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To: DesignWrittenDescription2016 <DesignWrittenDescription2016@USPTO.GOV>

Subject: Requested Public Comments on written description requirements for Design Applications

The following comments are respectfully submitted in response to the recent PTO Federal Register request for public comments on the consideration of MPEP changes for the examination of design patent applications. Although some of these comments will be obvious to long time patent practitioners, I did not see them specifically noted in the subject FR Notice, and I believe they should be.

First, it should be expressly noted that there is no *statutory* basis for different treatment of design patent applications than utility applications under 35 USC 112, 102, 103, and most other provisions of the patent laws, notwithstanding their very different examination practices* and some inconsistencies in Fed. Cir. opinions. Nor is “new matter” properly allowed to be introduced by amendment in either. However, there is a very important difference for design patents. Unlike utility patents, in design patents there is in effect a merger of the specification and the claim. The design patent drawings constitute all or almost all of the specification and claim and delimit and define the scope of the claim. Thus, any changes in the design specification can directly change the proper scope of the design claim. Far more so than in a utility application. The prime example is changing some of the non-limiting phantom (broken, dotted or dashed) lines in a design application to claim-limiting solid lines or vice versa. [The subject of the decision in *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013).]

This 112 issue which is so integral to claim scope for design patents is a further concern re the axiomatic “black letter law” that a patent claim must be interpreted with the same claim scope for both validity and infringement. [E.g., *Kimberly-Clark Corp. v Johnson & Johnson*, 745 F.2d at 1449 (Fed. Cir. 1984).] The Fed. Cir. case law for design patents has not been that clear. Including an inconsistent [albeit 103 required] POSITA (a professional product appearance designer) test for validity, but modified by unique non-statutory proof requirements differing from those for utility patents,* and in juxtaposition to a broad “ordinary observer” comparison test for design patent infringement. *Egyptian Goddess Inc. v. Swisa Inc.*, 543 F.3d 665, 671 (Fed. Cir. 2008) (en banc). The latter test for design claim infringement is not consistent with PTO design application examiners taking a very narrow view of design patent claim scope as being limited by all solid lines and their shapes for 103 examination.** Furthermore, it is difficult to see why 103 initial rejections would not be far more appropriate for most design applications than 112 “written description” rejections, unless the drawings are really so poor or ambiguous as to not even clearly show the subject ornamental object. Nor does the lay comparison for infringement seem consistent with arguments for judicial view of design patent claim scope as narrow [see, e.g., the article “Functionality and Design Patent Validity and Infringement”, 91 *Journal of the Patent and Trademark Office Society (JPTOS)* 313, May, 2009, by Perry J. Saidman]. Even a narrow view of claim scope does not avoid the requisite 103 question of whether or not it would be obvious to a product appearance designer of ordinary skill in that art. The Sup. Ct. 103 guidance in *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) is particularly applicable to design applications because professional product appearance designers work on many different products in many different commercial fields. Thus effective “non-analogous art” arguments or failures to search other areas should be much rarer.

Further confusion as to design patent claim scope and infringement may be seen in the most recent Fed. Cir. design patent decision of *Sport Dimension, Inc. v. Coleman Co., Inc.* (Fed. Cir. April 19, 2016), as discussed at: <http://patentlyo.com/patent/2016/04/construction-federal-circuit.html>

I am a fully retired former patent attorney, and this does not represent the views of any other person or organization. This is a purely pro bono submission of personal views. Differences of opinion from those with current extensive design patenting practices may be expected.

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*See, e.g., the respective Fed. Cir. decisions discussed in “Design Patents §103 – Obvious to Whom and As Compared to What?” Patently-O, Sept. 17, 2014.

**Note, for example, prior observations, including my own, that design applications [very differently from utility applications] are rarely rejected during examination for anything other than mere formalities. Less than 2% ever even receive an initial 103 rejection, as was found in the formal study by Professor Crouch reported at:

<http://patentlyo.com/patent/2010/01/design-patent-rejections.html>