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Remarks of Cooper C. Woodring, FIDSA
Representing the Industrial Designers Society of America

I'm Cooper Woodring. I'm not a lawyer; I'm an industrial designer and a past president of IDSA, the Industrial Designers Society of America, one of the sponsors of DesignDay, and I have a couple dozen patents. I represent IDSA's thousands of industrial designers, both corporate and consultant.

Good design is no longer a luxury or a novelty; it's a necessity. So too is good design protection a necessity. Many nations, such as South Korea, consider their industrial designers to be a national resource and a competitive weapon in the global marketplace. America needs good design patent rules to stop infringing copycats, for if we can't stop the copycats, investment in good design will diminish or even evaporate.

The question of whether a child-patent's particular combination of visual features is disclosed and described in the parent-patent's drawings is critical to our ability to stop copycats. Let me explain the position of the industrial design community.

First, asking a designer if he was in possession of various combinations of features of his design is like asking an author if he was in possession of various combinations of sentences in his manuscript. In both cases, nothing was added, something was deleted, and what remained, existed in the original.

As one skilled in the art, when we design the overall appearance of an article of manufacture, we are in possession of all possible combinations of the visual features. How do we know that? We know that because we created the design's overall appearance; we created each and every individual feature of the design; and we created the size, shape, location, character and relationship among the various individual features of the design, hence we were in possession of all combinations of features shown in the parent-patent's drawings.

During the design process, every visual feature is evaluated relative to every other visual feature. This evaluation of each individual feature relative to all other features is not a formal, structured and recorded process; it is a conscious process so common to designers that it is intuitive. This basic design methodology assures that the resultant design will be easier for a consumer to understand and use because evaluating the design's various features is how we establish the desired visual importance or hierarchy among the features, and is further proof that we had possession of all later combination of features.

Additional Written Remarks of Cooper C. Woodring, FIDSA Representing the Industrial Designers Society of America

After attending the roundtable I gained a better understanding of the problem as it was explained. As a result, I would like to add brief additional comments to my earlier submitted written comments.

As the problem was explained, I came to understand that the PTO feels that some continuing design patent applications “push the envelope” or “step over the line”, and are in effect taking advantage of, or manipulating, the design patent system, and are “just playing gamesmanship”, which the PTO views as improper. Now, I can better understand why the PTO is seeking new rules and procedures to curtail these practices.

Better understanding the stated problem leads me to believe that it is well intended, but misguided. Let me explain.

The attorney filing the continuing application in behalf of, for example, the market leader, is not the “bad guy”. The “bad guy” is the copycat who is “playing gamesmanship” by manipulating the patent system to steal the heart and soul of the market leader’s patented design while avoiding infringement by changing several minor features.

One look at the copycat’s design and everyone knows they copied the market leader’s patented design. The only question to be resolved is, can the real “bad guy” get away with it. And, the answer is, “Yes, they probably can”.

The market leader now calls their patent attorney and asks, “Isn’t there some way we can stop this copycat; they’re killing us”. The attorney says, “Yes; we can file a continuation application disclaiming the several minor features that the copycat changed, and then we can nail them in court”.

The PTO has identified the market leader’s attorney as the “bad guy” for “playing gamesmanship” when the real “bad guy” is the knock-off artist and his clever attorney who are legally ripping the heart and soul out of the market leader’s original award winning design that they spent years endless dollars creating.

Eliminating or reducing our ability to file continuing applications to stop copycats is not good for strong design protection, not good for investment in good design, and not good for United States’ balance of trade, but it’s great for copycats.

The PTO is, after all, part of the Department of Commerce, and I would hope their policies would be weighed with an eye toward what is best for United States’ commerce.

If the PTO adopts this proposed rule, you will be requiring the design examiners to determine that *this* combination of features is patentable, but *that* combination of features is not patentable. And, that determination will be made in accordance with one or more of the five factors. This practice will be difficult to apply consistently, but what's worse, it gives copycats a powerful new weapon with which to avoid infringement, namely invalidity. The copycats will claim that *that* specific combination of features should not have been patentable for one or all of the reasons described in the five factors. Your Notice in the Federal Register states that the factors would be considered "only in some rare situations". While you may use the proposed new rule infrequently, infringers won't. They will challenge the validity of virtually every issued child-patent asserted against them, all based on your five fuzzy factors. We think it best not to put the design examiners in the position of having to be mind readers in trying to determine what was in the mind of the designer when the earlier application was made.

Regarding the illustrative examples, one concern with, for example, Factor No. 2, the telescope, is the design examiner will be charged with determining if the three claimed visual features of this complex design share an "operational connection" like aligning. This will require the design examiners' to have a full understanding of how complex products *operate*, even though design patents don't protect how product designs *operate*, they only protect how they *look*.

Another concern, in Factor No. 5, the ice skate, the factor states, "the *blade* can be part of any design recognized within the whole ice skate". It doesn't state why the visual feature of the blade has some status different from other visual features, but presumably it is because all ice skates must have a blade, while the same cannot be said for the eyelets, for example, as not all ice skates must have eyelets. This will require the design examiner to determine which visual features of a design *are* required and which *are not* required, while a feature that is required today, may not be required tomorrow. An example is QWERTY keyboards on smartphones. Mistakenly determining that a feature was or was not required in the design opens yet another invalidity floodgate for copycats.

Today's standard that any child-patent's combination of visual features is patentable if disclosed and described in the parent-patent's drawings is a time honored, non-subjective, clean test. Replacing it with a subjective, fuzzy, multi-factored test weakens design patent protection and aids copycats in escaping infringement.

I am opposed to this cumbersome and unnecessary new rule, as is the industrial design community, as it weakens design patent protection, which will weaken investment in good design, which will weaken America's balance of trade.