

United States Patent and Trademark Office

March 3, 2014

Subject: Re: DESIGN ROUNDTABLE 2014

I appreciate the opportunity to comment on the written description requirement as applied to design applications in certain limited situations.

Should The USPTO change rules for design patent application in regard to what constitutes a proper amendment to the claim that satisfies the written description requirements of 112 (a) in view of the decision in re Owens (Fed. Cir. 2013)

The drawings of an item in a design application must show the claimed design in solid line. If the same drawings are refiled in a continuation application and most of the previously claimed design is unclaimed, (converted to broken line) in my opinion the item claimed in the amended drawings is not the same item as in the originally filed drawings. The scope of the originally filed claim is changed. In re Owens, the original drawings claim a bottle; the amended drawings claim a small piece of a bottle. The small area claimed in the amended drawings is a surface, a shape, and does not even qualify as an object. If you only want to claim a shape, it seems to me that you would be better served to file a trademark application.

Generally, you are not allowed to correct drawings unless you can do so without adding new matter. New matter is anything that is added to, or removed from, the claim, drawings or specification, that was not in the original application. The amended drawings in re Owens have removed/unclaimed most of the design.

Since broken lines in design drawings have no value when it comes to claims, what is the point of using them at all? Broken lines of unclaimed areas can be used constructively to indicate environment. For instance if you are filing an application for a new fan blade, figure 1 or the last figure can show the fan in broken line to indicate where the blade is situated. All other figures should show the blade only. Another example is an application for a hubcap; no need to show wheel or car, other than in one figure to indicate environment.

Most countries do not allow the use of broken lines in the manner that they were used in re Owens, nor should the USPTO.

The USPTO is moving towards harmonizing patent standards. Many rules for patent drawings have already been revised to correspond with those of the European Patent Office (EPO) and the World Intellectual Property Organization (WIPO). The change been considered would assist in the convergence of USPTO, EPO and world standards.

Respectfully Submitted
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