

Debrief on USPTO Design Day Information

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The USPTO held its annual Design day conference, today, 4/23/2013. This is a debrief. The USPTO Design director noted today that the examiners will no longer accept conversion of a solid line to a dashed line or vice versa, in design drawings, unless the applicant can demonstrate support for the conversion (which is unlikely). This is contrary to pre-existing MPEP guidance, which indicates that such changes are not new matter. See MPEP 1504, paragraph 15.73 which states in part:

A change in the configuration of the claimed design is considered a departure from the original disclosure and introduces prohibited new matter (37 CFR 1.121(f)). See *In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983). This includes the removal of three-dimensional surface treatment that is an integral part of the configuration of the claimed design, for example, beading, grooves, and ribs. The underlying configuration revealed by such an amendment would not be apparent in the application as filed and, therefore, it could not be established that applicant was in possession of this amended configuration at the time the application was filed. However, *an 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.

The foregoing statement regarding changing broken lines to or from solid lines is no longer USPTO policy.

There was a major focus on design patents directed to the user experience of a GUI. That is, the sequence in which GUI's views are displayed and the manner in which they change, primarily directed to cell phone "apps." This is a large and rapidly growing section of the design applications.

The newly signed Patent law treaty and Hague agreement, in conjunction with the foregoing limitation, result in incentives to include multiple embodiments of designs in a single US filed application. Some embodiments differing only by what is dashed and what are solid lines, to allow flexibility in U.S. prosecution while serving as a basis for priority in Offices where design requirement differ from those in the U.S. The design treaty should be effective some time in 2014 due to regulatory delays and WIPO negotiations.

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