

Response to "Request for Comments and Notice of Roundtable Event on the Written Description Requirement for Design Applications," 79 FR 7171 (February 6, 2014)

By Rick Neifeld, Neifeld IP Law, PC

On February 6, 2014, the USPTO solicited comments on how to examine design applications for compliance with the written description requirement, when the design claim was broadened after filing. The Notice requesting comments is at 79 FR 7171, as indicated herein above. My comments were submitted February 13, 2013. Those comments follow.

To: DesignRoundtable2014@uspto.gov

Sir:

Thank you for the opportunity to comment on the application of the written description requirement for US design patent applications.

I am a patent attorney and founder of Neifeld IP Law, PC. I have about 20 years of experience in the field of patent law.

You request comments on factors for determining whether an amended/continuation design claim, which includes only a subset of the originally disclosed elements (that is when no new elements are introduced that were not originally disclosed), satisfies the written description requirement.

More specifically, the Notice at 79 FR 7171 seeks comments on the application of the written description requirement where only a subset of elements of the original disclosure are shown using solid lines in an amendment or in a continuation application. The Notice lists five factors. The Notice refers to a pdf file containing illustrations corresponding to the five factors, which is titled "Illustrative Examples of the Proposed Factors in the Federal Register Notice." I have also reviewed those illustrations. My comments also address those illustrations.

Prior to providing my comments on those factors, the relevant law for written description must be noted in order to place those factors in context of the appropriate legal framework. Written description is a subset of the requirements in 35 USC 112(a). 35 USC 112(a) states that:

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The "written description" requirement and the enablement requirement are distinct. Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co., ___ F.3d ___ (Fed. Cir. 2010)(en banc). In Ariad, the Court defined the test for written description as follows:

whatever the specific articulation [of the test for written description], the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.

Ariad also reiterated that "original claims are part of the original specification." Finally, Ariad laid down factors for making the written description determination, stating:

For generic claims, we have set forth a number of factors for evaluating the adequacy of the disclosure, including "the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology, [and] the predictability of the aspect at issue."

With that framework in mind, I address your proposed factors.

Factor 1: "The presence of a common theme among the subset of elements forming the newly identified design claim, such as a common appearance."

Response: No. Factor 1 does not seem to be relevant to a subset of disclosed elements. Elements and relationships between elements, are either disclosed or not disclosed. Merely claiming a subset of disclosed elements, or a subset of disclosed relationships of elements, is not relevant to written description, and therefore not a factor. If there was a written description of the elements and relationships in the original disclosure (including the original claim), then there is disclosure of the subset of elements and relationships.

Respecting the vehicle wheel illustration in correspondence with factor 1, the illustration is not relevant to the foregoing conclusions. It is however illustrative of the logical fallacy that removal of originally claimed and therefore disclosed subject matter (illustrated by replacement of solid lines with broken lines) could result in lack of written description. The remaining claimed elements and their ornamental interrelationships with one another are unaffected by the broadening of the claim.

Factor 2: "the subset of elements forming the newly identified design claim share an operational and/or visual connection due to the nature of the particular article of manufacture (e.g., set of tail lights of an automobile)".

Response: No. Factor 2 does not seem to be relevant to a subset of disclosed elements. Elements and relationships between elements, are either disclosed or not disclosed. Merely claiming a subset of disclosed elements, or a subset of disclosed relationships of elements, is not relevant to written description, and therefore not a factor. If there was a written description of the elements and relationships in the original disclosure (including the original claim), then there is disclosure of the subset of elements and relationships.

Respecting the telescope apparatus illustration in correspondence with factor 2, the illustration is not relevant to the foregoing conclusions. It is however illustrative of the logical fallacy that removal of originally claimed and therefore disclosed subject matter (illustrated by replacement of solid lines with broken lines) could result in lack of written description. The

remaining claimed elements and their ornamental interrelationships with one another are unaffected by the broadening of the claim.

Factor 3: "the subset of elements forming the newly identified design claim is a self contained design within the original design"

Response: No. Factor 3 does not seem to be relevant to a subset of disclosed elements. Elements and relationships between elements, are either disclosed or not disclosed. Merely claiming a subset of disclosed elements, or a subset of disclosed relationships of elements, is not relevant to written description, and therefore not a factor. If there was a written description of the elements and relationships in the original disclosure (including the original claim), then there is disclosure of the subset of elements and relationships.

Respecting the remote control and cradle assembly for a ceiling fan and light fixture illustration in correspondence with factor 3, the illustration is not relevant to the foregoing conclusions. It is however illustrative of the logical fallacy that removal of originally claimed and therefore disclosed subject matter (illustrated by replacement of solid lines with broken lines) could result in lack of written description. The remaining claimed elements and their ornamental interrelationships with one another are unaffected by the broadening of the claim.

Factor 4: "a fundamental relationship among the subset of elements forming the newly identified design claim is established by the context in which the elements appear"

Response: Factor 4 is a non-sequitur. Any "fundamental relationship" existing amongst a subset of elements inherently exists in the entire set of elements, because the entire set includes the subset. Accordingly, factor 4 is not consistent with group theory and therefore cannot be a factor for determining compliance with the written description requirement.

Respecting the ice skate illustration in correspondence with factor 4, the illustration is not relevant to the foregoing conclusions. It is however illustrative of the logical fallacy that removal of originally claimed and therefore disclosed subject matter (illustrated by replacement of solid lines with broken lines) could result in lack of written description. The remaining claimed elements and their ornamental interrelationships with one another are unaffected by the broadening of the claim. Moreover, there is nothing within the ice skate illustration to indicate what is "fundamental" and what is not "fundamental". The amended illustration merely limits the claim to certain features of the ice skate.

Factor 5: "the subset of elements forming the newly identified design claim gives the same overall impression as the original design claim."

Response: No. Factor 5 is a non-sequitur. Any subset of elements forming a new claim is contained within the set of elements previously claimed. Therefore, any claim to that subset of elements was disclosed by the claim to the set of elements. Merely claiming a subset of disclosed elements, or a subset of disclosed relationships between elements, is not relevant to written description, and therefore not a factor. If there was a written description of the elements and relationships in the original disclosure (including the original claim), then there is disclosure of the subset of elements and relationships.

Respecting the computer network appliance illustration in correspondence with factor 5, the illustration is not relevant to the foregoing conclusions. It is however illustrative of the logical fallacy that removal of originally claimed and therefore disclosed subject matter (illustrated by replacement of solid lines with broken lines) could result in lack of written

description. The remaining claimed elements and their ornamental interrelationships with one another are unaffected by the broadening of the claim. Moreover, what provides a "common overall impression" is undefined. What is claimed in both the original and amended designs includes the external shape, as least insofar as the single perspective view provides, and only excludes what appear to be some apertures on one side of the design. Why that would be characterized as the "same overall impression" is undefined by the notice or illustration.

Finally, the Notice asks for input on "any additional factors ... that would be useful for design patent examiners to consider in determining whether an amended/continuation design claim, which includes only a subset of the originally disclosed elements, satisfies the written description requirement." My observation is that the Notice indicates that the Office is confusing disclosure with claims. Elements and relationships in original claims form part of the disclosure. Merely because the original claims are narrow is no basis to conclude that written description does not exist for a broader claim defined by a subset of the limitations in the original claim.