

June 14, 2016

Commissioner for Patents of the United States Patent and Trademark Office  
Mail Stop Comments—Patents  
Attn: Nicole D. Haines  
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via email: *DesignWrittenDescription2016@USPTO.gov*

**Re: Comments in response to USPTO's Request for Comments on the Application of the Written Description Requirement to Specific Situations in Design Applications, Fed. Reg. Vol. 81, No. 73 (April 15, 2016)**

Dear Commissioner:

We are attorneys with Sterne Kessler Goldstein & Fox, an intellectual property law firm with more than 170 IP professionals in Washington, DC. Together the two of us have over 36 years' experience filing and prosecuting design patent applications before the USPTO. Throughout its history our firm has filed design patent applications on behalf of nearly 200 different companies and individuals, including 2 companies that are regularly among the top 25 annual US design patent grantees. In 2015 alone, our firm filed over 3500 design applications worldwide, over 500 of which were filed at the USPTO.

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. Our firm has been on the planning committee for Design Day since its inception 10 years ago.

The USPTO has asked for input on its proposal for applying the written description requirement to certain situations that arise when a design application claims only a subset of originally-disclosed elements, but where all claimed elements were visible in the original disclosure and no new element has been added.

We write to encourage the USPTO to apply the same written description standards to all design claims. The right standard is already laid out in the MPEP, and is consistent with prevailing law. There has been no change in the law such as might call for new guidelines, yet the issues implicated in the Office's request for comments are squarely substantive. Thus any new guidelines affecting these

issues—including those proposed in the request for comments—would no doubt exceed the Office’s authority.

There is no need or basis for a new approach or additional guidelines to address the situation raised in the request for comments. Design examination quality has historically been perceived as high. To maintain this, the USPTO should follow the long-established and clear guidelines in the MPEP, rather than try to create new and complicated practices.

**There has been no change in law to justify new guidelines.**

Typically, examination guidelines or changes to the MPEP are made in response to changes in the law, which come through the legislative or judicial branches. This is how the USPTO can legitimately act within its rulemaking authority, since it can take action *procedurally* to enact the substantive law as it is determined by other bodies vested with that authority.

For example, the Office only took action to adjust its guidance with respect to examination of subject matter eligibility and obviousness *in response to* the United States Supreme Court’s decisions in *Alice Corp. v. CLS Bank Intern.*, 134 S.Ct. 2347 (2014), and in *KSR Intern. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), respectively. The first sentence of the Office’s request for comments after *Alice* begins, “The United States Supreme Court recently issued a decision in [*Alice*].” Fed. Reg. Vol. 79, No. 125, p. 36786 (June 30, 2014). Similarly, the first sentence of the Office’s publication of new guidelines after *KSR* begins, “The [USPTO] is publishing examination guidelines for determining obviousness under 35 U.S.C. 103 *in view of the Supreme Court decision* in [*KSR*].” Fed. Reg. Vol. 72, No. 195, p. 57526 (October 10, 2007).

There is no similar legal basis for adjusting examination guidance for written description in design applications. The law surrounding this issue has been well-settled for decades and is clearly described in the MPEP, which unambiguously explains that changing solid lines to broken lines, or *vice versa*, does not violate the written description requirement: “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.

The MPEP here is consistent with prevailing law, which finds the written description requirement satisfied where all elements of the claimed design are *visible* in the original disclosure. *See In re Daniels*, 144 F.3d 1452, 1456–57 (Fed. Cir. 1998) (“The leecher as an article of manufacture is clearly *visible* in the earlier design application, demonstrating to the artisan viewing that application that Mr. Daniels had possession at that time of the later claimed design of that article”) (emphasis

added); *see also Racing Strollers, Inc. v. TRI Industries, Inc.*, 878 F. 2d 1418, 1420 (Fed. Cir. 1989) (“meeting the remaining 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.”) (emphasis added).<sup>1</sup>

The Office has already been apprised that these cases establish a “simple visual test” where “the written description requirement is satisfied [where] the elements of the later-claimed design are *visible* in the original disclosure.” Fed. Reg. Vol. 81, No. 73, 22234 (April 15, 2016) (emphasis added). Yet the Office seeks to create an exception to this standard “in certain limited situations” where:

The subset of originally disclosed elements, although visible in the original disclosure, composes a later-claimed design that an ordinary designer might not have recognized in the original disclosure. In those certain limited situations, a question arises as to whether the later-claimed design satisfies the written description requirement.

*Id.* On the contrary, these situations do not raise a unique question about satisfying the written description requirement. The standard remains the same as for all other designs: if the elements of the later-claimed design are *visible* in the original disclosure, the written description requirement is satisfied. In the “certain limited situations” described by the office, *all* elements of the later-claimed design are visible in the original disclosure. Thus, under the law the later-claimed design *does satisfy* the written description requirement.

There is no legal basis for an exception to the simple visual test that is grounded in prevailing law. The Office should apply the standard developed by the courts and aptly articulated in the MPEP, rather than attempting to create an unfounded exception to it.

**The issuance of new substantive guidelines would exceed the USPTO’s authority.**

“The USPTO’s broadest rulemaking power ... does NOT grant the commissioner the authority to issue substantive rules.” *Tafas v. Dudas*, 541 F. Supp. 2d 805 (ED

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<sup>1</sup> The only significant legal decision since *Daniels* regarding written description in design applications was *In re Owens*, but that dealt with a completely different issue than is the subject of the request for comments. *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013). It was about the *addition* of a new broken line, not a change between broken and solid lines. *Id.* at 1366 (“The subject of this appeal is the broken line that Owens introduced in his continuation application”).

Va. 2008) (emphasis original). This includes “substantive declarations with regard to the Commissioner’s interpretation of the patent statutes, whether it be section 101, 102, 103, 112 or other section.” *Id.* (emphasis added).

By developing a new approach or issuing new guidelines for evaluating written description under the “certain limited situations” identified by the Office, the Office will necessarily be making a substantive declaration regarding interpretation of the patent statutes. Under *Tafas*, the Office does not have the authority to do this. The Office here is on even shakier footing than it was in *Tafas*, where the Office tried to convince the court that its actions were not substantive by relying on the fact that its actions did not implicate § 112. *Id.* Here the Office could not make a similar argument, since it proposes a new approach that directly and explicitly implicates § 112. Thus, any action that the Office takes to develop a new approach or new guidelines for evaluating § 112 is very likely to be determined substantive in its eventual challenge in the courts.

Even the specter of this challenge will cast doubt over all § 112 assessments carried out by the Office following any announcement of a new approach or new guidelines for evaluating written description in design applications.

**The implementation of new guidelines would adversely affect the rights of patent applicants and patent holders.**

The result of the Office taking a new approach or issuing new guidelines in the absence of new controlling precedent would be the imposition of *new* § 112 rejections based on *new* rationales and bases. It would also imperil the settled validity of past-issued design patents by promoting new grounds of invalidity that would inevitably be raised in litigations, reexaminations, and *inter partes* reviews. These would be significant adverse effects to applicants and patent owners, and would reinforce the substantive nature of the new approach. *See Animal Legal Def. Fund v. Quigg*, 932 F.2d 920, 930 (Fed. Cir. 1991).

**There is no practical need for a new approach or new guidelines.**

The Office acknowledges that in the “vast majority” of applications, written description support is not an issue, yet the Office has not articulated what makes the others problematic under the law, or even how to identify them.

The only example offered by the Office as raising a unique written description question is purely theoretical. The Office imagines an original disclosure of a grid of many blocks or pixels, and a later-claimed design composed of only a subset of the blocks or pixels forming a pattern (a smiling or frowning face). We are aware of no

real-world application even remotely similar to this example. To the extent it has any relevance to practical examination it is an extreme outlier, upon which it would be dangerous to premise changes in examination practice, particularly without sound legal footing.

But even in the case of this extreme example the law is clear; it satisfies § 112 because all elements of the claimed design are visible in the original disclosure. *See* MPEP § 1504.04; *see also Daniels* at 1456–57; *see also Racing Strollers* at 1420. That is not to say it is necessarily patentable. The Office must simply use the appropriate tools at its disposal to evaluate the design. In the case of a simple grid—as in the Office’s example—we have no doubt that the Office could find appropriate prior art disclosing a grid to reject later-claimed designs as anticipated under § 102.

In more realistic situations, as more solid lines become broken lines more prior art potentially comes into play. If a claim gets too general, it can be rejected as anticipated or obvious under § 102 or § 103. The Office should not distort § 112’s written description requirement to avoid having to perform prior art searches and make substantive rejections. If claim scope changes in a later-filed design, examiners must update their search, just as they should any time an amendment is made. Changing § 112 standards to short-circuit the examination process is not the right way to reduce examiners’ search burdens.

**Design examiners have in the recent past reliably applied the correct written description standard. They can do so again.**

In its request for comments, the Office explains that “in view of the comments [received in response to its previous request], it became clear that there exists a need to supplement the current provisions in the [MPEP] relating to 35 U.S.C. 112 for design applications.” Fed. Reg. Vol. 81 at 22234. But any uncertainty giving rise to this perceived need was only recently provoked, and is unfounded.

Based on our review of district court validity determinations, over the past 5 years, design patent validity has been upheld 85% of the time. This speaks to the high quality of design examination overall. Yet it is even higher when focusing on satisfaction of the written description requirement in issued patents: in *no case* was a design’s validity challenged through to a final decision on the basis of noncompliance with the written description requirement of § 112. Thus even litigants—some with many millions of dollars on the line—don’t even raise this issue because the law is so well settled.

Moreover, of the publicly accessible design Board decisions, only one appears to have dealt with a § 112 written description rejection based on an allegation of new

matter introduced by changing line types between solid and broken lines. *Ex parte Chaudhri*, Appeal No. 2012-002278, Application No. 29/116,148 (August 28, 2015). In that case the examiner was reversed, with the Patent Trial and Appeal Board applying the prevailing legal written description standard described above and favorably quoting the MPEP: “Applicants were ‘in possession of everything disclosed in the drawing at the time the application was filed and the mere ... conversion of broken line structure to solid lines is not a departure from the original disclosure.’” *Id* at 6 (quoting MPEP § 1504.04).

If there is any current uncertainty about the standards for applying § 112 to certain situations in design examination, it is an aberration created by the Patent Office’s recent attempt to *sua sponte* change examination standards in the absence of a change in the law. This attempt was first made public at Design Day 2013, and has been promoting uncertainty ever since. To resolve this uncertainty the easy solution is also the right solution: do not implement a new approach or new guidelines, just follow the ones that exist. In other words, examiners should be directed to continue examination practices that are consistent with the law, such as were presumably in place before Design Day 2013.

**If guidelines are still found necessary, they must be as circumscribed and limited as possible.**

If the Office nevertheless proceeds with adopting a new approach or issuing new written description guidelines for design applications, there should be a strong presumption against applying an exception to the “simple visual test” that finds the written description requirement satisfied where the elements of the later-claimed design are visible in the original disclosure. *See* Fed. Reg. Vol. 81 at 22234. This will help keep most examination squarely within the bounds of existing law. To overcome this presumption examiners should be required to provide substantial evidence and factual evaluation on the record. This will help to protect the public from arbitrary differences in examiner standards, and will provide a clear record for applicants and reviewing bodies to evaluate in order to further legal development of the Office’s new approach.

Further, the Office suggests in its request for comments that examiners should consider “*how* an ordinary designer in the art would have designed the article that is the subject of the design claim.” We suggest that the Office not promote such consideration, since doing so is directly contrary to the law as explained by the Supreme Court in *Gorham Co. v. White*.

Manifestly the mode in which those appearances are produced has very little, if anything, to do with giving increased salableness to the article. It is the appearance itself which attracts attention and calls out favor or dislike. It is the appearance itself, therefore, *no matter by what agency caused*, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense. The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly, but, *in whatever way produced, it is the new thing, or product, which the patent law regards*.

81 US 511, 525 (1871) (emphasis added).

### **Conclusion**

In sum, we encourage the Office to follow the existing law and guidance. There is no need or basis for a new approach or new guidelines for examining compliance with the written description requirement.

Respectfully submitted,

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