

March 14, 2014

The Honorable Margaret Focarino
Commissioner for Patents of the United States Patent and Trademark Office
600 Dulany Street
P.O. Box 1450
Alexandria, VA 22313
via email: designroundtable2014@uspto.gov

**Re: Comments in response to USPTO's Request for Comments on the
Written Description Requirement for Design Applications, Fed. Reg.
Vol. 79, No. 25 (February 6, 2014)**

Dear Commissioner Focarino:

We are attorneys with Sterne Kessler Goldstein & Fox, an intellectual property law firm located in Washington, DC. Sterne Kessler has more than 160 IP and business professionals. For more than 30 years Sterne Kessler has helped companies strategize, build, license, leverage and enforce IP rights worldwide.

Last year alone, our law firm filed more than 350 US Design patent applications for various companies and individuals. Our firm has been on the planning committee for USPTO Design Day since its inception 7 years ago.

**The perceived problem of assessing possession under § 112 was created by
the Office's new standards for evaluating possession, announced at
Design Day 2013**

We are active in the Design patent bar, and speak regularly with other design patent practitioners and design patent Examiners about the law and best practices. Before Design Day 2013, we heard no mention from examiners or practitioners that examiners were having difficulty assessing whether an applicant had possession of a design at the time of filing, when the design included only a subset of so-called "seemingly unrelated" originally-disclosed elements—the description of the issue to be addressed according to the Federal Register notice. In fact, our experience has been that practitioners and examiners were surprised that the issue was raised at Design Day and

that they too were not aware of such difficulty. Thus, any difficulty, if it now exists, was created by the Office's policy change announced at Design Day 2013, and the guidelines proposed will not solve it.

The Federal Register Notice that this letter responds to refers to the problem arising in "rare" situations. In our experience, that was correct before Design Day 2013, when we rarely—if ever—received a rejection when a claim was introduced by amendment or in a continuation that used broken lines to claim less than the original disclosure. However, in our experience since Design Day 2013, the Office is prohibiting such a claim nearly every time one is presented. This leads us to conclude that Examiners were well capable of evaluating this issue before Design Day, but have since been prompted to prohibit such amendment as a matter of course, whether or not there is any uncertainty about written description support for the claim.

Since Design Day 2013, such a claim has been prohibited in more than a dozen cases being prosecuted by our firm. Our firm's total substantive office actions in design patent applications during that period numbered 84. This is not "rare." Before Design Day, however, it truly was rare.

Quayle actions should not be used to object to a priority claim

Further, when a claim is presented in a continuation, whether originally or by amendment, that uses broken lines to claim less than in the parent application, examiners are now objecting to the continuation's priority claim to the parent in a *Quayle* action, closing prosecution. This is entirely inappropriate for several reasons.

First—*Quayle* actions should be reserved for formal matters only. In requiring Applicants to acquiesce to a change in the very basis upon which an application stands—its priority—the Office unjustifiably extends the *Quayle* doctrine far beyond its proper limited application to correction of trivial formal matters. The determination as to whether an application is entitled to priority under § 120 incorporates the provisions of § 112 and is squarely substantive—it depends on how one of skill in the art would understand the original disclosure. Objecting to it as a mere "formality" denigrates the statute and the perspective of one of skill in the art.

Second—once prosecution is closed, the applicant has no opportunity to make the case that their claim is supported in the parent. Since the

perspective of one of skill in the art directly bears on the question of priority under § 120, the Office should not procedurally bar applicants from supporting their priority claim or one of skill in the art from providing an opinion on the matter. This issue should be decided on its merits, rather than through procedural use of an *Ex Parte Quayle* action closing prosecution. What use are guidelines if applicants have no opportunity to explain that their claim meets them?

Also, because objections are petition-able, not appealable, this procedure by the Office inappropriately prevents applicants from appealing to the board what is effectively a denial of priority under section 120 based on perceived new matter under § 112. These are squarely statutory issues. The result will be unjustified additional cost to applicants to file a CPA application to respond to what should have been a rejection made in a substantive Office Action

Why are these guidelines necessary and what problem is the Office really trying to solve?

We are aware of no case in which an issued design patent was challenged on the basis of inadequate written description and was found lacking. Clearly design patent examiners have been doing a good job and getting it right when presented with this situation.

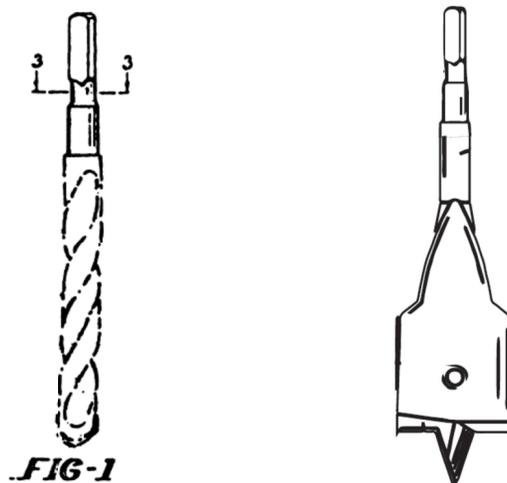
During the roundtable held by the Office on March 5 to discuss this issue, Office personnel intimated that they intend by these guidelines to inhibit an applicant from using broken lines to obtain a claim that would read on a competitor's product, where the competitor's product as a whole has a different appearance than an applicant's originally-disclosed design.

This is not the first time the Office has argued against allowing an applicant to use broken lines to claim only a portion of an article, on the basis that this technique can be used to cover articles having potentially different overall appearances than the full article disclosed. Over three decades ago the Office asked the Court of Customs and Patent Appeals to disallow claiming only a portion of an article for this very reason. *In re Zahn*, 617 F.2d 261, 265-67 (CCPA 1980).

The *Zahn* court roundly rejected the idea that an applicant could not use broken lines to claim a design for less than an entire article of manufacture.

In doing so, the court recognized the Office's concerns that such a technique "would cover all sorts of undisclosed drill tool appearances ... no matter what the effect on the appearance of the drill tool as a whole would be," but dismissed the Office's concerns as having no basis in the controlling legislation, then—as now—§ 112. *Id.* at 266–67.

Thus, the courts have *explicitly approved* of the result the Office is trying to prevent. Zahn's design, shown below left, may very well cover the exemplary article shown below right, regardless of their differences in appearance as a whole. And that is the legally correct outcome according to judicial and legislative precedent.



Using broken lines is permitted by statute and by the courts. Seeking to prevent applicants from possibly obtaining a patent which could be infringed by a product that is not identical to or even similar to the patentee's product should not be a concern of the Office or a basis for changing the Office's policies regarding possession under § 112.

The proposed guidelines have no judicial or legislative support

The ability to broaden claim scope to protect an applicant's invention is a celebrated virtue of our patent system, and the Office provides no legal basis for abrogating this ability with its proposed guidelines. The 5 factors mentioned in the proposed guidelines come from no legal opinion or legislative body. The language used in the guidelines, like “seemingly unrelated,” “common theme,” and “fundamental relationship” have never been discussed in any legal opinion we are aware of.

Furthermore, there is no basis to conclude that meeting any of the 5 proposed factors would prove that a claim satisfies the written description requirement. Section 112 explains that written description is satisfied when a person of ordinary skill in the art can make and use the invention. The 5 factors identified by the Patent Office in no way relate to whether or not a person of ordinary skill could make and use the design as claimed. Instead the factors focus on individual features of the design, not the design as a whole, which is not in accordance with § 112.

The proposed guidelines have practical disadvantages that outweigh any potential benefit

In addition to the guidelines not being supported in the law, there are clear disadvantages to having them. In practice they will quickly cease to become mere “factors” that are considered along with other aspects of the design and will instead become a litmus test for examiners. If none of these 5 factors are met, the examiners may refuse to consider other “factors” because the guidelines don’t include them. This wrongly removes the perspective of one of skill in the art from the analysis, and is a slippery slope that the Office should avoid.

Descriptive statements as proposed do not belong in design applications

Finally, the Federal Register notice also asked “whether use of a descriptive statement in the original application which identifies in words different combinations of elements that form additional disclosed designs could be a meaningful way to demonstrate possession for future amendments or continuation claims.” This is not a good alternative and should not be suggested or encouraged. It will without doubt encourage applicants to file lengthy written specifications in an attempt to capture every conceivable permutation of their design, turning design applications effectively into utility applications.

This is not something the Patent Office should welcome or invite as it will surely cause delay in examination as examiners pore over these lengthy written specifications to determine if the claimed permutation has been precisely described. Surely this would be more complicated and prone to greater error than the current practice of merely comparing drawings and concluding whether the feature now being unclaimed was disclosed in the

original application. It would also impose undue burdens and delays on applicants who must then prepare these lengthy specifications in order to protect their legitimate inventions.

The Office should revert to pre-Design-Day-2013 practice

The Office should take measures to un-do the damage done by the change in practice implemented after Design Day 2013. Before this change the Office operated under longstanding and supportable principles when evaluating possession under § 112. Conclusions by examiners on this issue were fair and consistent, and made from the proper legal perspective of one of skill in the art. A good first step in un-doing this damage is for the Office to again trust examiners to use the same careful consideration and expertise that they did before Design Day 2013, instead of foisting unnecessary guidelines upon them that will undoubtedly engender confusion and inconsistent results.

Respectfully submitted,

/Tracy Durkin/

Tracy-Gene G. Durkin, Reg. No. 32,831
Director, Mechanical and Design Practice
Group Leader, Sterne Kessler

/Daniel A. Gajewski/

Daniel A. Gajewski, Reg. No. 64,515
Associate, Sterne Kessler

1100 New York Avenue
Washington, D.C. 20005-3934
(202) 371-2600

The views expressed herein are our own and are not to be attributed to any other person or entity including Sterne, Kessler, Goldstein & Fox P.L.L.C., or any client of the firm.

1823207