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Via email to DesignWrittenDescription2016@uspto.gov

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
attn.: Ms. Nicole D. Haines

Re: Comments in Response to “Request for Comments on the Application of the Written Description Requirement to Specific Situations in Design Applications” 81 Fed. Reg. 22233 (April 15, 2016)

Dear Under Secretary Lee,

Crocs, Inc. (“Crocs”) respectfully urges consideration of these comments filed in response to the Office’s Request for Comments on the Application of the Written Description Requirement to Specific Situations in Design Applications (“the Request for Comments”), published on April 15, 2016 in the Federal Register, 81 Fed. Reg. 22233. To begin, Crocs would like to thank the Office for opening this important issue for public comment, and for taking the time to consider the comments in crafting a set of new written description guidelines for examination of design patent applications.

As set forth below, Crocs recommends further strengthening the framework set forth in the Request for Comments by emphasizing precedential holdings that identity¹ of drawings is not required for written description support.

I. Why Crocs is Commenting

Crocs generates over a billion U.S. dollars per year in revenue and employs thousands of workers, including a number of industrial designers who focus their efforts on new product

¹ Crocs herein refers to “identity” rather than “identity” so as to avoid confusion with other concepts often associated with “identity,” and notes that “identicalness” could also be used.

design. Crocs regularly files and enforces U.S. design patents, often in protecting new styles of its colorful molded footwear. Due to the practical realities involved with protecting industrial designs internationally in the fast-moving world of fashion, Crocs sometimes finds itself on the front lines of the Section 112 design patent written description policy discussion.

In design patent examination, a written description standard that is either too inflexible, or inconsistently applied, increases cost and uncertainty. While the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) has decided a relatively small number of design patent written description cases, the application of those cases in examination currently differs markedly and surprisingly from application to application, as well as from examiner to examiner. Crocs suspects that other design innovators find themselves similarly situated – their design patent prosecution costs are increased not for reasons related to protecting the public against new matter in design patents and priority claims, but rather for reasons related to the application of written description rejections in a manner inconsistent with the law or in a manner that is inconsistent from examiner to examiner. Adding further guidance to the framework set forth in the Request for Comments will further promote the correct and consistent application of written description rejections.

The Request for Comments touches on two different, though related, written description scenarios in design applications. In the first type of scenario, an earlier filed application (including drawings) is compared to a later set of non-identical design drawings to determine whether the earlier application provides written description support for the later set of design drawings. *See, e.g., In re Daniels*, 144 F.3d 1452 (Fed. Cir. 1998). In a second type of scenario, a set of later-filed design drawings is identical to an earlier set of drawings, except for an indication of claimed versus unclaimed subject matter, and the examiner must decide whether the particular scope of claimed versus unclaimed subject matter finds support in the earlier application. *See, e.g., In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013). While the bulk of the proposed guidelines in the Request for Comments appear to focus on the second type of scenario, Crocs’ comments herein focus on the first type of scenario.

II. Case Law Should Anchor the Written Description Guidelines

As tempting as it may be to formulate hypothetical scenarios to illustrate concepts in written description design patent law, the use of such hypothetical scenarios should be avoided in

the examination guidelines. Because the illustrative value of hypothetical scenarios often depends upon the input assumptions and constraints, and because such assumptions and constraints are often not fully set forth in the hypothetical scenario, the Office risks an examiner applying the conclusion or outcome of the hypothetical scenario in a case with different input assumptions and constraints that might require a different outcome under the applicable case law. Thus, while it remains important to acknowledge the unsettled aspects of design patent written description law, any examination guidance adopted should find strong support in real world cases, and should be updated as more precedential decisions become available.

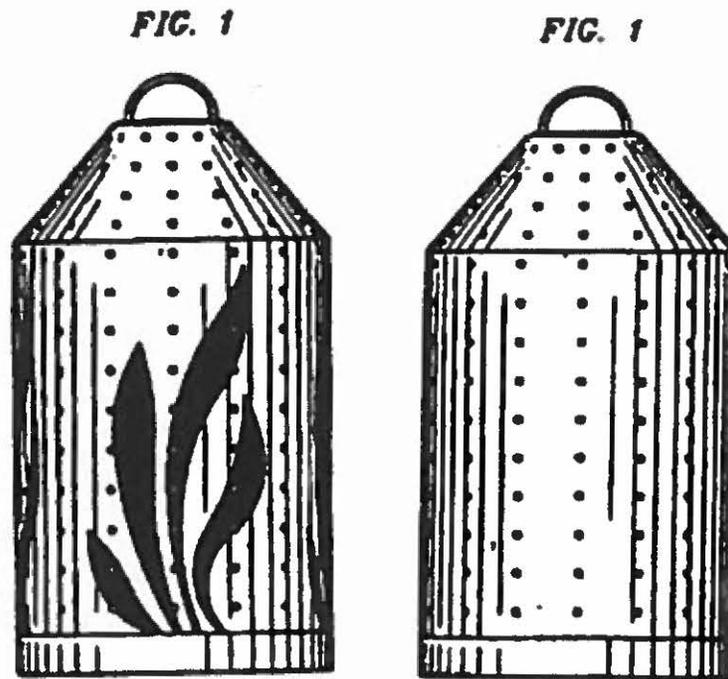
Given this approach, there remain aspects of the settled case law that lend themselves to synthesis into additional “general principles” to guide examination beyond the mere broad statement of the legal standard. These include examples provided by the Federal Circuit of what to do, as well as what not to do, from an examination perspective.

III. Written Description Support in Design Drawings Does Not Require Identity

The work of design examiners requires them to be both thorough and hyper detail oriented. When comparing two images, their eye is trained to spot even the smallest difference in curvature, the tiniest computer artifact, or the most minor of inconsistencies. In comparing two sets of drawings, a design examiner’s trained eye for detail could even cause the examiner to see differences that would not be apparent to, or that would be regarded as trivial or inconsequential by, a designer of ordinary skill in the particular art being examined. It would not be uncommon for an examiner to end the analysis there and issue a written description rejection stating that the current and prior drawing sets are not identical, perhaps even pointing to specific lines or features within the current drawings that are not identical to the prior drawings. While such an approach contradicts binding Federal Circuit precedent, it is believed to still occur frequently.

In *In re Daniels*, 144 F.3d 1452 (Fed. Cir. 1998), the Federal Circuit compared the design drawings of a priority application to the design drawings of a continuation application in deciding whether the new drawings had written description support in the old drawings under Section 112. In that case, the patentee’s priority design application featured a leech trap cage with a pattern of leaves applied to the sides (FIG. 1 reproduced below, at left). *Id.* at 1454. The

patentee then filed a continuation which included the same drawings, but with the pattern of leaves completely removed (FIG. 1 reproduced below, at right). *Id.* at 1455.



In upholding the rejection of the continuation application on Section 112 written description grounds, the Board of Patent Appeals and Interferences (“BPAI”) “held that *any* change in the drawing defeats a priority claim for a design patent.” *Id.* at 1457 (emphasis added). The BPAI had reasoned that “a design is ‘a unitary thing,’ and thus that the change in the drawings defeats compliance with the written description requirement” *Id.* at 1455. The Federal Circuit reversed, noted that the BPAI had applied an incorrect standard, and held that “the inquiry is simply to determine whether the inventor had possession at the earlier date of what was claimed at the later date.” *Id.* at 1456. “The Board was incorrect in holding that any change in the design defeats a priority claim as a matter of law.” *Id.* at 1457.

Given this precedent, the proposed examination guidelines should clearly state that for a proper Section 112 written description rejection in a design application comparing a prior set of drawings to a new set of drawings, it is not enough for the examiner to assert that the drawings or portions thereof are not identical, or that there has been a “change in the design.” A Section 112 written description rejection that amounts to nothing more than an assertion that the drawings or the depicted design are changed, or are not identical, is akin to the approach reversed by the Federal Circuit in *In re Daniels*. *See id.* Stated differently, under the *In re Daniels* precedent, an

examiner should not just conduct a simple visual test and then conclude that any drawing discrepancies necessarily add new matter or run afoul of the written description requirement. Instead, a proper Section 112 written description rejection explains how and why a designer of ordinary skill in the art would determine that the inventor did not have possession at the earlier date of what was claimed at the later date. *See id.*

In remaining true to the *In re Daniels* holding, such an explanation by the examiner would necessarily include more than “because the drawings (or portions thereof) are different” or “because there has been any change in the design.” For example, in a case affirming the denial of a priority claim from a design application claiming a stool with a round seat to an earlier design application claiming the stool with a square seat, the court characterized the square seat shape as “an integral element” of the earlier claimed stool and noted that nothing in the earlier application suggested a broader design. *See In re Salmon*, 705 F.2d 1579, 1581 (Fed. Cir. 1983). Though that case was decided before *In re Daniels*, the court did not simply hold that the priority claim was defeated because a round seat is not the same as a square seat, but instead explained how and why the seat shape would have been viewed as “an integral element” of the earlier design. *See id.* While as a practical matter most would likely agree that the earlier application in *In re Salmon* did not show that the inventors had possession of the substitution of a round seat for a square seat in what often forms one of the most visually prominent features of a stool, the lack of sameness in the drawings, by itself, did not end the written description analysis.

This guidance also finds at least indirect support in the en banc *Racing Strollers* opinion from the Federal Circuit: “As a practical matter, 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 and claimed therein by the *prescribed formal claim . . .*” *Racing Strollers, Inc. v. TRI Indus., Inc.*, 878 F.2d 1418, 1420 (Fed. Cir. 1989) (en banc) (emphasis added). The references to “whatever form they may take” and “prescribed formal claim” acknowledge that, in some cases, illustrations can and do change in form between an earlier application and a later application in which the design supported by the earlier illustration is formally claimed, without running afoul of the written description requirement. An applicant invokes this type of analysis when filing formal line drawings to replace, or claim the priority benefit of, earlier drawings in

the form of photographs or sketches or wireframe plots of the same design, or in a form showing the same article from more, less, or different viewing angles or optical perspectives.

Given the guidance from the Federal Circuit reversing the “any change in design defeats written description support” approach, the proposed examination guidelines should warn examiners to avoid those types of rejections. Without such further clarification, examiners might think that a list of perceived differences between an earlier illustration and a later illustration can somehow substitute for the proper inquiry into “possession” by the inventor as it would be understood by a designer of ordinary skill in the art. This, in turn, leads to examiners increasing prosecution cost, uncertainty, and inconsistency by issuing written description rejections for changes that a designer of ordinary skill in the art would consider to be minor, inconsequential, trivial, or as not impacting the claimed design as a whole. As published, portions of the proposed guidelines in the Request for Comments leave unclear whether an examiner is allowed to read “possession of ‘the design’ or ‘the same design’ or ‘the later claimed subject matter’” as “possession of the exact same drawings of the design.” The proposed guidelines should reflect that binding precedent has answered this question in the negative.

IV. Proposed Wording for Additional Guidelines

While the Office is encouraged to adopt any portion of these comments for inclusion in the guidelines, below is a succinct statement about drawing comparisons in written description rejections, for proposed inclusion in the new guidelines.

Drawings Need Not Be Identical

For a proper Section 112 written description rejection in a design application comparing a prior filed application and drawings to a new set of design drawings, it is not enough for the examiner to assert that the new drawings or portions thereof are not identical, or that there has been “any change in the design.” See *In re Daniels*, 144 F.3d 1452, 1457 (Fed. Cir. 1998) (“The Board was incorrect in holding that any change in the design defeats a priority claim as a matter of law.”). These types of inquiries can often arise when an applicant files formal line drawings to replace, or claim the priority benefit of, earlier drawings in the form of photographs or sketches or wireframe plots of the same design, or in a form showing the same article from more, less, or different viewing angles or optical perspectives. Cf. *Racing Strollers, Inc. v. TRI Indus., Inc.*, 878 F.2d 1418, 1420 (Fed. Cir. 1989) (en banc) (holding that “[a]s a practical matter, 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 and claimed therein by the *prescribed formal claim*)” (emphasis added).

Instead, a complete Section 112 written description rejection explains how and why a designer of ordinary skill in the art would determine that the inventor did not have possession at the earlier date of what was claimed at the later date. *See In re Daniels*, 144 F.3d at 1456 (“inquiry is simply to determine whether the inventor had possession at the earlier date of what was claimed at the later date”); *cf. In re Salmon*, 705 F.2d 1579, 1581 (Fed. Cir. 1983) (characterizing the square seat shape as “an integral element” of the earlier claimed stool and noting that nothing in the earlier application suggested a broader design). A Section 112 written description rejection in a design application that amounts to nothing more than an assertion that the drawings lack identity cannot, alone, form an adequate basis for the rejection, particularly where a designer of ordinary skill in the art would consider the drawing differences to be minor, inconsequential, trivial, or as otherwise not impacting the claimed design as a whole. *Cf. In re Daniels*, 144 F.3d at 1457 (holding that “the leaf design” shown in the prior application was “a mere indicium that does not override the underlying design”).

In conclusion, Crocs appreciates the opportunity to submit these comments in the spirit of providing additional concrete guidance, gleaned from the governing case law, to design patent examiners in the exercise of Section 112 written description analysis.

Sincerely,



Sara Hoverstock
Vice President, Global Intellectual Property
Crocs, Inc.