

March 13, 2014

**By E-Mail Only**

Comments-Patents

Attn: Ms. Nicole Dretar Haines

Commissioner for Patents

P.O. Box 1450

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**Re: Comments of North Star Intellectual Property Law, P.C. to the February 6, 2014 Request for Comments and Notice of Roundtable Event and the Written Description Requirement for Design Applications**

Dear Ms. Haines:

The following are the comments of the North Star Intellectual Property Law, P.C. (“Firm”) that are being submitted in response to the Request for Comments and Notice of Roundtable Event on the Written Description Requirement for Design Applications that was published in the Federal Register by the U.S. Patent and Trademark Office (“PTO”) on February 6, 2014 (“the Notice”).

In the Notice, the PTO published several topics for written comments and discussion at the Roundtable event. In particular, the PTO seeks comment on the application of the written description requirement where only a subset of elements of the original disclosure of the claimed design are shown using solid lines in an amendment or in a continuation application.

In order to determine whether such a design application conforms with the written description requirement of 35 U.S.C. 112(a), the PTO has proposed that design examiners consider five (5) factors in the “rare situation” where there is a question as to whether an amended/continuation design claim of this type satisfies the written description requirement.

As an initial matter, this Firm notes that the situations under which the design examiners will reject a pending design claim for failure to meet the requirements of, for example, a claim of domestic priority under 35 U.S.C. 120 (which incorporates the written description requirement of 35 U.S.C. 112(a)) are hardly “rare,” as several examiners have routinely imposed such rejections against our clients’ pending applications, when they are continuations of earlier filed U.S. design applications.

In any event, we respectfully suggest that the Notice fails to provide any definition or guidance of what would constitute the “rare situation” contemplated by the PTO. Such an assessment would presumably be made by the same examiners who have routinely rejected design applications of this type for failure to provide a proper antecedent written description.

Moreover, this Firm is not aware of any case law, statutory provision or regulation that indicates or suggests that design applications which include only a subset of the originally disclosed design elements should be examined using a special set of standards or factors that are not used to examine utility and design patents in general. Neither Congress, the Federal Courts nor the Board of Appeals and Interferences has found that such applications require special treatment, beyond the legal standards that those bodies have already promulgated for the written description requirement, which apply equally to both utility and design applications, regardless of type.

Nor do those legal authorities support further limiting the instances where design applications claiming a subset of design features are allowable, and may claim an earlier effective filing date. Therefore, we respectfully submit that there is no precedent that would suggest that the factors proposed by the PTO would be permissible, relevant, or even helpful, to determine whether these types of design applications would meet the written description requirement.

In fact, such limiting factors seem to run directly contrary to the Federal Circuit's controlling decision in *Racing Strollers, Inc. v. Tri Industries, Inc.*, 878 F.2d 1418, 1420 (Fed. Cir. 1989):

In the case of an "ornamental design for an article of manufacture," with which we are here concerned, the patenting of which is provided for in 35 USC § 171, the "best mode" requirement of the first paragraph of § 112 is not applicable, as a design has only one "mode" and it can be described only by illustrations showing what it looks like (though some added description in words may be useful to explain the illustrations). ***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:***

The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

(Emphasis added) Therefore, the Federal Circuit has presented a broad, permissive statement of what is required in order to meet the written description requirement in the case of design applications involving amendments or continuations.

In spite of this, the PTO now proposes to exclude from compliance with the written description requirement those design applications that do not present factual circumstances that fall within one of the proposed five factors. This would apparently be so, regardless of whether there is an identifiable written description of the design features in question in an earlier design or utility application from which that design application claims priority or an earlier effective filing date that shows that the applicant already had possession of those design features. In doing so, the PTO proposes to deprive affected design applicants of the benefit of at least 35 U.S.C. 120, which the Federal Circuit in *Racing Strollers* explicitly held the PTO cannot do:

In our view, Section 120 gives to any applicant for a patent *complying with its terms* the right to have the benefit of the filing date of an earlier application. The language is mandatory: “An application for patent ... shall have the same effect as though filed on the date of the prior application.”

878 F.2d at 1421.

If adopted, we respectfully suggest that the five (5) factors that the PTO proposes would be contrary to the Federal Circuit’s holding in *Racing Strollers*. As a practical matter, those factors would also be unworkable, and would inject needless subjectivity and arbitrariness into the written description analysis in design applications of this type. This would undoubtedly result in costly and time consuming disputes between applicants and design examiners over compliance with the written description requirement, and would undoubtedly result in equally costly and time consuming litigation of final rejections of such design applications to the Board and the Federal Circuit over whether the five (5) factors are proper, and if so, whether they are met in a particular instance.

In particular, with respect to Factor No. 1, nowhere is the term “common theme” defined, nor is any guidance provided regarding what would be sufficient to establish that a common theme is present between the earlier design application, and the subset of design features that are claimed in the design application in question. This “standard” is too vague, and would invest too much discretion in design examiners to define for themselves what a “common theme” is.

With respect to Factor No. 2, the operative term “share an operational and/or visual connection due to the nature of the particular article of manufacture” appears to be arbitrary, given the fact that neither Section 112(a), nor the applicable case law identifies this factor as being relevant to whether a design application meets the written description requirement. In addition, this factor supplants the judgment of the applicant with the judgment of the examiner concerning what combinations of design elements should be part of a proper continuation application that defines the applicant’s valuable property rights. Moreover, the term “visual connection” appears vague, and unduly subjective, and the PTO provides no guidance regarding when and how this factor would be met.

The same definitional, subjectivity, arbitrariness and workability concerns are also implicated by the “self-contained design within the original design” language of Factor No. 3, the “fundamental relationship” language of Factor No. 4 and “the same overall visual impression” language of Factor No. 5.

In any event, there is already a developed body of case law from the Federal Circuit and the Board which define the legal standards –applicable equally to design and utility patent applications - that are to be applied to determine whether a design application meets the written description requirement. Nowhere in the notice does the PTO articulate a reason why those legal standards are inadequate to the task, assuming the PTO is even empowered to depart from them or narrow their applicability, as they propose to do with the five (5) factors.

Since its inception, the Court of Appeals for the Federal Circuit has frequently addressed the "written description" requirement of § 112. A fairly uniform standard for determining compliance with the "written description" requirement has been maintained throughout: "Although [the applicant] does not have to describe exactly the subject matter claimed, . . . the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991) (quoting *In re Gosteli*, 872 F.2d 1008, 1012, 10 U.S.P.Q.2d (BNA) 1614, 1618 (Fed. Cir. 1989) (citations omitted)). "The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 U.S.P.Q. (BNA) 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 U.S.P.Q. (BNA) 1089, 1096 (Fed. Cir. 1983)).

More recently, in *In re Daniels*, the Federal Circuit provided an analytical framework for determining whether a continuation design patent application found sufficient written description support in a parent design patent application:

The inquiry is simply to determine whether the inventor had possession at the earlier date of what was claimed at the later date.

The leecher as an article of manufacture is clearly visible in the earlier design [\*1457] application, demonstrating to the artisan viewing that application that Mr. Daniels had possession at that time of the later claimed design of that article; [citations omitted] and other guides to application of § 112 P1 to § 120. The leaf ornamentation did not obscure the design of the leecher, all details of which are visible in the drawings of the earlier application. The leaf design is a mere indicium that does not override the underlying design. The subject matter of the later application is common to that of the earlier application. See *Transco*, 38 F.3d at 557, 32 U.S.P.Q.2D (BNA) at 1081. In the context of 35 U.S.C. § 171 ("design for an article of manufacture" is the subject matter of a design patent), it is apparent that the earlier application contains a description of what is claimed in the later application. See *In re Gosteli*, 872 F.2d at 1012, 10 U.S.P.Q.2D (BNA) at 1618.

*In re Daniels*, 144 F.3d 1452, 1456-57 (Fed. Cir. 1998).

Most recently, in *In re Owens*, the Federal Circuit discussed the instances where changes in the size, shape, configuration or appearance of a design through the addition of a new broken line border may constitute the introduction of new matter that was not supported by a prior written description. For those circumstances, the Federal Circuit provided this guidance:

In our view, the best advice for future applicants was presented in the PTO's [\*1369] brief, which argued that unclaimed boundary lines typically should satisfy the written description requirement only if they make explicit a boundary that already exists, but was unclaimed, in the original disclosure. Although counsel for the PTO conceded at oral argument that he could not reconcile all past allowances under this standard, he maintained that all future applications will be evaluated according to it.



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*In re Owens*, 710 F.3d 1362, 1369 (Fed. Cir. 2013). None of these or any other court precedents suggest special treatment or additional limitations on the instances in which applicants may claim subsets of design features that were disclosed in prior applications, as long as that disclosure of the subset of design features in the prior application shows that the applicant had possession of them. The factors that the PTO proposes do not address this essential written description inquiry, and therefore should not be adopted.

As a result, we respectfully suggest that the PTO instead review these and other relevant precedents and legal authorities addressing the written description requirement, and instead focus its efforts on training the design examining corps. to understand and consistently apply them to the examination of design patent applications.

Thank you very much for your consideration of our comments. We stand ready to answer any question that you may have and to provide any further information that you would deem helpful on this issue.

Best regards,

A handwritten signature in blue ink that reads "Charles Y. Park". The signature is fluid and cursive, with the first and last names being the most prominent.

Charles Y. Park

Partner

North Star Intellectual Property Law, P.C.