



June 14, 2016

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property &
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
Mail Stop Comments—Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Attention: Nicole D. Haines

Via email: DesignWrittenDescription2016@uspto.gov

Re: IPO Comments on the Application of the Written Description Requirement to Specific Situations in Design Applications

Dear Director Lee:

Intellectual Property Owners Association (IPO) submits the following comments on the United States Patent and Trademark Office's request for comments on the Application of the Written Description Requirement to Specific Situations in Design Applications (81 Fed. Reg. 22233).

IPO is an international trade association representing companies and individuals in all industries and fields of technology who own, or are interested in, intellectual property rights. IPO's membership includes about 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO membership spans 43 countries. IPO advocates for effective and affordable IP ownership rights and provides a wide array of services to members, including supporting member interests relating to legislative and international issues; analyzing current intellectual property issues; information and educational services; and disseminating information to the general public on the importance of intellectual property rights.

IPO appreciates the United States Patent and Trademark Office's effort to allow stakeholders the opportunity to provide comments on the application of the written description requirement to design applications. In these comments IPO addresses the issues raised in the Office's request and concludes that a new approach or new guidelines are not necessary or appropriate at this time. Instead, IPO suggests improvements to examination practice to better comport with existing guidance from the relevant case law.

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1. The Law Relating to Written Description in Design Applications Has Been Long Settled; There Has Been No Change That Would Call for New Guidelines.

In its request, the Office seeks comments on the application of the written description requirement to the situation in design applications in which only a subset of originally disclosed elements is later claimed by amendment or in a continuing application. 81 Fed. Reg. 22234. The Office was well-apprieved of the current legal standard in response to its previous request for comments on this same topic, and appears to be in line with its stakeholders. IPO agrees with the prevailing standard articulated in those comments, as summarized by the Office: “[the case law establishes] ‘a simple visual test’ for determining compliance with the written description requirement; that is, the written description requirement is satisfied because the elements of the later-claimed design are visible in the original disclosure.” *Id.* This standard comes from the prevailing case law on this issue, *Racing Strollers Inc. v. TRI Indus. Inc.*, 878 F.2d 1418 (Fed. Cir. 1989) (*en banc*) and *In re Daniels*, 144 F.3d 1452 (Fed. Cir. 1998).

The Office’s concern appears to be that the current legal standard does not go far enough. In particular, in some situations “an ordinary designer might not have recognized in the original disclosure” the later-claimed design, even though all of its elements were visible in the original disclosure. IPO believes this concern cannot be addressed by new guidelines absent a change in the prevailing law. The law is clear that the written description requirement is satisfied when the elements of the later-claimed design are *visible* in the original disclosure, and it does not allow for an exception to this standard to address the situation raised by the Office.

Moreover, there has been no recent change in the law that would call for a new approach or new guidelines to apply when the only difference between an original disclosure and a later-claimed design is a difference in which lines are solid in one and broken in the other. In the case of *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013), the court determined that a *new element* had been introduced by introducing a *new* unclaimed boundary line. Broken lines used to disclaim certain design elements—such as are the subject of the Office’s request for comments—were “not at issue in [*Owens*].” *Id.* at 1367.

The prevailing law provides a clear and objective test: if the elements of the claimed design are *visible* in the original disclosure, then the claimed design satisfies the written description requirement. IPO is concerned about introducing subjectivity into this analysis. Doing so would only promote uncertain and inconsistent examination.

2. The MPEP is Already Consistent with the Law.

The MPEP has long been consistent with the prevailing case law on this issue. It states that changing existing broken lines to solid lines or solid lines to broken lines is permissible and does not violate the written description requirement:

[A]n amendment that changes the scope of a design by either reducing certain portions of the drawing to broken lines or converting broken line structure to solid lines is not a change in configuration as defined by the court in *Salmon*. The reason for this is because applicant was in possession of everything disclosed in the drawing at the time the application was filed and

the mere reduction of certain portions to broken lines or conversion of broken line structure to solid lines is not a departure from the original disclosure.

MPEP § 1504.04 (emphasis added).

3. The Solution to the Issues Raised in the Request for Comments Is Not New Guidelines, But Better Alignment of Examination Practice with the MPEP’s Existing Guidance.

In the request for comments, the Office suggests that “there exists a need to supplement the current provisions in the [MPEP] relating to 35 U.S.C. 112 for design applications.” Given the clear existing language of the MPEP quoted above, and its consistency with the law, IPO wonders why a supplement would be necessary. To the extent that there is current uncertainty surrounding the written description standard for design applications, this stems not from the MPEP, but from remarks made by the Office during Design Day 2013. These remarks suggested that the Office had been unofficially promoting examination practices within the design technology center that were inconsistent with the MPEP and the law, thus engendering confusion. Specifically, the Office noted that it was promoting rejections under section 112 in some instances in which all elements of the claimed design were *visible* in the original disclosure, using an undisclosed subjective standard rather than the objective standard mandated under the law and outlined in the MPEP.

IPO believes that the best solution to the present uncertainty surrounding the written description requirement is for the Office to align examination practice with existing law and MPEP guidance. This may be done by reverting examination practice to the manner in which it was carried out before the changes following Design Day 2013. To the extent that the Office believes that recent uncertainty might be clarified by a change to the MPEP, IPO suggests that the Office include the same statement it made in the current request for comments that summarized the comments previously received on this topic. The Office might consider re-phrasing it in the following way:

Determining compliance with the written description requirement is undertaken using a simple visual test: the written description requirement is satisfied when the elements of the later-claimed design are visible in the original disclosure.

4. Examples That Guide Examination Should Come From Litigation or the Examination and Appeal Processes, Not Speculation by the Office or the Public.

The Office has asked for examples to illustrate proposed approaches to applying the written description requirement. IPO believes that without real interests at issue, any examples provided would be incompletely developed, and any predicted outcomes would be speculation. This would be a poor basis on which to rest examination guidelines. IPO would welcome the opportunity to assist in developing examples drawn from actual cases in the future.

5. Declarations Should Not Be Required, but When Presented Should Be Given Substantial Weight.

The Office's request reveals a further complication. By eschewing the existing objective standard for assessing written description and relying instead on subjective assessment, an applicant's main recourse to challenge such a rejection might become declaratory evidence. This would be a substantial new burden on applicants, and would significantly raise the cost of design patent prosecution. If the Office introduces new guidelines, IPO asks that the Office do so without these new burdens and costs, by encouraging examiners to resolve rejections without calling for declaratory evidence.

When applicants do undertake the burden and expense of providing declaratory evidence, the Office's request for comments affirms that examiners must "thoroughly analyze and discuss" them. 81 Fed. Reg. 22236. This treatment is already required. *See* MPEP § 716.01 ("[T]he examiner must specifically explain why the evidence is insufficient. General statements ... without an explanation supporting such findings are insufficient.").

Notwithstanding the MPEP's clear guidance, IPO members' experience is that evidentiary declarations within the design technology center are routinely dismissed without explanation. IPO encourages the Office to implement training as needed to bring examination practice into conformance with existing guidance on evaluating declarations, whether or not new written description guidelines are issued.

We thank you for considering these comments and would welcome any further dialogue or opportunity to provide additional information to assist the Office's efforts in reconciling its examination practices for evaluating written description in design applications.

Sincerely,



Kevin H. Rhodes
President