

COMMENTS REQUESTED BY U. S. PATENT AND TRADEMARK OFFICE (USPTO) ON
APPLICATION OF THE WRITTEN DESCRIPTION REQUIREMENT
TO SPECIFIC SITUATIONS IN DESIGN APPLICATIONS

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I. EXECUTIVE SUMMARY: The USPTO FR proposal is an important change and supported by the patent statute and case law. It implements the one invention for a design patent law, that has been the law for utility and design patents. These comments include a needed recommendation that should help clarify the one invention law analysis for design patent practice Examples are provided on how to apply the one invention law to design patents

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Necessary changes to the way proposed to implement the patent law on written description for design patents

Examples to consider, for comparison, on the USPTO proposed implementation and the approach recommended by these comments

III. INTRODUCTION B SUPPORT FOR THE PROPOSAL

A. These comments incorporate by this reference the prior oral and written statement given by Professor Fryer at the Roundtable, held on March 5, 2014. For access to documents and event recording go to URL: www.uspto.gov/patent/contact-patents/roundtable-written-description-requirement-design-applications As explained in the FR Notice and in my Roundtable presentation, this proposal is clearly supported by current U. S. case law

B. In principle I support the USPTO's approach to the clarification of the written description requirement for design patents. This step will make the U. S. design patent system more effective. In particular, it will make the application for design protection fit the nature and role of design patents. The evaluation of design patent protection scope will be more realistic. The international design registration system (Hague Agreement) will benefit from this step forward, as the proposal will allow more predictability in preparing and prosecuting design patent applications, a point that the USPTO has emphasized. Overall, it is WIN --WIN change for the design owner and the the public.

IV. WHY THE CHANGE IS NEEDED

There are some who argue that there be no need for change in current design patent written description practice. My answer is that the proposal is essential guidance. The USPTO proposal merely helps guide the design application practice to follow the current law. The USPTO will benefit from the guidance received by this open discussion of how to apply the current law..

V. U. S. PATENT LAW REQUIRES IMPLEMENTING THE PROPOSAL B THUMBNAIL VIEW

A. Most attorneys are brought up beginning with utility patent practice. They are familiar with the requirement for one invention per patent and how that controls the utility patent claim structure. The switch over to design patent practice requires increased visual analysis, and some changes in procedures, such as the claim consisting only of the drawing, supporting description incorporated into the design patent, and other controlling limitations.

B. Utility patent practice has its own history for addressing the one invention law and design patent practice needs to clarify its approach consistent with the law. It is quite clear in utility patent practice that a claim to more than one invention in an application is not allowed, if the scope of an allowed claim does not embrace each claimed invention. The restriction practice will be applied (MPEP Chapter 800B Restriction in Application filed under 35 U. S. C). The design patent application, with its detailed disclosure and non-claimed broken line practice, and solid line claiming, has to follow the same one invention in a patent requirement. As the drawing is changed by replacing broken lines with solid lines, or vice versa, the design visual image changes. If it changes so much that a skilled designer would consider it a distinctly different design from the original claimed design, it is not the same invention, and the changed design cannot be claimed in the original application. The one invention in a patent law has equal application to design patent applications. The USPTO is applying this patent law principle to utility and design patent practice, as they should.

C. This thumbnail review is too short to communicate the complex procedure of utility patent practice. It is hard to explain the law without an invention to analyze. This Thumbnail introduction is important to help show that the USPTO is right in applying the one invention in a patent standard to design patents, limiting the design patent application claim to one invention. There is a lot of background in the utility patent practice, but none of it changes this basic law that the USPTO is applying correctly.

VI. RECOMMENDED ADDITION TO THE PROPOSAL

The USPTO proposal implementation, described in Section III of the FR Notice, pages 22235-22236, may be incomplete, at least need clarification to apply the current law of only one invention in a design patent. The proposed test for possession of the design in the written description is that the amended design is the same design in the original application. The key issue is whether the design claimed is clearly visible in the amended original application, not just present. While the example given by the proposal is one of the situations that would prevent claiming a design, the necessary test is broader, to include other design created by amendment claiming, changes in the drawings or other application parts, that may create a different design from the one in the original application.

It is recommended that the proposal include a requirement that the claimed design must be distinctive in the amended application, to a person with ordinary skill in the design art. This addition would be one way to fill the proposal void. It appears to me the previous AIPLA comments, referred to in Section III, were applying the broader concept that is part of the current law of one design invention in a patent, as discussed above. The Section III discussion comes close to saying what needs to be said, that mere presence of a design in the amended original application is not enough. The original application design as a whole must be distinctive in the amended application to comply with the patent law.

Some patent attorneys may be concerned that this recommendation opens the door to constant debate over design patent claim amendment. It will force the careful use of amendments to kept within the current law, which is important to the litigation of a design patent. Many design patents have additional features that are not a distinctive part the design. The courts in infringement analysis should rely on the distinctive features to find infringement, as was done in the famous *Gorham Co. v. White*, U. S. Supreme Court case, 81 US 511 (1871)

It is a matter simply of clarifying this point, to bring the USPTO proposal into alignment with the current patent law. When this clarification is made, the design patent system will work more efficiently, helping attorneys obtain more effective design patents, and the global use of design patents will be improved. In hindsight, the *Daniels* case, quote in proposal Section III, gave us this message, when it said A[t]he leecher as an article of manufacture is clearly visible in the earlier design application@ *Emphasis Added*. One skilled in the art for the design must see clearly that the amended design claim is the same as the original application design claim.

VII. EXAMPLES B DESIGNS TO USE IN TEACHING THE ONE INVENTION LAW ANALYSIS

A. The FIRST example is based on the very important *Gorham* design patent, litigated in U. S. Supreme Court, *Gorham Co. v. White*, 81 US 511 (1871) The design patent drawing shows a utensil handle surface design with a central, prominent design at tthe lower end of the utensil where it is held. Other lines surrounding the latter design are of less visual design importance. If the original design application had the complete design as stated, and the application was amended to put the other (outside ones) in broken lines, a designer skilled in this art would recognize the distinctiveness of the handle center design and the amended application would be meet the written description requirement under U. S. design patent law, shown in the original application

B. The SECOND example is more difficult to analyze using the one invention law. In this design patent application drawing the utensil has the same central design described in the FIRST example, and the surface lines outside do not circle the central design. Instead they cross over it and spiral in several places, so that the overall appearance is one integrated design. In the amended application, the outside lines crossing the central design with the spiral features are now in broken lines, as are the spirals formed by these lines.

I apologize for my lack of a drawing to illustrate these features. The analysis of the amended design claim, by a person skilled in this design art would determine if the original application design was the clearly shown same in the amended design application, Was the amended design a distinct part of the original design? Of course it is impossible to answer the question without seeing the drawings, but the SECOND example gives us a way of applying the basic law principles that are clearly stated in the *Daniels* case. If the original design is not distinctly shown

in the amended application, the amended design drawing claims a different design that cannot be claimed in the original application. The inventor was not in possession of the amended design.

The SECOND example illustrates why it is recommended that the proposal be clarified, to add that one skilled in the art look for a distinct design, one that presents the same visual image as found in the original application. If the overall visual effect is not the same, by not claiming the features now in broken lines, the amended design cannot be claimed in the original application. On the other hand, if the visual effect of this change leaves the original image clearly shown, the amended design can be protected in the original application. This explanation is the best I can do in words.

Design law is crafted mainly to work on evaluating visual impressions. There is a trend, like it or not, to move to use of words to amend a design drawing claim, so the practice with this example is a good exercise. Design patent practice is becoming more like utility patent practice around the world.j

VIII. Other Suggestions

A. The USPTO may want to administer in a special way the refusal of an amendmen based on esign not being clearly shown in the amended application, or a loss of priority. The proposal already includes several safeguards. For example, an instruction to review the full file wrapper contents for evidence of what is claimed. A process similar to the one used in the USPTO restriction practice may allow the office to have a second review under certain circumstances, allowing additional perspectives to be discussed. before the rejection is made or final.

B. Some examples may be useful to included in the final proposal. The Design Group has been very effective in using this approach in presenting new proposals.

Thank you for your work on this important project ,and considering my comment. If there are any questions on my comments, please feel free to contact me.

Respectfully Submitted,

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