

Comments On Proposed Written Description Requirement Guidelines

Comments on behalf of the U.S. Section of FICPI
International Federation of Intellectual Property Attorneys



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

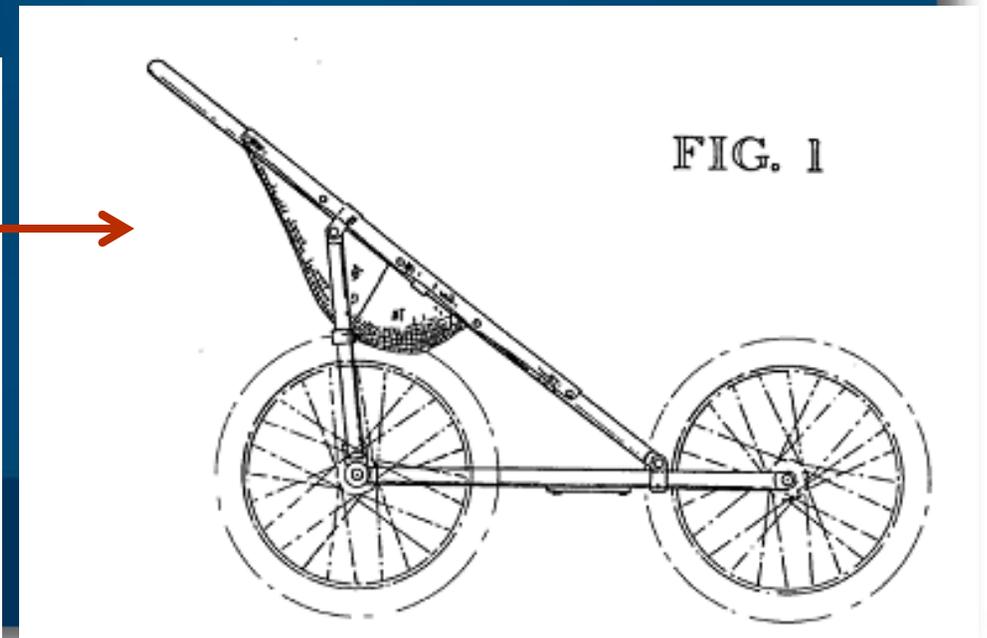
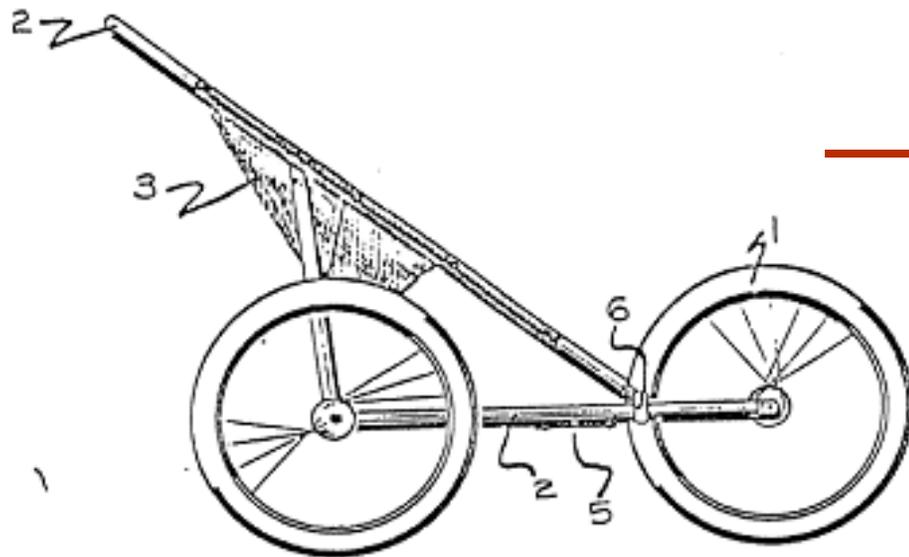
INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

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Racing Strollers

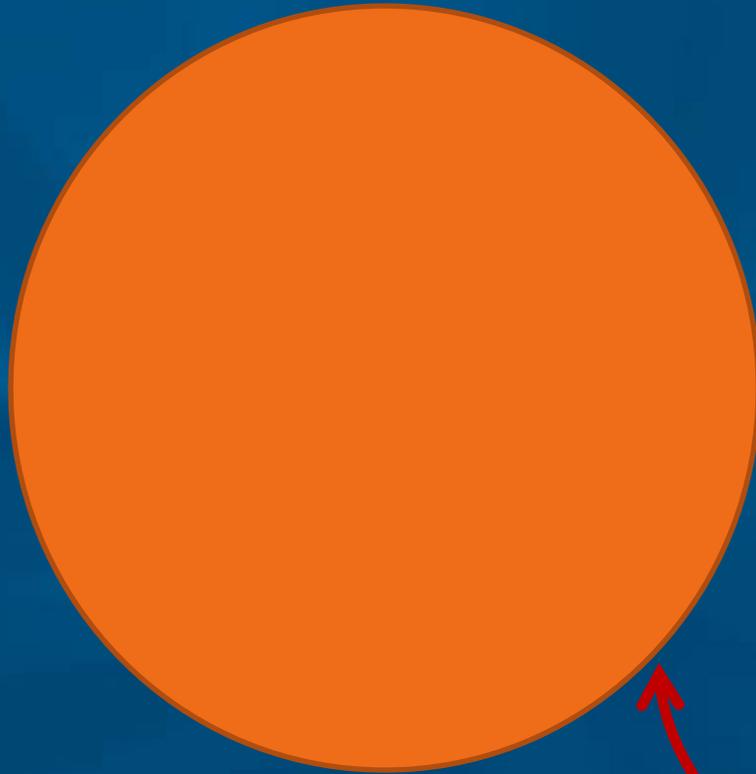
- Applicant filed a continuation design patent application and needed priority to a utility patent application
- Disclaimed wheels (added disclaimed spokes)



Racing Strollers

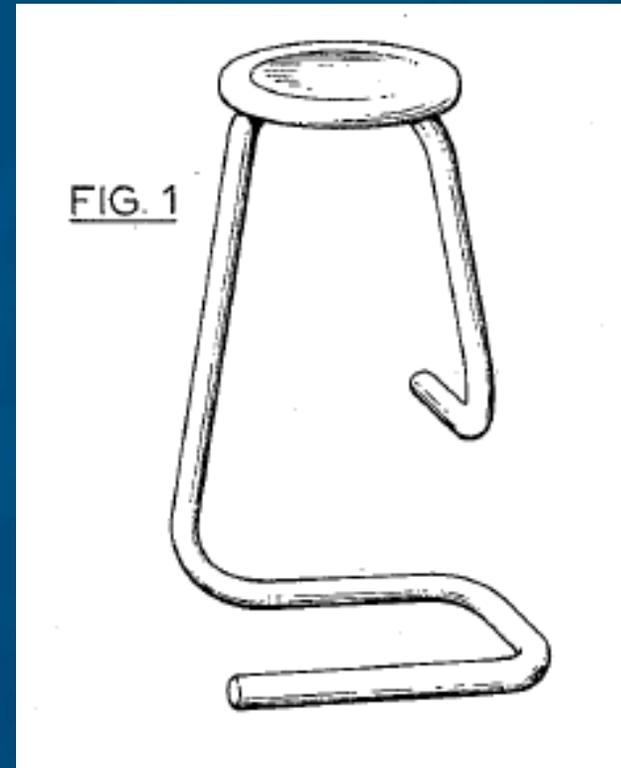
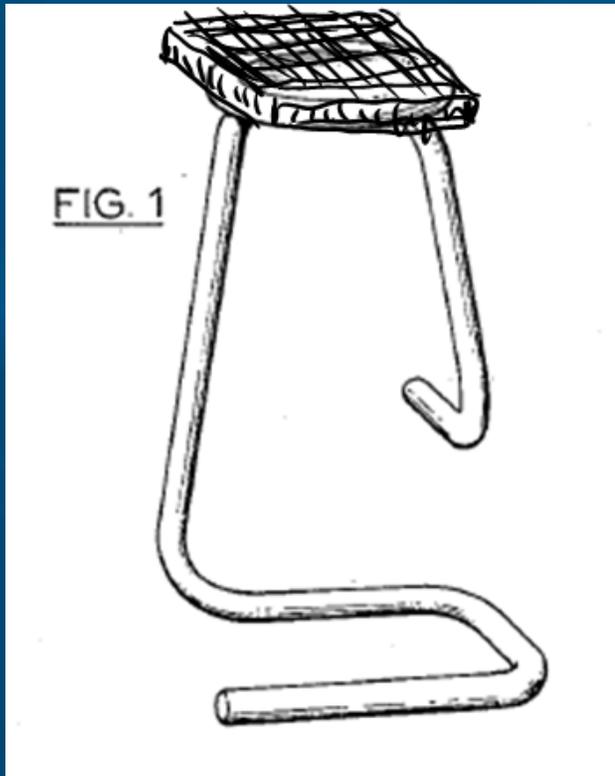
- Rejected; Board affirmed; CAFC reversed (En Banc)
- As a practical matter, meeting the ... requirements of Section 112 is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application.
- The test should generally focus on whether the later filed design has been disclosed.
- The test for sufficiency in disclosure is whether the disclosure reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter at the time of filing

Federal Circuit Case Law

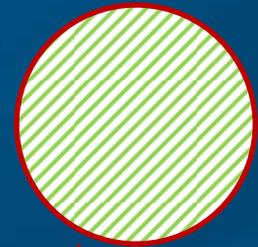
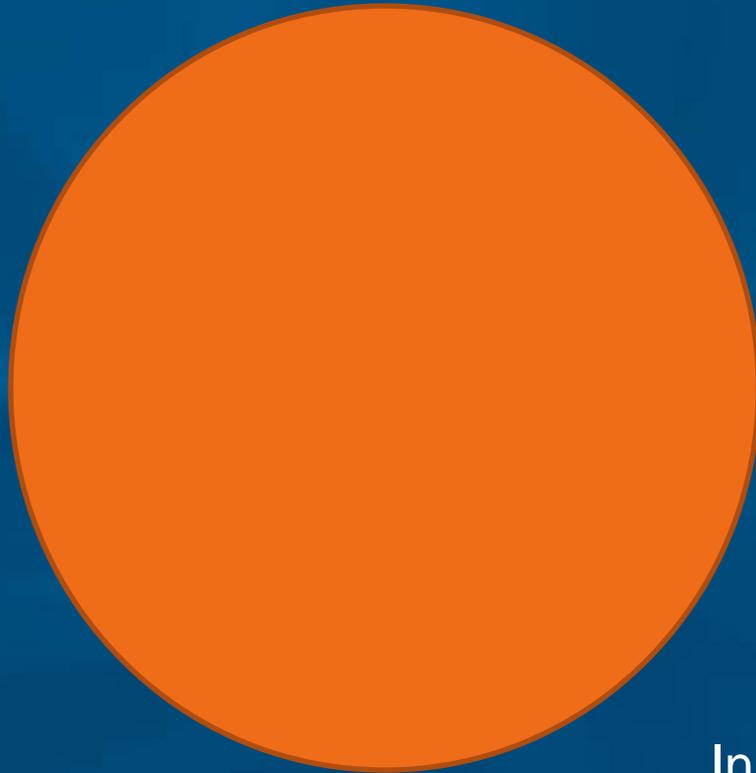


Racing Strollers
If disclosed, then ok

In re Salmon



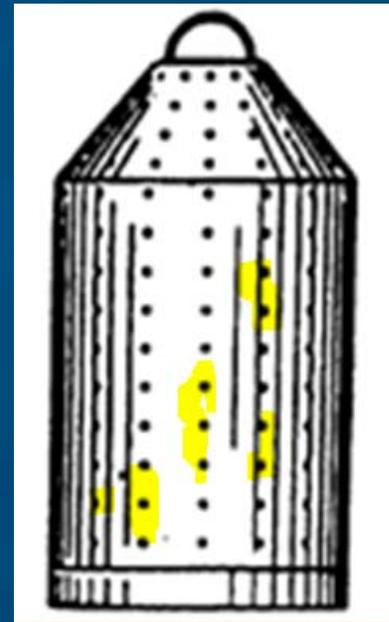
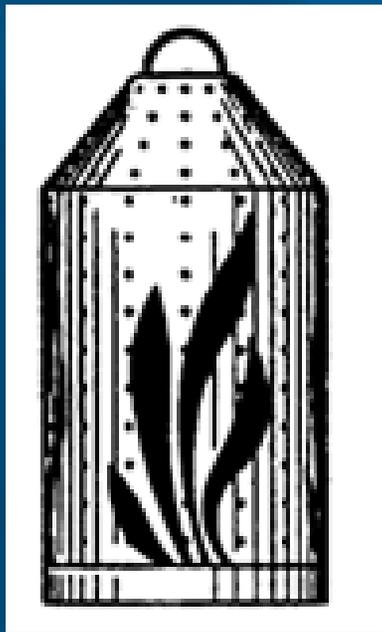
Federal Circuit Case Law



In re Salmon
If not disclosed, then not ok

In re Daniels

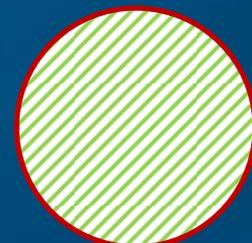
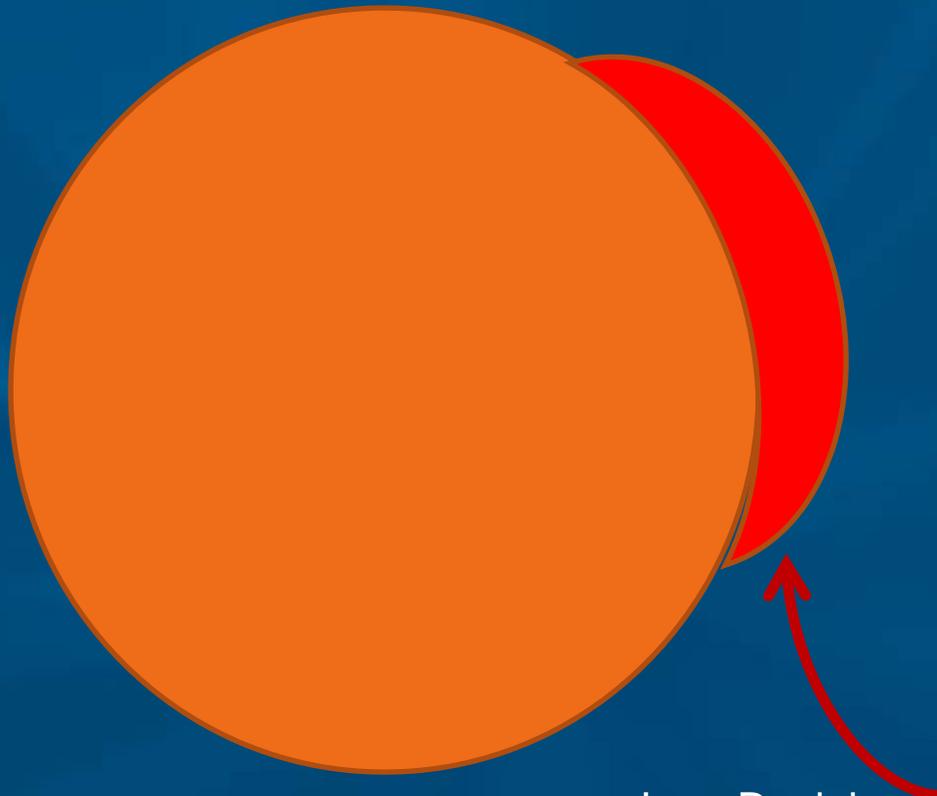
- Applicant filed leecher design with leaf ornamentation. Filed a continuation to protect without ornamentation (priority needed)
- Holes were added (not specifically disclosed) and ornamentation removed



In re Daniels

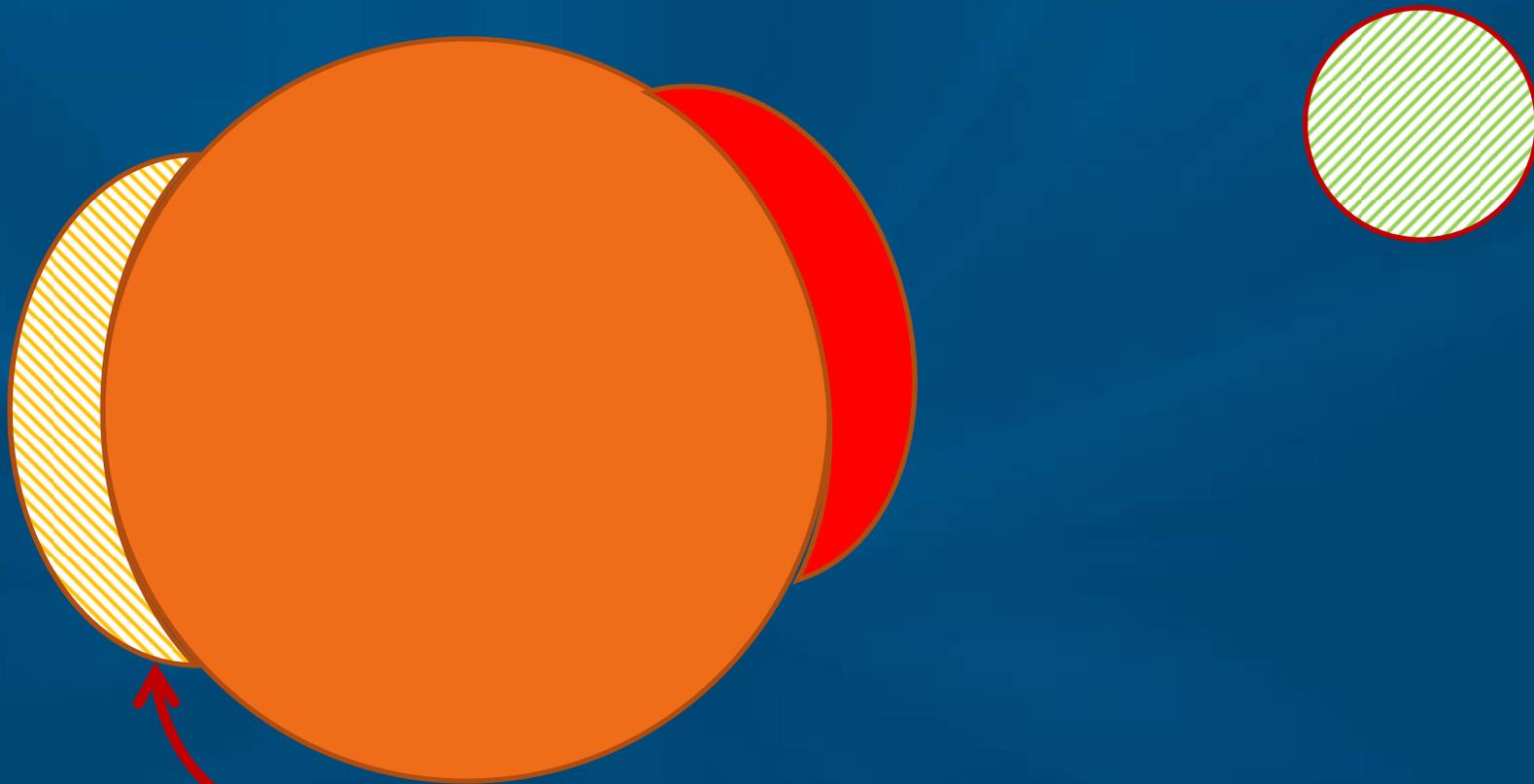
- Rejected; Board affirmed; CAFC reversed
- The test for sufficiency in disclosure is whether the disclosure *reasonably conveys* to those skilled in the art that the inventor had possession of the claimed subject matter at the time of filing
- Impliedly, the written description requirement can still be met even if the design later claimed is not exactly present in the original filed drawings but one of ordinary skill would recognize that the inventor had possession of it.

Federal Circuit Case Law



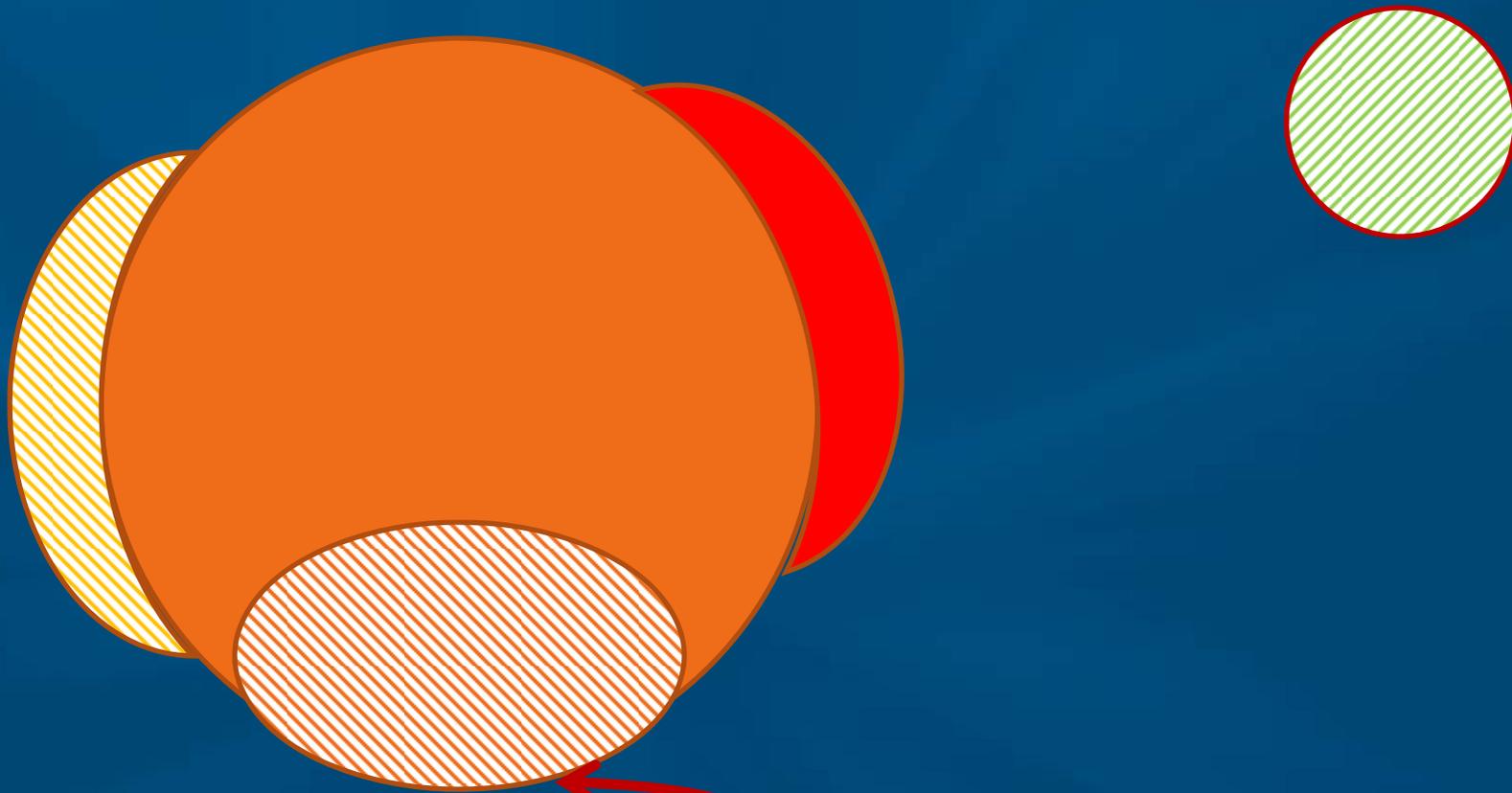
In re Daniels
If reasonably conveyed, then ok w/112

Federal Circuit Case Law



In re Owens
If not disclosed, then not ok

Federal Circuit Case Law



NOW: The Carve Out

The Carve Out – Part 1

- USPTO is creating a category of situations where a design applicant cannot protect his design where he otherwise would be able to protect the design under the test set forth by the CAFC
- For designs, the Federal Circuit has never found that the written description requirement was not satisfied where the later filed design was disclosed in the originally filed application
- Guidelines cannot be based on an intent to claim at time of filing
 - Contrary to Racing Strollers
 - Contrary to Daniels

The Carve Out – Part 2

- To the extent that the USPTO wants to use utility patent law for guidance, it should focus on the more analogous drawing-based situations
 - Mechanical inventions (can add or delete elements from a claim if disclosed in the specification)
 - Should not focus on chemical and biotech unpredictable arts
- In the mechanical utility patent realm, no such prohibitions apply – if its in the disclosure, it can be claimed (absent an essential element issue)
 - Amendments during prosecution
 - Benefit from provisionals without claims
 - Reissue applications

The Carve Out – Part 3

- Why? USPTO motives are not fully known
- How are design patents used 98% of the time?
- Designers revise design all the time in the real world for US
 - May seem random, but designers also look to **DNA**
 - Small/Med/Large; High/Med/Low End, etc.
 - Product capabilities get better
 - Limited editions
 - Part of the way many companies work
- Designers (those of ordinary skill in the art) would certainly almost always feel they had possession of the later filed design based on what they disclosed

The Carve Out – Part 4

- Since the USPTO is negating protection that would otherwise be permissible under the existing CAFC test, the carve out should be narrow
 - This is a newly created carve-out where none exists in the law and none is present in the more analogous mechanical utility patent law
 - Rejections should only be made except in rare circumstances
 - A broader than needed carve out will help knockoff artists simulation the designs of the creators
- Should only be done after consulting with designers (who have a much better feel for what is reasonably conveyed to one of ordinary skilled in the art)

The Carve Out – Part 5

- The Notice had a number of factors that can be considered to determine whether the original disclosure “reasonably conveys” the later claimed design
 - Any or all can be a valid basis
 - Justifications list should not be limited to that list
 - DNA being carried over should be OK
 - Typically be able to disclaim any minor features (seams, labels, etc.)(close to category 5)
 - Combinations of factors – such as 3 + 5 should be OK too
- No special test for GUIs/icons
 - The same principles used for 3D designs should be applied

Special Statement - Boilerplate

- All aspects of the specification, including language in the written specification must be considered.
- This test is one of ordinary skill in the art based
- Boilerplate language not as strong as specific statements, but should be considered

If Rejected → Evidence To Rebut

- Previously told would not be persuasive
- Declarations by inventors should not be dismissed out of hand
- Declarations by non-inventor designers should not be dismissed out of hand merely because they are compensated

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