



March 14, 2014

The Honorable Margaret Focarino
Commissioner for Patents
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 “Request for Comments and Notice of Roundtable Event on the Written Description Requirement for Design Applications” Fed. Reg. Vol. 79, No. 25 (February 6, 2014)

Dear Commissioner Focarino:

Intellectual Property Owners Association (IPO) appreciates the opportunity to submit comments on whether in “rare situations” it would be “useful for design examiners to consider certain factors for determining whether an amended/continuation design claim satisfies the written description requirement of 35 U.S.C. §112.”

IPO is a trade association representing owners of patents, trademarks, copyrights, and trade secrets. IPO’s membership includes over 200 member companies and more than 12,500 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO serves intellectual property owners in all industries and across all fields of technology. IPO looks forward to further opportunities to participate in public discussion on these and other issues.

The proposed multi-factored approach is unnecessary given (1) the rare nature of the problem as explained by the USPTO, (2) existing Federal Circuit precedent on §112 as applied to design patents, and (3) the potential for uncertainty, inefficiencies, and inconsistencies that could result if the proposed approach was implemented. Our comments are below.

1. An *En Banc* Federal Circuit Opinion Has Adequately Addressed 35 U.S.C. §112 in the Context of Design Patents, Rendering the Proposed Multi-Factored Analysis Unnecessary

The *en banc* Federal Circuit in *Racing Strollers*, succinctly stated:

“As a practical matter, meeting the ... 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 formally claimed].

President
Philip S. Johnson
Johnson & Johnson

Vice President
Carl B. Horton
General Electric Co.

Treasurer
Lisa Jorgenson
STMicroelectronics, Inc.

Directors
Edward Blocker
Koninklijke Philips N.V.
Tina M. Chappell
Intel Corp.
William J. Coughlin
Ford Global Technologies LLC
Robert DeBerardine
Sanofi-Aventis
Anthony DiBartolomeo
SAP AG
Louis Foreman
Enventys
Scott M. Frank
AT&T
Darryl P. Fricke
Dow Chemical Co.
Roger Gobrogge
Rolls-Royce Corp.
Krish Gupta
EMC Corporation
Horacio Gutierrez
Microsoft Corp.
Jennifer Hall
Mars Incorporated
Alan W. Hammond
Life Technologies Corp.
Dennis R. Hoerner, Jr.
Monsanto Co.
Michael Jaro
Medtronic, Inc.
Charles M. Kinzig
GlaxoSmithKline
Christopher H. Kirkman
The Travelers Companies, Inc.
David J. Koris
Shell International B.V.
Allen Lo
Google Inc.
Timothy F. Loomis
Qualcomm, Inc.
Steven W. Miller
Procter & Gamble Co.
Douglas K. Norman
Eli Lilly and Co.
Elizabeth A. O'Brien
Covidien
Sean O'Brien
United Technologies, Corp.
Salvatore Pace
Praxair, Inc.
Richard F. Phillips
Exxon Mobil Corp.
Dana Rao
Adobe Systems Inc.
Kevin H. Rhodes
3M Innovative Properties Co.
Mark L. Rodgers
Air Products & Chemicals, Inc.
Curtis Rose
Hewlett-Packard Co.
Matthew Sarboraria
Oracle USA, Inc.
Manny Schecter
IBM, Corp.
Steven Shapiro
Pitney Bowes Inc.
Dennis C. Skarvan
Caterpillar Inc.
Russ Slifer
Micron Technology, Inc.
Terri H. Smith
Motorola Solutions, Inc.
Daniel J. Staudt
Siemens Corp.
Brian K. Stierwalt
ConocoPhillips
Thierry Sueur
Air Liquide
James J. Trussell
BP America, Inc.
Roy Waldron
Pfizer, Inc.
Michael Walker
DuPont
BJ Watrous
Apple Inc.
Stuart Watt
Amgen, Inc.
Paul D. Yasger
Abbott Laboratories
Mike Young
Roche Inc.

General Counsel
Michael D. Nolan
Milbank Tweed

Executive Director
Herbert C. Wamsley

[*Racing Strollers, Inc. v. Tri Indus., Inc.*, 878 F.2d 1418, 1420 \(Fed. Cir. 1989\)](#). The Federal Circuit precedent sets forth a simple visual test for determining §112 compliance: Is the design “depicted” in the earlier illustrations? (Visual Depiction Test).¹

In contrast, the proposed multi-factored analysis delves beyond the illustrations, making additional/subjective determinations, including, *inter alia*, whether the parent/child share a “common theme,” “common appearance,” “fundamental relationship,” or an “operational and/or visual connection,” and whether the amended/child design is a “self-contained design.” The proposed analysis risks contravening the Federal Circuit’s Visual Depiction Test.

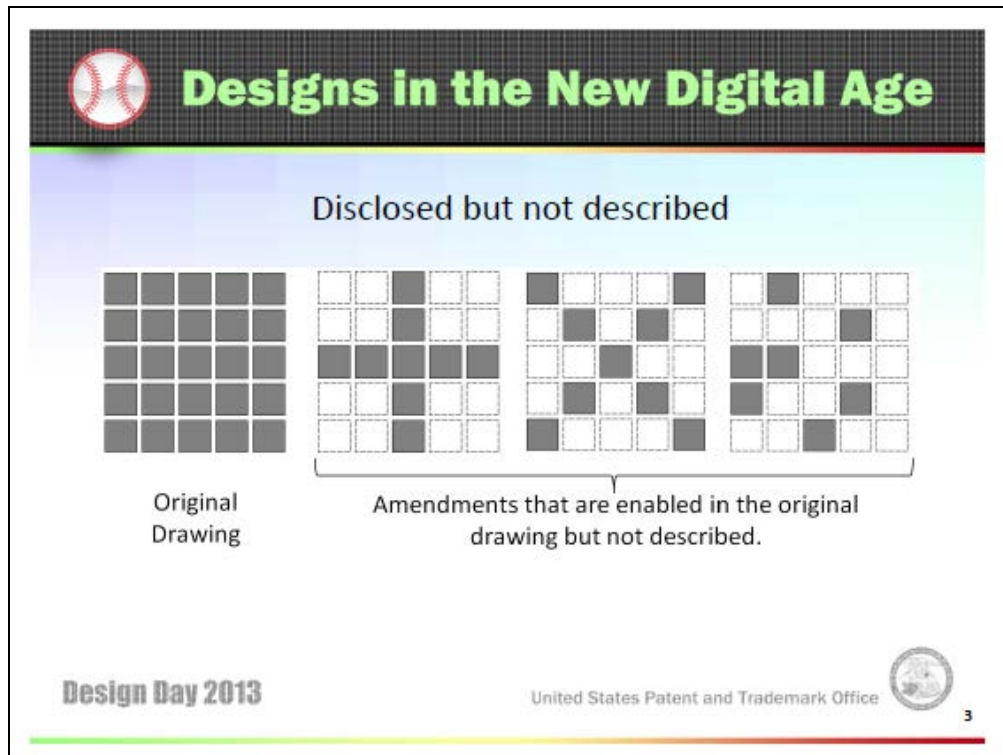
Consistent with *Racing Strollers*, §112 description/disclosure requirements are satisfied where the claimed design in the amendment/child is depicted in the illustrations of the parent/initial filing. For example, as long as the solid lines that comprise a amended/child design are depicted in the subset of broken/solid lines in the parent/initial filing drawings, the §112 description/disclosure requirements are satisfied. *Racing Stroller’s* simple and practical Visual Depiction Test provides a workable objective rule that applicants and examiners can rely upon; it yields reasonably certain, consistent, and just results. IPO recommends that the USPTO continue to follow the Federal Circuit’s Visual Depiction Test.

Applying the Visual Depiction Test articulated above, IPO submits that all ten examples set forth in the Federal Register Notice (http://www.uspto.gov/patents/init_events/additional_ex_2014.pdf) would meet the requirements of §112.

2. Attempts to Curb the Hypothetical Checkerboard Scheme Should Not Thwart Bona Fide Amendments and Continuations

Included in the materials attached to the Federal Register Notice was a USPTO presentation from the 2013 USPTO Design Day. http://www.uspto.gov/patents/init_events/designday2013.pdf. Slide 3 of the presentation (shown below) sets forth a hypothetical example showing a parent application depicting a generic 5x5 grid of small squares and three hypothetical amendments. (Checkerboard Scheme).

¹ Indeed, the Federal Circuit has found that §112 description/disclosure requirements can be met *even if* the design claimed in child application is not *exactly* disclosed in the parent drawings so long as the design is merely “reasonably conveyed.” *In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998) (permitting the *addition* of holes to complete a pattern not explicitly disclosed in the original filing). The *Daniels* Court reiterated that when analyzing §112 issues for a design patent, “**one looks to the drawings** of the earlier application for disclosure of the subject matter claimed in the later application.” *Id.* (*emphasis added*).



IPO believes the Checkerboard Scheme should not serve as the impetus for constructing new guidelines for interpreting §112 for design patents. To our knowledge, the USPTO has not cited real-world examples of abusive amendments/continuation practice. The Checkerboard Scheme has been the only example (albeit hypothetical) cited in connection with the possibility of problematic amendment/continuation design patent practice. IPO is unaware of any attempts to execute the hypothetical Checkerboard Scheme.

With regard to implementing a rule related to §112 to combat the Checkerboard Scheme, IPO could support such a rule so long as it was measured and did not impact the prosecution of legitimate good faith amendments/continuations. IPO views the applicant's ability to file amendments/continuations on sub-combinations found in the initial/parent figures as a virtue of the U.S. design patent system, not a problem. The vast majority of practitioners who engage in amendment/continuation practice are trying to best protect the legitimate interests of their clients in a cost-effective manner.

3. Any Proposed Rule Change To USPTO's Longstanding Interpretation of §112 Must Not Only Comply with Federal Circuit Precedent, But Also Be Narrowly Tailored to Address the Exceptionally Rare Situation of the Checkerboard Scheme

Any modification to the USPTO's interpretation of §112 should comply with Federal Circuit precedent and the Visual Depiction Test. See *Racing Strollers*. If the USPTO does construct a rule to combat the hypothetical Checkerboard Scheme, it should be tailored narrowly to address the perceived problem and no broader. Presumably, the Checkerboard Scheme and like schemes constitute a small percentage of design patents

prosecuted before the USPTO. In view of these considerations, IPO proposes the following test:

An amended design patent claim may not have written description support in the original disclosure when a designer of ordinary skill would not recognize any relationship between the claimed design and the original disclosure.

Again, other than the hypothetical Checkerboard Scheme, IPO is unaware of any actual, or other potential, amendment or continuation abuses beyond the Checkerboard Scheme example. Accordingly, any proposed rule for analyzing §112 compliance would need to be constructed to address the Checkerboard Scheme and nothing broader.

4. The Public Notice Function is Best Served By Current §112 Test, And Not The Proposed Multi-Factored Analysis

The USPTO's current approach to §112 (i.e. inquiring whether the claimed design of amendment/child is shown in the solid/broken lines of the parent/initial drawings) best serves the policy of public notice. The lines in the initial application, whether solid or broken, are the best proxy for whether the inventor was in possession of the amended design under §112. The §112 issue with regard to the current approach is a simply "yes" or "no" proposition: Are the lines present in the parent/initial drawings? Whatever is ultimately claimed must satisfy the rigors of §§ 102, 103, and 171. Any concerns about an applicant later "unfairly" claiming just a "fragment" of the original design is not an issue under §112. Rather, whether a particular "fragment" warrants a design patent is to be determined pursuant to §§ 102, 103, and 171 and the controlling design patent jurisprudence interpreting those statutes.

5. The Proposed Multi-Factored Approach Will Create Unwanted Uncertainty Forcing Applicants to Frontload Applications Thereby Raising Transaction Costs

If the proposed multi-factored approach is implemented, it will inject uncertainty into the system relative to the general rule. Applicants, wishing to steer clear of the uncertainty created by the proposed factors, will be forced to frontload applications (i.e., filing an application with a massive amount of drawings and text directed at every conceivable sub-combination). Guarding against the uncertainty of the proposed multi-factored approach, bloated applications will become the norm. Frontloading applications raises unwanted transaction costs all around (e.g. professional fees, drafting fees, PTO resources, etc.). Worse, small and mid-sized entities, along with individual inventors, will be particularly disadvantaged under the proposed factor-based approach because they are not in the position to expend these additional resources to frontload applications, particularly before knowing if a design is commercially valuable. Most simply can't afford to file multiple applications/embodiments in the first instance to adequately protect novel aspects of their designs.

6. *Any Rejection Based on a New Rule Should Be Rebuttable With Remarks and Evidence*

If the USPTO creates an additional rule for analyzing §112 compliance in these rare instances, the procedural process and burdens that should be applied should be similar to the procedures established by the USPTO on other issues, such as the issue of inherency. That is, to establish a rejection on the theory of the failure to comply with the written description requirement, the examiner must provide a detailed explanation and reasoning to support that a designer of ordinary skill would not recognize any possible visual, conceptual, or physical relationship between the claimed design and the original disclosure. If a strong detailed argument is presented on this basis such that a *prima facie* case has been established, the applicant should have the opportunity to rebut this assertion and can provide remarks or submit evidence to rebut the rejection.

While the factors listed by the USPTO in the Federal Register Notice are but a few examples of arguments that inherently support that the inventor had possession of the design at the time of the original filing from the perspective of a designer of ordinary skill, the failure to meet a subset of such factors should not be the basis to establish that the design is not in compliance with §112. Other evidence, such as declarations under Rule 132, may be submitted by the applicant to rebut such rejection and may include any information relevant to this issue. The USPTO must fully weigh and consider all of the evidence presented. Again, if such a rule for analyzing §112 compliance were implemented, it would presumably be exercised in only the rarest situation to combat the Checkerboard Scheme or the like.

7. *The Same Test for §112 Compliance Should Apply to All Articles of Manufacture*

Regardless of whether the test and the associated procedures are modified relative to the written description requirement of Section 112, they should be applied similarly to all designs regardless of their corresponding article of manufacture. There should not be a different test or examination procedure for graphical user interfaces and other two-dimensional designs as compared those used for three-dimensional designs.

8. *Detailed Special Descriptions Are Not Needed*

The Federal Register Notice inquired as to whether use of a descriptive statement in the originally-filed application (e.g., that specifically identifies different combinations of elements, which respectively form additional designs) could be a meaningful way for applicants to demonstrate that they had possession of designs claimed in future amendments/ continuation applications. It has long been said that the drawings, not words, are the best way to communicate a design. IPO feels that the Visual Depiction Test is best aligned with this principle.

The presence of a special description statement can be relied upon to show that the amended design claim is in compliance with Section 112. It should be noted, however,

that the lack of a special description statement or a very detailed special description statement does not mean that an amended design claim is not in compliance with Section 112.

Conclusion

IPO fully supports the USPTO in undertaking reasonable efforts to prevent hypothetical abuses such as the Checkerboard Scheme. IPO supports any measures that improve the efficiency of the examination process and the quality of issued patents. We have considerable concern, however, that the changes discussed would not lead to greater efficiency in the examination process, would not reduce the pendency of patent applications, and would not improve the quality of issued patents. We are concerned that the proposed multi-factored approach would thwart the issuance of legitimate design patents and divert scarce resources from examining activity to discerning the applicability of the proposed multi-factored approach. Thus, any upside from implementing the multi-factored approach would be outweighed by the attendant downside.

Sincerely,

A handwritten signature in black ink, reading "Herbert C. Wamsley". The signature is written in a cursive style with a large initial "H" and a long, sweeping underline.

Herbert C. Wamsley
Executive Director