

March 14, 2014

The Honorable Michelle K. Lee
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22313-1450

Via email: DesignRoundtable2014@uspto.gov

**Re: Response to “Request for Comments and Notice of Roundtable Event
on the Written Description Requirement for Design Applications”
79 Fed. Reg. 7171 (February 6, 2014)**

Dear Deputy Under Secretary Lee:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the United States Patent and Trademark Office (Office) Notice entitled “Request for Comments and Notice of Roundtable Event on the Written Description Requirement for Design Applications” as published in the February 6, 2014, issue of the Federal Register, 79 Fed. Reg. 7171 (hereinafter “Request”).

AIPLA is a national bar association with approximately 15,000 members who are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA represents a wide and diverse spectrum of individuals, whose companies and institutions are involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

The Request was published in part for the purpose of soliciting public comments concerning various topics related to the application of the written description requirement of 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph) (hereinafter collectively referred to as “35 U.S.C. 112(a)”) to design patent applications. The Request follows up on discussions held between the Office and members of the public during the Office’s Design Day 2013 with respect to the specific application of the written description requirement to designs where only a subset of elements of the original disclosure are shown using solid lines in an amendment or in a continuation application.

AIPLA opposes the framework described in the Request for determining whether an amended/continuation design claim, which contains a subset of elements disclosed in the application as filed (or in the priority application as filed), satisfies the written description

requirement of 35 U.S.C. §112. As more fully explained herein, AIPLA's position is that the use of the proposed framework will lead to continued uncertainty in examination and will unnecessarily increase the cost to applicants to procure U.S. design patent protection. In addition, we believe this framework will limit continuation practice and the ability to amend design patent claims during examination in a manner to an extent not justified by the current state of the law, and will cast a cloud over the validity of a substantial number of active U.S. design patents.

In the Request, the Office states that "in some rare situations ... a question may arise as to whether the applicant had possession of the newly claimed design at the time of filing the original application, where the design results from the applicant including only a subset of seemingly unrelated, originally disclosed elements in the claim by way of an amendment or continuation application." AIPLA's main concerns with the Office's position on this topic are two-fold:

- (1) there is likely to be inconsistent application by the Office of any established examination framework for amended and continuation design applications, which would introduce significant uncertainty into the examination process for applicants; and
- (2) this uncertainty, coupled with the additional efforts necessary for applicants to minimize the risks of losing a priority date for amended or continuation applications, would substantially increase the necessary size of design applications and/or costs of preparing same.

So long as this uncertainty is present, many applicants will necessarily file larger and more detailed design patent applications, thereby both significantly burdening the Office's examination corps and rendering design applications less accessible to independent and small inventors.

Our concern regarding inconsistent application of the proposed examination framework is rooted in the fact that determining what constitutes a "subset of seemingly unrelated, originally disclosed elements" (emphasis added) will be highly subjective and is likely to lead to written description rejections in a broader set of circumstances than is justified by the current Federal Circuit case law. In addition, it is unclear on the Request whether a determination that the amended claim constitutes a "subset of seemingly unrelated, originally disclosed elements" is a prerequisite to applying the factors. AIPLA believes that the Office should set forth a detailed threshold test for "unrelatedness" to be applied before any of the individual "factors" are considered.

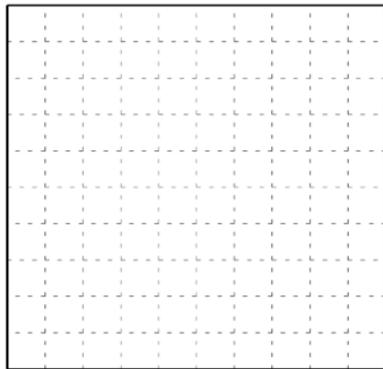
We are also concerned that an "unrelatedness" standard may represent an overly-broad interpretation of the particulars of the written description requirement, as it has been interpreted by the U.S. Court of Appeals for the Federal Circuit. We are not aware of any indication by the Federal Circuit, even in dicta, that the relative "relatedness" of the claimed elements plays any part in determining whether the written description standard is met in an amended claim.

AIPLA urges the Office to adopt the following Examination guideline as an alternative to the factors suggested in the Request:

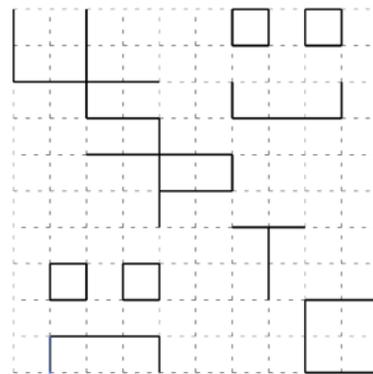
an amended claim that does not add subject matter to the original disclosure or remove subject matter claimed in the original disclosure satisfies the written description requirement unless the amended claim introduces a claimed element not “reasonably discernible” from the original disclosure.

For the purposes of the proposed standard articulated above, “removing subject matter claimed in the original disclosure” would mean to remove one or more solid lines that formed part of the claimed design as originally disclosed. Changing a solid line to a broken line or an unclaimed border would not be considered “removal.” In addition, the changing of any line present in the original disclosure (e.g. from claimed to environmental, from claimed to unclaimed border, from environmental to unclaimed border, etc.) would not represent adding subject matter.

Providing an exception to the general rule where a claimed element that is not “reasonably discernible” from the original disclosure would address situations in which the amendments introduce visual elements that were simply not visible in the original disclosure. The following is an example of an introduction of such elements.



ORIGINAL DRAWING



AMENDED DRAWING

In the amended drawing of this example, broken lines from the original disclosure have been converted to patterns of solid lines that form the visual elements (the word “USPTO”, a smiling face and a frowning face) that were clearly not “reasonably discernable” from the original disclosure.

The proposed examination guideline more closely comports with the legal standard set forth by the Federal Circuit, as best understood, than the “factor” analysis suggested in the Request. This proposal strikes a more appropriate balance between the legitimate right of applicants to protect claimed designs of differing scope on continuing applications and amend the scope of their

claims during examination, and the notice function that underlies the written description requirement.

Comments and Suggestions Regarding the Office’s Proposed “Factors in Determining Whether an Amended/Continuation Design Claim Satisfied the Written Description Requirement”

Factors Proposed by the Office

The Request sets forth five “and/or” “factors” that the Office proposes to use when determining whether an amended or continuation design claim satisfies the written description requirement of 35 U.S.C. 112(a). As set forth above, AIPLA does not support the use of these factors. If, however, the Office decides to proceed with their implementation, we offer the following comments.

AIPLA believes the term “factor” is a misnomer, in that any one of the numbered items, if satisfied, demonstrates that an adequate written description exists for the design claimed in the amended or continuation application. AIPLA thus prefers the term “basis (-es),” since any one of the proposed bases, if met, demonstrates independently and definitively that adequate written description is present. Said another way, if an Examiner determines, for example, that the claimed subset of elements of an amended application has a “common appearance,” then adequate written description definitively exists, and the Examiner need not consider any of the other “factors” and should be barred from setting forth arguments that the consideration of any of the additional “factor(s)” weighs against a finding of the presence of an adequate written description.

The factors proposed by the Office appear below with specific AIPLA comments in the accompanying bullet points:

- (1) The presence of a common theme among the subset of elements forming the newly identified design claim, such as a common appearance;
 - The Office has provided no guidance on how a “common theme” would be defined beyond a “common appearance,” or how “common appearance” itself would be interpreted.
 - Would different elements of a design that share the same or similar ornamentation, curvature, dimensions, or shape be considered to share a “common theme” in all cases?
 - Don’t all elements of a design that appear in an original application share a “common theme” by the very act of their inclusion together in a design patent application?
 - The Office should provide multiple examples of amended drawings that do and do not meet this factor in an update to the MPEP, with detailed explanations of the reasoning for their determination in each example.

- (2) the subset of elements forming the newly identified design claim share an operational and/or visual connection due to the nature of the particular article of manufacture (e.g., set of tail lights of an automobile);
- The Office has provided no guidance on how an “operational connection” or “visual connection” would be interpreted.
 - A consideration of the presence of an “operational connection” is conceptually distinct from a consideration of the presence of a “visual connection.” Therefore, these two factors should be separated such that the presence of either would demonstrate sufficient written description.
 - A consideration of “operational” connectivity between parts of an article of manufacture is conceptually distinct from a consideration of whether a subset of claimed design elements forms some cohesive or appreciable design that is some subset of the original design.
 - The Office should provide multiple examples of amended drawings that do and do not meet this factor in an update to the MPEP, with detailed explanations of the reasoning for their determination in each example.
- (3) the subset of elements forming the newly identified design claim is a self-contained design within the original design;
- The Office has provided no guidance on what would be considered a “self-contained” design within the original design.
 - Would this factor apply only if a clear visual distinction between parts is obvious to one of ordinary skill in the art?
 - The Office should provide multiple examples of amended drawings that do and do not meet this factor in an update to the MPEP, with detailed explanations of the reasoning for their determination in each example.
- (4) a fundamental relationship among the subset of elements forming the newly identified design claim is established by the context in which the elements appear; and/or
- The Office has provided no guidance on what would be considered a “fundamental relationship” between claimed elements.
 - This appears to be similar to the “operation connection” or “visual connection” factors, which as noted above should be separated.
 - The Office should provide multiple examples of amended drawings that do and do not meet this factor in an update to the MPEP, with detailed explanations of the reasoning for their determination in each example.

- (5) the subset of elements forming the newly identified design claim gives the same overall impression as the original design claim.
- The Office has provided no guidance on what they consider to constitute the “same overall impression” as the original design claim.
 - Under this factor, would it be always be permissible for an applicant to disclaim minor or “accessory” portions of an article of manufacture, for example fasteners, small holes, plugs, wires, ports/sockets, wheels, so long as the cumulative visual effect is that “not much” or “only small/minor elements” is disclaimed?
 - The Office should provide multiple examples of amended drawings that do and do not meet this factor in an update to the MPEP, with detailed explanations of the reasoning for their determination in each example.

The Initial Burden is on the Office to Show that None of the Proposed Factors is Satisfied

As in all cases examined by the Office for adequacy under 35 U.S.C. 112(a), the initial burden should always be on an Examiner to make a *prima facie* showing that none of these factors applies. “[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (C.C.P.A. 1976). An Examiner should only be permitted to set forth a rejection for lack of written description in an amended or continuation application if he or she provides a detailed explanation of why the claimed design fails to satisfy each of the proposed factors.

Suggestions for Additional Factor(s)

An additional factor that should be considered by the Office for adequacy with the written description is:

- (6) the subset of elements forming the newly-identified design claim forms a cohesive and identifiable partial design within the original design.

Comments Regarding Potential Mechanisms for Establishing Adequate Written Description Support in the Original Disclosure

In the Request, the Office has also sought comments on whether there are mechanisms that applicants can use to demonstrate that they had possession of designs claimed in future amendments or continuation applications at the time that an original design application is filed. AIPLA members have provided the following suggestions for mechanisms that can, if used appropriately, demonstrate in a meaningful way that applicants were in possession of designs claimed in later amendments or continuation applications at the time of filing of the original application:

- Providing a descriptive statement in the original application that specifically identifies elements of the article of manufacture (if necessary to identify the parts, labeled illustration(s) or photograph(s) of said article could be provided therewith) that, in various combinations, could comprise or constitute a later design claim;
- Including illustration(s) or photograph(s) of an article of manufacture including boundary line(s) that define possible claimed or unclaimed boundaries of additional design claims; or
- Including appendices of illustrations or photographs along with the original application that evidence additional design claims of which the applicant is in possession.

The concerns expressed by applicants with respect to the increased costs of preparing original design applications are primarily founded on the need to include these additional drawings and/or descriptive statements in original applications. It is the experience of AIPLA members that the costs associated with preparing design patent applications is doubled—and in some cases multiplied further—by the need to include additional sets of illustrations or to formulate and include a descriptive statement regarding other possible design claims at the time of filing of the original application.

Moreover, it is unclear what level of specificity would be required in any descriptive statement to avoid being considered a “generic boilerplate statement” in the opinion of the Office. For example, would clear identification of every conceivable element of an article, coupled with a descriptive statement to the effect that the “Applicant is in possession of additional designs that include the combinations of Element A and/or Element B and/or Element C ... and/or Element X” be adequate to meaningfully demonstrate that applicant was in possession of each of these additional combinations of elements at the time of filing of the original application? How will the Office consider such statements when the quantity of elements is high?¹

AIPLA requests that the Office provide specific examples, in an amendment to the MPEP, of descriptive statements that would adequately demonstrate possession, at the time of filing of an original application, of additional designs that are not fully illustrated in figures provided along with the initial filing. It is also unclear whether the absence of the mention of an element in a descriptive statement of this type could be used to bar an applicant from later arguing that said element should be permitted to be claimed in combination with one or more additional elements because the overall claimed design meets one of the factors proposed by the Office in the Request.

Additional Issues

Issuance of Ex Parte Quayle Actions in Design Applications in Which Priority Claim Denied

Several applicants have received Office actions under *Ex parte Quayle*, 453 O.G. 213, 25 USPQ 74 (Comm’r Pat 1935), for design applications where the Office has rejected a claim to an earlier

¹ In a design including just 10 separate elements, for example, in excess of 3.6 million different combinations of elements are possible, ignoring potential design claims in which only a portion of an individual element is claimed.

priority date or effective filing date based on an inadequate written description under 35 U.S.C. 112(a). The receipt of an *Ex parte Quayle* action severely limits an applicant's ability to address the underlying rejection. AIPLA recommends that, in design applications where an earlier priority date or effective filing date is denied for these reasons, the corresponding Office action should not close prosecution pursuant to the *Ex parte Quayle* holding.

The In re Owens Holding Should Be Read Narrowly

AIPLA's position is that the holding of *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013) ("*Owens*") should be read narrowly. The holding of *Owens* addressed the narrow factual scenario in which an unclaimed border was added in a continuation application in a location where no line was present in the original disclosure. *Owens* did not involve a set of facts in which a line or element that was present in an original application was disclaimed in an amendment or continuation application.

Therefore, the Office should not expand the holding of *Owens* to factual scenarios in which a line or element that was present in an original disclosure is disclaimed in an amendment or continuation application. The latter practice remains permissible post-*Owens*, and consideration of the *Owens* holding by the Office should be limited to the rare factual scenario present in that case.

The In re DiLeone Holding is Inapposite to Design Applications

During the Design Day 2013 presentation given by an Office design practice specialist, a slide was presented including the following quote from *In re DiLeone*: "[I]t is possible for a specification to enable the practice of an invention as broadly as it is claimed, and still not describe that invention." 436 F.2d 1404, 1405, 168 USPQ 592, 593 (C.C.P.A. 1971) ("*DiLeone*"). This quote—along with some visual examples of amended designs that were allegedly "disclosed but not described" by an original filing—was provided to support the Office's position that some amended or continuation designs could be enabled by an original design application, yet still lack adequate written description therein.

The issue in *DiLeone* was whether a broad claim encompassing two entire genera of chemical compounds adequately described the compounds available within the genera where there was no evidence that one of skill in the art could select a chemical compound from one of said genera. The chemical field is complex and subject to a much greater degree of uncertainty with respect to the interchangeability of elements than is a design application, in which all of the elements of the design are present and apparent at the time of filing of an original application. The context in which the *DiLeone* court considered the requirements of 35 U.S.C. 112(a) is not pertinent to the context of examination of a design application.²

² It is worth noting that the *DiLeone* court reversed the examiner and the Office's Board of Appeals in finding that the illustrative examples of compounds provided in the specification of the application thereof did not limit the scope of the claim, and provided adequate written description for the entire claimed genera of chemical compounds.

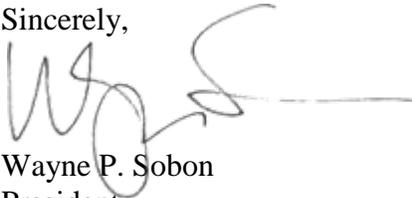
Harmonizing Treatment of GUI Design Applications

Presently, design applications for the ornamental designs of graphical user interfaces (“GUIs”) are examined differently than applications for the ornamental designs of other articles of manufacture, in that no amendment to the drawings for a GUI design are permitted under any circumstances. Because there is no qualitative difference between designs for GUIs and designs for other articles of manufacture, AIPLA submits that, for purposes of predictability and uniformity, design applications for GUIs should be examined under the same framework as applications for other articles.

* * *

AIPLA appreciates the opportunity to provide these comments in response to the Request, and to assist in establishing reasonable guidelines for examination of design applications with respect to the written description requirement. AIPLA looks forward to further dialogue with the Office in identifying difficulties and finding solutions with respect to the implementation of any examination guidelines relating to this topic.

Sincerely,

A handwritten signature in black ink, appearing to read 'Wayne P. Sobon', with a long horizontal line extending to the right.

Wayne P. Sobon

President

American Intellectual Property Law Association