

June 14, 2016

The Honorable Michelle K. Lee  
Director of the United States Patent and Trademark Office  
The United States Patent and Trademark Office  
Commissioner for Patents  
Attn: Nicole D. Haines  
PO Box 1450  
Alexandria, VA 22313-1450

*DesignWrittenDescription2016@uspto.gov*

**Re: Comments on the Application of the Written Description Requirement to Specific Situations in Design Applications**

We, The Sun Products Corporation and Thule AB, together submit these comments in response to the US Patent and Trademark Office's request for comments on the application of the written description requirement to specific situations in design applications. The USPTO's request was issued April 15, 2016, in Federal Register Vol. 81, No. 73, p. 22233.

We recognize industrial design as crucial to success in today's market, and we rely on the protections afforded to our industrial designs through the USPTO. We regularly file design applications.

We write to encourage the USPTO not to adopt a new approach or issue new examination guidelines for evaluating written description under 35 USC § 112. The proposals advanced by the USPTO are unnecessary and would increase the cost of design patent prosecution. Instead of new approaches or new guidelines, we urge the USPTO to simply bring its examination practices in line with existing law and official guidance.

The USPTO in its request for comments has already articulated the current legal standard for evaluating design applications under the written description requirement. The requirement is satisfied where "the elements of [a] later-claimed design are visible in the original disclosure." The existing MPEP puts this into more easy-to-apply terms, making clear that any change from broken lines to solid lines or solid lines to broken lines is okay: "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.

This is the long-standing standard under which applicants have historically prepared and prosecuted patent applications. The standard is predictable and efficient. It allows applicants to file an initial design application with a single all-solid-line depiction of a designed article, and then to file continuation applications as appropriate to claim a subset of the originally disclosed design elements to separately protect various aspects of the design. There are many reasons why applicants do this including when certain features are used in the next generation of a product. The only way to protect those already disclosed novel features is to separately patent them in a continuation application.

Applicants have reasonably come to rely on this long standing practice because neither the law nor the most recent update of the MPEP put restrictions on applicants' freedom to "reduc[e] certain portions to broken lines or conver[t] broken line structure to solid lines." MPEP § 1504.04. Yet for the last few years and for no apparent reason, the USPTO has continued to propose—and even to unofficially apply—new standards for making rejections under 35 USC § 112 that impose such restrictions. Just the threat of these rejections has forced us to prepare new design applications differently to avoid them, unnecessarily increasing the cost of obtaining design protection. We ask that the Office make its written description examination practices consistent with the law and the existing guidance of the MPEP, which unambiguously allows applicants to change solid lines to broken lines or broken lines to solid lines without risk of a § 112 written description rejection. This would maintain the status quo, and would avoid imposing substantial cost increases to applicants that are not justifiable under the law.

We thank the USPTO for the opportunity to provide our comments.

Sincerely,

Lauren J. Mandell  
Assistant General Counsel, Intellectual Property  
**The Sun Products Corporation**  
60 Danbury Road  
Wilton, CT 06897

Niklas Kronborg  
Patent Manager  
**Thule AB**  
Fosievägen 13  
SE 214 31 Malmö, Sweden