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By E-Mail Only

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**Comments to the April 15, 2016 Federal Register Notice:
Application of the Written Description Requirement to
Specific Situations in Design Applications**

Dear Ms. Haines:

The following are the remarks of NSIP Law, an intellectual property law firm located in Washington, D.C., to the April 15, 2016 Federal Register Notice requesting follow-up comments on the Application of the Written Description Requirement to Specific Situations in Design Applications (“the Notice”).

Since the issue of the proper application of the written description requirement of 35 U.S.C. 112(a) to design patent applications was first raised by the Office during the Roundtable Discussion on that issue that took place on March 5, 2014, our firm and its clients have been greatly concerned with the way that the Examiners and Supervisors within Technology Center 2900 have interpreted and applied this requirement of Section 112(a), as well as the relevant case law and MPEP provisions when examining pending design patent applications. During the past two years, design applications under our purview have routinely received objections to domestic priority (in the case of continuation applications filed under 35 U.S.C. 120), as well as rejections under Section 112(a) for failure to comply with the written description requirement in instances where the design claim was amended in order to change its scope in any way, whether to broaden it or to narrow it.

We are further concerned by the reasoning articulated by various Examiners for objecting to or rejecting the design claim based on Section 112(a), as many of the factors and standards referenced are regularly inconsistent with the applicable statute, MPEP provisions, or the controlling Federal Circuit case law that has interpreted those provisions as they apply to design patent applications. In particular, our examination of many Office Actions has demonstrated the persistent inclusion of citations to and arguments based upon utility patent case law. The Office’s citations often involve unrelated chemical or biotech inventions, which have no applicability to design practice, given the substantial differences in the nature and extent of the disclosures of the invention required of such utility patent cases. Other design related cases, including *In re Mann*, 8 USPQ2d 2030 (Fed. Cir. 1988) are frequently referenced to find a lack of written description, even though those cases, including *Mann* do not address this issue. Moreover, the Office has failed to rely on the



recent body of controlling Federal Circuit precedent which interprets and applies the written description requirement to the particular disclosures that are provided by design patent applications.

Despite our consistent disagreement with the Office's application of Section 112(a) in responses to Office Actions, and where appropriate, in appeals of final actions to the Patent Trial and Appeal Board (PTAB) and Petitions to the Director under 37 C.F.R. 1.181, these issues remained unresolved. We consistently cited to the same controlling Federal Circuit precedent relevant to design patent applications discussed in the Notice, and requested the application of this precedent be applied to the analysis of a design claim's compliance with the written description requirement of Section 112(a).

This resulted in an ongoing concern with the interpretation and application of the written description requirement by Technology Center 2900. The practical effect of which has been to impair our clients' access to their statutory rights to file continuation applications which change the scope of the design claim, to amend the design claim in order to avoid cited prior art, or to seek a broadening reissue of the design claim through the patent reissue process. In almost every instance where our clients sought the benefits of those rights, their efforts were met with a final objection to or rejection of the design claim based on an alleged lack of written description under Section 112(a).

Therefore, we are pleased that the Office has proposed in the Notice to adopt the legal standards for the application of the written description requirement to design patent applications, as stated in the controlling Federal Circuit case law and the MPEP provisions on that subject. The proposed interpretation of those cases and provisions, and the discussion of their applicability to the design patent context provided in the Notice is reasonable, accurate and consistent with the intent of the Court and MPEP. We are further encouraged by the recognition, included in the Notice, that "[i]n the vast majority of such situations, the fact that the subset of originally disclosed elements composing the later-claimed design is visible (claimed or unclaimed) in the original/earlier applications is sufficient to demonstrate to the ordinary designer viewing the original/earlier application that the inventor had possession of the later-claimed design at the time of filing the original/earlier application." If fully implemented, that policy will return the written description inquiry back to its form prior to the Office's March 5, 2014 Roundtable Discussion. Such a change is consistent with the intent of Congress and the Federal Circuit in applying the written description requirement broadly and permissively to design patent applications. Therefore, we enthusiastically support the consistent application of the legal analysis and examination policies set forth in the Notice.

Nonetheless, a portion of the proposed examination policy stated in the Notice presents concerns. The Notice proposes to leave open the possibility that "limited situations may exist where a later-claimed design, composed of only a subset of originally disclosed elements (claimed or unclaimed), raises a question as to whether the later-claimed design is supported by the original/earlier disclosure, even though the elements composing the later-claimed design are visible in the original/earlier disclosure." While we understand and appreciate the Office's concern that there may be instances where features are composed in a subsequent amendment to the drawings that may render the design to be unrecognizable because they create an arbitrary new design, we believe that such instances will be very rare. In the vast majority of instances, the size, shape, visual appearance and proportions of an amended design will be shown exactly in the original drawing figures, whether in broken or solid lines.

However, we are concerned that the instances where a supporting written description will not be found may be extended to include individual features which do have recognition and support in the previous design,

because they have the exact same visual appearance. We therefore respectfully request that this “limited situation” area be supplemented with a detailed and specific understanding which includes examples and relies on the appropriate case law, statute, and MPEP sections in analyzing such issues relating to an alleged lack of written description under Section 112(a). We trust that training will be provided that will discourage the Examiners from relying on previously-cited court cases dealing with chemical and biotech cases, or which involve design patents but have nothing to do with the written description requirement, like *In re Mann*.

The Notice provides an example of a potential design claim that includes the claiming of disjointed design features (blocks or pixels) that are arbitrarily spread across a design. The Notice proposes to allow an Examiner to object to or reject a design claim if the new composition or combination of claimed features in the continuation or amendment is not recognizable in the original disclosure of the design (to include the totality of the title, claim, descriptive statements in the specification and the drawing figures), even though the features that are claimed may have the same exact size, shape, visual appearance, proportions or relative placements within the design that they are shown to have in the original disclosure.

We are therefore concerned with whether the controlling Federal Circuit case law from which this “recognizability” statement is derived would support such an exception to the otherwise broad application of the written description requirement set forth in the Notice. No case that we are aware of that has been decided by the Federal Circuit, a federal district court, or by the PTAB has found a lack of supporting written description in instances where the particular design features that are claimed in the amended or continuation claim have the exact same appearance in terms of size, shape, configuration, proportion or placement within the design, relative to the appearance that they had in the original drawing figures.

The only occasions that we have found where a court or the PTAB has held that there was no supporting written description are in instances where the size, shape, appearance, proportions or placement of individual design features were different in the amended or continuation claim from the way that they appeared in the original disclosure of the design. For example, in *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013), the inclusion of a new boundary on the front surface of the claimed container design was found by the Federal Circuit not to be recognizable in the original drawing figures, because the resulting change in size and shape of that surface was not shown in the original drawing figures.

Original Owens Design



Fig. 2

Amended Owens Design

Dot-dash line
inserted by
amendment

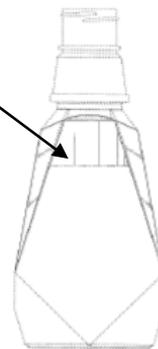


Fig. 2

Similarly, in *In re Salmon*, 705 F.2d 1579 (1983), the Federal Circuit found that the design claim of a later-filed application failed to meet the written description requirement because it claimed a stool with a **round** seat, whereas the original drawings in the parent application claimed a **square-seated** stool.

In a recent Inter-Partes Review (IPR) proceeding, the PTAB denied a claim of domestic priority because of a noticeable difference in the way that the spout tip feature of the claimed design was drawn in the figures of the parent application relative to the way that it was drawn in the child design patent at issue. See, *Munchkin, Inc. v. Luv 'n Care, Ltd.*, Case No. IPR2013-00072 (PTAB April 21, 2014):

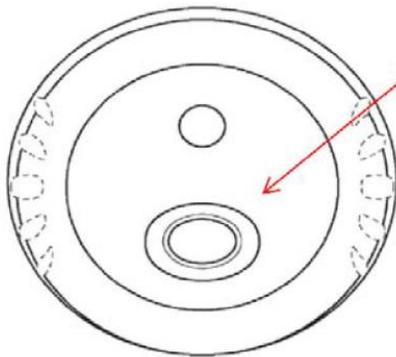


Fig. 3 of '465 patent
(rotated 90° counter-clockwise)

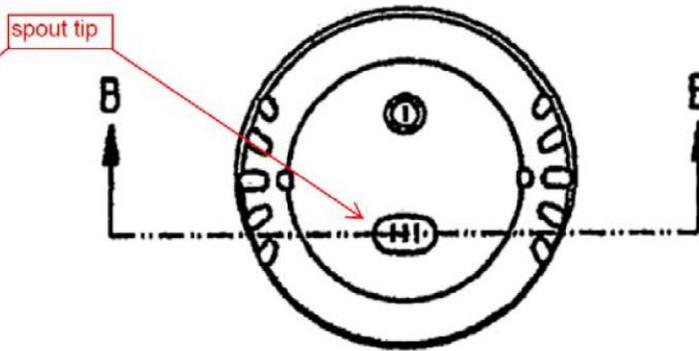
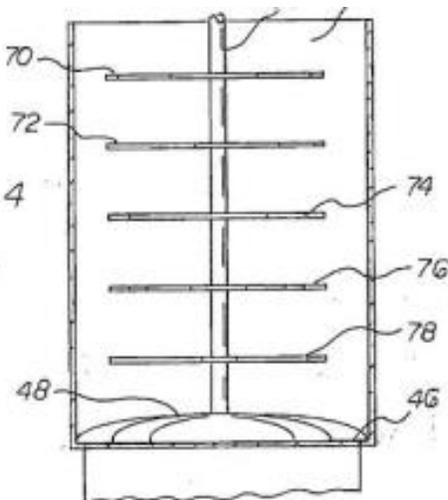


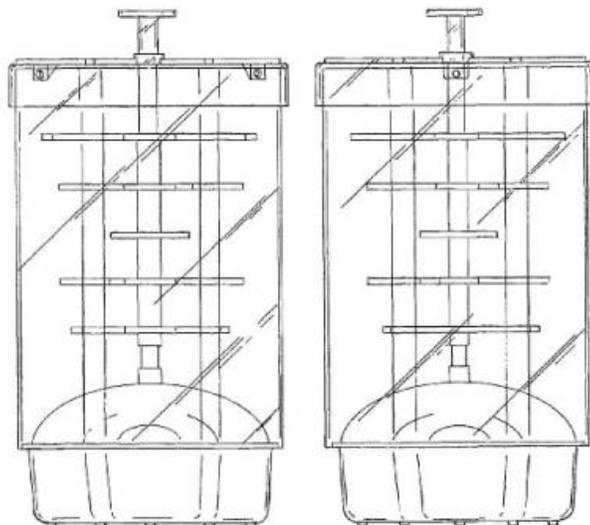
Fig. 12a of the '106 application

Similarly, in *Spencer v. Taco Bell Corp.*, 2013 U.S. Dist. LEXIS 142619 (M.D. FL 2013), the District Court also found that the design patent was not entitled to claim domestic priority for the claimed design back to an earlier-filed parent application, because certain claimed features were drawn in the figures of the parent application to have a different ornamental appearance from the way that they were shown in the drawings of the later continuation application.

Parent Application



Continuation Application



As a result, we respectfully suggest that the proposed use in the Notice of the “recognizability” requirement stated in *In re Daniels*, 144 F.3d 1452 (Fed. Cir. 1998), to form the basis for a potentially broad and subjective exception to this new examination policy would be an incorrect reading of the case law, and would potentially result in the same uncertainty and disputes between applicants and Examiners that resulted in the issuance of the present Notice in the first place. Based on the holdings of the relevant case law discussed above, and the context in which the term “recognizable” was used in *Daniels*, we suggest that a later design claim is “recognizable” in the original disclosure of the design if the later-claimed features are recognized in the original drawings to have the same size, shape, configuration, ornamental appearance, proportions or relative placement.

There is nothing that we see in the case law that would support a finding that there was no supporting written description in instances where the “composition” of the later-claimed design may be different from the original disclosure, or that the particular combination of features that is claimed would not be “recognizable” in the original drawing figures, which is what the particular example provided in the Notice would suggest. It would apparently be unprecedented under the case law for the Office to uphold an objection to or rejection of the design claim in instances where the claimed features are shown to have the exact same appearance and form in the original drawings or disclosure. No case has held that a particular selection, composition or combination of design claims could itself lack a supporting written description, if the individual design features that are claimed are exactly the same.

That would be directly contrary to the Federal Circuit’s holding in the *Racing Strollers* case that written description support under Section 112(a) should be found in all cases where there are “illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application and claimed within.” 878 F.2d 1418, 1420 (Fed. Cir. 1989) (*en banc*). The exception to this rule suggested by the Office presents problems of practicality, as the Notice provides no objective standards or parameters for its application to a given design. Therefore, there is the continuing danger that in practice, this exception will be applied broadly in order to continue the problematic and subjective application of the written description requirement to design patent cases that existed prior to the Office’s March 5, 2014 Roundtable Discussion.

As a result, we respectfully suggest that the Office instead adopt a bright-line test for compliance with the written description requirement in design patent applications. This test would require the Examiners to find compliance with the written description requirement in all cases where the later-claimed design features are shown in the original disclosure of that design to have the exact same ornamental appearance, proportion and placement. The Examiners would be permitted to object to or reject a design claim on written description grounds only when the ornamental appearance, proportion, or placement of the claimed design features differs from that which is shown in the original disclosure. Such a bright-line test is consistent with the holdings of the courts and the PTAB on this issue in design patent cases, and removes much of the subjective analysis that has caused disputes.



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Thank you for your kind consideration of this matter. Please contact us should you have any questions, or if you would like additional information.

Very truly yours,

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