality of the circumstances may suggest that certain features are separable and nonessential to the invented design. This was the case in *Daniels*, where the Federal Circuit interpreted the leaf pattern added to the device as nonessential, a mere "inducium that does not override the underlying design."

Accordingly, the proper standard for whether a design application complies with the written description requirement of § 112 is whether an ordinary designer would recognize that the inventor had possession of the full scope of the design. Where a design application claim is broadened by excision of certain elements, examiners should investigate the totality of the circumstances to determine whether the excision is permissible based on the originally-filed application.

### **C. The Proposed Standard Is Not an Improperly High Burden for Applicants**

The standard thus proposed, while obviously more stringent than the highly relaxed standard suggested by other commenters, is not unduly burdensome to applicants, and in fact will promote higher quality applications.

For one thing, design applicants have long held the tools for making their originally filed applications clear as to the inventive scope contemplated by their

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of modern design patent practice. *Compare Ex parte Jenks*, 83 O.G. 1513 (1898) ("modifications of designs do not exist and should not be shown and described in one patent"), *cited by Adams*, 83 O.G. at 1995, *with Rubinfeld*, 270 F.2d at 393 (design patent statute does not "preclude the showing of two or more embodiments of a design invention"), *and* MPEP § 1504.05 ("More than one embodiment of a design may be protected by a single claim.").

<sup>20</sup> *Feder v. Poyet*, 89 O.G. 1343, 1344 (1899) ("If an inventor has a generic design capable of modification—that is, a design made up of a small number of simple elements to which other elements may be added without modification of the essential elements—he should, in order to secure protection for the generic design, show the design in his application in its simplest form. He must show the genus stripped of additions."). *Rubinfeld* disapproved of *Feder* insofar as the earlier decision required a generic claim to be depicted in a certain way, but *Feder* still stands for the proposition that a generic claim *may* be depicted by stripping it down to the essential elements.

applicants. Dashed lines for identifying essential elements of a design have been permitted for over a century.<sup>21</sup> Disclosure of multiple embodiments involving a single inventive concept is clearly permitted in the MPEP.<sup>22</sup> Furthermore, an applicant may identify characteristic features of the design in the text of the specification; indeed the MPEP explicitly contemplates that an applicant may include a disclaimer of a portion of the design or enter statements suggesting alternate unclaimed embodiments “in the design application as originally filed to provide antecedent basis for a future amendment.”<sup>23</sup> To the extent that an applicant wishes to demonstrate possession of a future claim broader than that initially sought, the applicant can easily draft an application to ensure that result.

Furthermore, in the bulk of cases it will be clear from the face of the design drawings what parts are separable and nonessential. This was the case in *Daniels*, for example. Thus, the Request for Comments observes that the “vast majority” of applications will raise no question as to whether or not the originally-filed application demonstrates possession of a claimed subset of features.

Finally, to the extent that the proposed standard does require changes in pending or future applications, that is a benefit that accrues to the public notice function of patents. The purpose of the written description requirement of § 112 is precisely to force the applicant to express, as clearly and entirely as possible, the whole scope of the invention possessed.<sup>24</sup> “The patent system is based on the proposition that claims cover only the invented subject matter.”<sup>25</sup> It would disserve the public value of the disclosure requirement of § 112, a fundamental part of the constitutional bargain for patents, to allow the applicant to suggest an intent to claim only a narrow, detailed design in initial filings, and yet pursue arbitrarily broader designs down the road.

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<sup>21</sup> *E.g.*, *Adams*, 83 O.G. at 1994.

<sup>22</sup> Additionally, an applicant could file multiple distinct embodiments, which would trigger a restriction requirement but nevertheless show the scope of the inventor’s possession at the time of application.

<sup>23</sup> See MPEP §§ 1503.01(II)(A)(5), (B)(1)–(2).

<sup>24</sup> See, *e.g.*, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 736 (2002) (elements of § 112 “must be satisfied before issuance of the patent, for exclusive patent rights are given in exchange for disclosing the invention to the public.”); *University of Rochester v. GD Searle & Co.*, 358 F.3d 916, 921 (Fed. Cir. 2002).

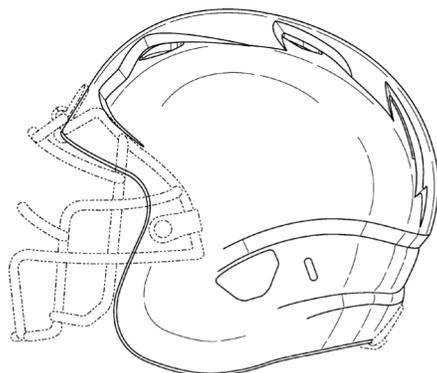
<sup>25</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) (en banc), cited in *LizardTech*, 424 F.3d at 1346.

### III. An Unrestricted Ability to Excise Elements from Design Application Claims Would Encourage Improper Behavior and Undermine the Patent System

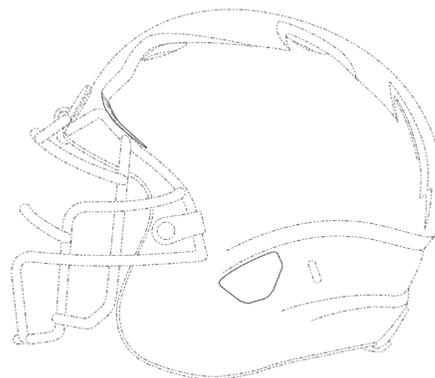
It is essential that the USPTO act quickly to adopt guidance to prevent the improper issuance of overbroad design patents, given contemporary developments that tend toward the likelihood of abusive design patent assertion practices in the near future.

Design patents are being issued with surprising frequency. The USPTO approved 89.5% of the design patent applications submitted in 2014, compared to utility and other patents, which were granted at a rate of about 51.5%.<sup>26</sup> A mere cursory review of those patents shows that the high grant rate indicates not rampant innovation but rather a high level of patenting even the most mundane designs.<sup>27</sup> Continuation practice then allows those patentees to secure broader and broader protection on such designs.

Under this system, the broad and flexible design patent universe proves an obvious instrument for abuse against unsuspecting and unintentional infringers. For example, Figure 1 shows two design patents for a football helmet, one granted in 2013



Pat. No. D678,617



Pat. No. D753346

**FIG. 1**

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<sup>26</sup> U.S. Patent & Trademark Office, *Performance and Accountability Report, Fiscal Year 2015*, at 184 tbl.1 (2015).

<sup>27</sup> See Sarah Burstein, *Moving Beyond the Standard Criticisms of Design Patents*, 17 Stan. Tech. L. Rev. 305, 336-37, 324-28 (2013).

and the other a continuation granted in 2016.<sup>28</sup> The earlier patent represents a relatively “narrow” design patent, protecting the entire crown of the helmet’s design; the later patent, however, replaces the *entire* crown design with dashed lines, save for two small openings on either side of the helmet. Another helmet manufacturer applying an entirely different crown design *but for* a small, similar-looking symmetrical opening might infringe the original design patent’s 2016 incarnation. Furthermore, a helmet manufacturer who responsibly made itself aware of the 2013 design patent in order to tailor its own design might nonetheless run afoul of the 2016 edition, and without notice.

Avoidance of infringement becomes unusually difficult in a landscape of changing design patents. For a helmet manufacturer looking to identify design patents that might jeopardize its product, it is almost impossible to search the patent catalog for comparable shapes at every level of design, and equally unreliable to consider competing products given the incompleteness of patent marking.<sup>29</sup> This regime makes it difficult for manufacturers to avoid infringement with any degree of certainty.

The USPTO has a significant opportunity to abate an upswing in cottage industries of patent litigation that threaten the marketplace of ideas due to the mutability of design patents. It should look to the history of other cottage industries of patent litigation as reason to avoid facilitating a new one now.

The history of business method patent assertion provides an educational analogy to the current state of the design patent regime. In *State Street Bank & Trust Co v. Signature Financial Group, Inc.*,<sup>30</sup> the Federal Circuit permitted patents on business practices, allowing the patenting of simple, basic methods that could be asserted against a wide variety of companies. Indeed, such patents were used almost without consequence after the Federal Circuit’s decision in *Brooks Furniture Mfg., Inc. v.*

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<sup>28</sup> Specifically, the ’346 patent is a continuation of D704,899, which is a division of D695,465, which is a division of the ’617 patent. Although the applicant claimed priority to the entire chain in the ’346 patent, the priority claim was amended in an odd way that led to the full chain not being printed on the face of the ’346 patent. Of note, the application that led to the ’617 patent in fact disclosed multiple versions with different parts of the helmet dashed, leading to a restriction requirement. But none of the embodiments in that originally filed application correspond to the later ’346 patent.

<sup>29</sup> For example, marking will not reveal patents issued after the products were marked, and it will not reveal patents held by non-manufacturing owners.

<sup>30</sup> 149 F.3d 1368, 1373 (Fed. Cir. 1998).

*Detailier Int'l, Inc.*,<sup>31</sup> which limited the courts' ability to shift attorney fees. As a result, litigious patent holders could initiate increasingly frivolous infringement suits with much lower risk. These cases created a perfect storm of conditions amenable to a burgeoning patent assertion industry able to exploit the threat of litigation to demand settlements or to obtain licensing fees, a fact that the USPTO has recognized.<sup>32</sup>

Correct readings of the law have been essential to forestalling these abusive practices to the extent possible. The Supreme Court's recent decisions in *Bilski v. Kappos*<sup>33</sup> and *Alice Corp. Pty. Ltd. v. CLS Bank International*<sup>34</sup> are credited in no small part with reducing abusive patent litigation. Similarly, *Octane Fitness, LLC v. Icon Health and Fitness, Inc.*,<sup>35</sup> which overruled *Brooks Furniture*, has arguably imposed some degree of correction on the financial incentives for patent lawsuits. But experience with business method patents shows that wherever there appears an opportunity for exploiting a flawed patent regime for financial gain, the public stands exposed to asserters' abuse.

By including a collection of elements in a design patent application and, once approved, later disclaiming the majority of those elements, patent holders position themselves to cast a wide net against unintentional infringers. Ensuring that examiners appropriately limit applicants' ability to excise design elements of a design patent application reduces the capacity of patent holders to game the system in favor of frivolous litigation at the expense of the public and the integrity of the patent system.

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<sup>31</sup> 393 F.3d 1378, 1381 (Fed. Cir. 2005), *overruled by Octane Fitness, LLC v. Icon Health & Fitness, Inc.*, 134 S. Ct. 1749 (2014).

<sup>32</sup> See, e.g., *The Innovation Act: Hearing on H.R. 9 Before the H. Comm. on the Judiciary*, 114<sup>th</sup> Cong. 26 (testimony of Michelle K. Lee, Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office) (“[T]he past several years have seen the growth of patent litigation practices which have the potential to hurt innovation.”).

<sup>33</sup> 561 U.S. 593 (2010).

<sup>34</sup> 134 S. Ct. 2347 (2014).

<sup>35</sup> 134 S. Ct. 1749 (2014).

#### **IV. Conclusion**

For the foregoing reasons, the standard for written description in design applications should be whether an ordinary designer would recognize upon reviewing the complete original/earlier application that the inventor had possession of the full scope of the later-claimed design in the original/earlier disclosure. Examiners should look to the totality of the originally filed application, including whether that application included multiple embodiments or indicated non-essentiality of certain features, in determining whether excision of features is permissible under that standard.

The commenter thanks the USPTO for the opportunity to submit these comments. If there are any remaining questions, please contact the undersigned attorney at the address indicated in the signature.

Respectfully submitted,

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