

USPTO's Proposed Patent Description Rules Draw Protests

By **Melissa Daniels**

Law360, Los Angeles (June 15, 2016, 9:35 PM ET) -- The Intellectual Property Owners Association trade organization, the American Bar Association and public information advocate Public Knowledge were among the voices Tuesday critiquing the U.S. Patent and Trade Office's proposed new approach to written description requirements in design patents.

The organizations filed comments with the USPTO on Tuesday at the close of a public comment period over its proposed alterations to written description requirements in certain design applications. The office sought comments on a proposed approach for written descriptions in situations where a subset of originally disclosed elements are later claimed by an amended or continued application.

The proposed new standard would allow the examiner to determine whether an ordinary designer in the field would recognize from the application that the inventor had possession of the later-claimed design in the original disclosure.

IPO, a member organization that represents patent holders across 200 major companies and 12,000 individuals, told the USPTO that a new approach to the written description requirement isn't necessary or appropriate, and that its proposal added too much subjectivity.

"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 [USPTO]," said the letter signed by IPO President Kevin H. Rhodes.

The IPO further said that the proposed approach would place substantial new burden on patent applicants and also raise the cost of design patent prosecution. The organization added that prevailing law provides an objective test where if the elements of the claimed design are visible in the original disclosure, the claimed design satisfies the written description requirement.

"IPO is concerned about introducing subjectivity into this analysis," its comments stated. "Doing so would only promote uncertain and inconsistent examination."

Charles Duan, director of the Patent Reform Project at Public Knowledge, wrote a 12-page comment letter that design applications are being approved with a "surprising frequency" and the USPTO should provide new approaches to ensure that patents are being issued correctly. The USPTO approved 89.5 percent of design applications in 2014, compared to 51.5 percent for utility and other patents, Duan wrote.

"It is essential that the USPTO act quickly to adopt guidance to prevent the improper issuance of overbroad design patents, given contemporary developments that tend toward the likelihood of abusive design patent assertion practices in the near future," Duan wrote.

Duan told the USPTO that its proposed approach is not unduly burdensome to applicants, though it is more stringent, but that examiners should be required to look at the totality of the originally filed application to determine whether cutting out features is permissible under the standard where an ordinary designer would recognize the inventor had possession of the later-claimed design.

The American Bar Association also sent in comments from its intellectual property law section saying that it opposes the proposed approach, as it would unduly burden applicants when Federal Circuit decisions have already sufficiently addressed the issue.

"The drawings of the parent application ably and fairly disclose and describe any depicted sub-combinations," wrote ABA Section Chair Theodore H. Davis Jr. "There has been no identified problem with this approach and no identified change in the law, and thus there is no need to change the existing approach to [written description requirements]."

The request for comments stems from a roundtable the USPTO held in March 2014. The USPTO issued a call for comments in April 2016 and so far received a total of 11 comments from organizations and individuals on the matter, according to website records for the public comment period that ended Tuesday.

Other entities who weighed in on the discussion included the American Intellectual Property Association, law firms NSIP Law and Sterne Kessler Goldstein & Fox, and shoe manufacturer Crocs.

The USPTO, IPO and Public Knowledge did not immediately respond on Wednesday to requests for comment.

--Editing by Philip Shea.

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