



DESIGN PATENT NEWS

THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT FINDS THAT PROSECUTION HISTORY ESTOPPEL DID NOT BAR A CLAIM FOR INFRINGEMENT OF A U.S. DESIGN PATENT

On August 1, 2018, the U.S. Court of Appeals for the Federal Circuit held that the doctrine of prosecution history estoppel did not prevent the owner of a U.S. design patent from moving forward with its claim for design patent application. In *Advantek Mktg. v. Shanghai Walk-Long Tools*, Appeal No. 2017-1314 (Fed. Cir. 2018), Advantek Marketing sought to enforce its U.S. Patent No. D715,006 (“the ‘006 Patent”) for a portable animal kennel design. Figures 1 and 2 of the ‘006 Patent show the ornamental visual appearance of the portable kennel design that is claimed. That design has the general appearance of a gazebo.



Figure 1 from D'006



Figure 2 from D'006

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TABLE OF CONTENTS

The U.S. Court of Appeals for the Federal Circuit Finds That Prosecution History Estoppel Did Not Bar Claim for Infringement of a U.S. Design Patent.

Page 1.

A second embodiment of the claimed portable animal kennel design shown with a roof feature covering the top portion is depicted in Figure 5:



Figure 5 from Application

Advantek had contracted with a Chinese company, Shanghai Walk-Long Tools Co. to manufacture the portable pet kennel product. Advantek subsequently discovered that Shanghai Walk-Long and Advantek's former Vice President and others had copied Advantek's portable kennel product and were selling it in the United States. Advantek then sued Shanghai Walk-Along, and the others who were responsible for copying its product, for design patent infringement in the U.S. District Court for the Central District of California. Shanghai Walk-Long responded to the lawsuit by filing a motion for judgment on the pleadings at an early stage of the case, and argued based only on the evidence that was presented in Advantek's Complaint and Shanghai Walk-Long's Answer that the doctrine of prosecution history estoppel prevents Advantek from enforcing the '006 Patent against Shanghai Walk-Long's copy of Advantek's product. The California District Court agreed and dismissed the case.

Advantek appealed the District Court's decision to the Federal Circuit, which held that prosecution history estoppel did not prevent Advantek from enforcing the '006 Patent against Shanghai Walk-Long and the other defendants.

According to U.S. Patent Law, if an applicant for a utility or design patent makes arguments to an Examiner, or amendments to the design claim, in order to overcome an objection to or rejection of the design

TABLE OF CONTENTS (Continued)

U.S Federal District Court Modifies Jury's Award of Damages for Design Patent Infringement and Rules That a Software Product Can Be An "Article of Manufacture" Which Supports An Award of the Infringer's Profits Under The Design Patent Damages Statute.

Page 5.

USPTO Updated Guidance on Complying With The Written Description Requirement In Design Patent Cases

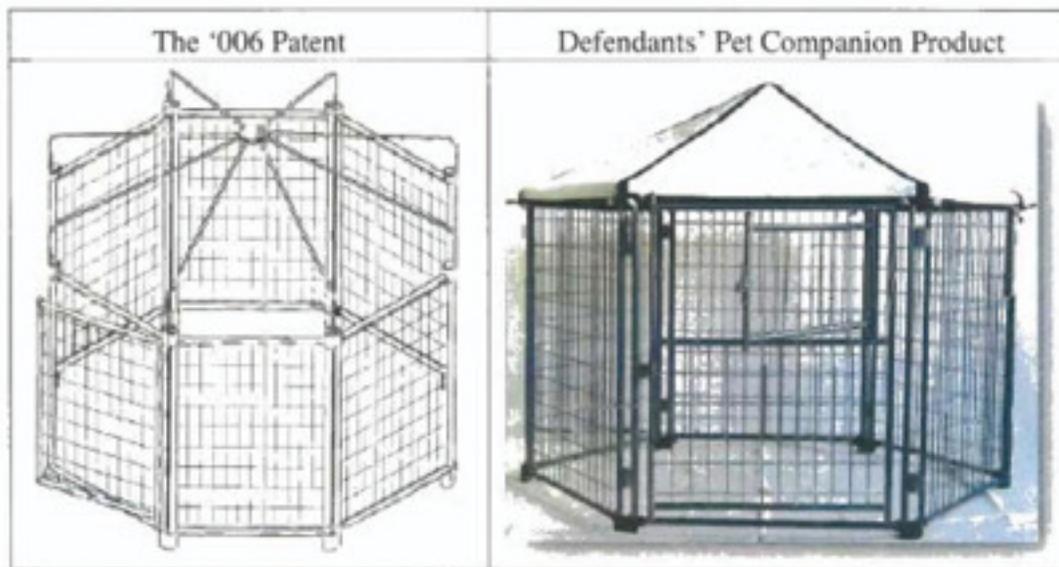
Page 8

claim by the Examiner in order to establish the invention's patentability, those arguments and amendments may be used later by a Court to narrow the scope of the design claim under the doctrine of prosecution history estoppel, based on the theory that an applicant which gives up certain features of his or her invention in order to obtain the patent, cannot later try to broaden the scope of his or her patent rights to include those relinquished features. This same doctrine applies to utility patents as well.

In *Advantek Marketing*, the Federal Circuit applied the three-part test for the application of prosecution history estoppel to design patents that it announced in *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694 (Fed. Cir. 2014). Under that three-part test, whether prosecution history estoppel will be found in a design patent case will depend on 1) whether there is a surrender of portions of the design invention during prosecution of the design patent application; 2) whether the surrender was for reasons of patentability; and 3) whether the accused design is within the scope of the surrender, so that when the surrendered subject matter is removed from the scope of coverage of the design claim, the accused product no longer infringes.

Understanding how the Federal Circuit applied these principles to the facts of *Advantek Marketing* is instructive of its current thinking on how the doctrine of prosecution history estoppel should be applied to design patent cases. During prosecution of the application for the '006 Patent before the U.S. Patent and Trademark Office, the Examiner issued a Restriction Requirement. Under U.S. patent law, only one claim for a single patentably distinct invention may be included in each design patent application. In the case of the application for the '006 Patent, the Examiner asserted that *two* patentably distinct inventions that were included in the application, a first embodiment, as shown in FIGS. 1 through 4, which was directed to a portable animal kennel without a cover, and a second embodiment, as shown in FIGS. 1 through 5 (the specification of the '006 Patent indicated that the design shown in FIGS. 1 through 4 may include the kennel with a cover shown in FIG. 5 in the second embodiment), which included a cover. Therefore, the Examiner directed Advantek to select one of those two patentably distinct embodiments to include in the present application, and cancel the non-selected embodiment. Since the non-selected embodiment was considered patentably distinct from the first embodiment, it was eligible for patenting in a separate design patent from the first embodiment.

Advantek responded to the Examiner's Restriction Requirement by electing the first embodiment of the portable kennel design without the roof/cover shown in FIGS. 1 through 4, and by withdrawing the second embodiment of the kennel design shown with the roof/cover in FIG. 5. Unfortunately for Advantek, the copy of the portable animal kennel that Shanghai Walk-Long was selling in the United States had a roof/cover, so that it looked like the second embodiment of the kennel design that Advantek had included in FIG. 5, and which Advantek had agreed to remove from the '006 Patent in response to the Restriction Requirement. It was not the kennel without the roof/cover that was included in FIGS. 1 through 4 of the '006 Patent, as the following comparison shows:



As a result, Shanghai Walk-Long argued that Advantek had “intentionally surrendered patent claim scope that would have included gazebos [*i.e.* kennels] with a cover in response to a restriction requirement, thereby limiting the scope of the ‘006 Patent to gazebos without a cover.” The District Court agreed and ruled that Advantek had surrendered the design for the proposed kennel with a cover in order to secure the ‘006 Patent by choosing one of two embodiments in response to a restriction requirement.

On appeal to the Federal Circuit, Advantek argued that the third part of the *Malibu Boats* test for prosecution history estoppel had not been met, because the accused Shanghai Walk-Long design falls outside of any claim scope that Advantek may have surrendered during prosecution in order to obtain the ‘006 Patent. Advantek interpreted the claim for the portable kennel design shown in FIGS. 1 through 4 of the ‘006 Patent to include “the skeletal structure design” of the kennel, and that this design was present in the accused Shanghai Walk-Long kennel, regardless of whether or not it included a cover. Advantek stated that the accused Shanghai Walk-Long kennel as shipped, assembled and used did not have a cover unless or until the user placed a cover on the kennel. Therefore, Advantek argued that the requirements for prosecution history estoppel were not met because its election of the first embodiment shown in FIGS. 1 through 4 during prosecution actually broadened its ability to prevent infringement of its skeletal design, regardless of whether the skeleton of the portable kennel was used alone or in combination with other parts.

The Federal Circuit agreed, and relying on the U.S. Supreme Court’s decision in *Samsung Electronics Co. v. Apple Inc.*, 137 S. Ct.429 (2016), reaffirmed that a design patent may be obtained for an entire product, or for only a component of a multi-component product. On that basis, the Federal Circuit held that regardless of whether Advantek surrendered claim scope during prosecution, the accused Shanghai Walk-Long product falls *outside* of the scope of that surrender, so that it may be found to infringe if it is determined to have a visual appearance that is substantially similar to the design that is claimed in the ‘006 Patent. The Court found that Advantek had patented an ornamental design for a kennel with a particular skeletal structure that was shown in FIGS. 1 through 4. According to the Federal Circuit, a competitor who sells a portable kennel that includes Advantek’s patented structural design will infringe the ‘006 Patent, *regardless of whether it includes extra features*, such as a cover, that the competitor might add to the kennel. As a result, the case

was sent back to the District Court, where Advantek will be allowed to prove that the Shanghai Walk-Long kennel infringes the '006 Patent.

The main take-away from the *Advantek Marketing* decision is that even though there may have been a surrender of certain features of the claimed design during the prosecution of the application which issued as the design patent, that does not end the inquiry. The interpretation of the scope of the design claim that is included in the issued design patent then becomes a critical issue. The exclusion of the subject matter from the design claim may, in certain circumstances, make it easier to prove that the accused product infringes, particularly if the design patent is interpreted to cover only components of a completed product, and not the entire finished product itself. It was very important to the decision in *Advantek Marketing* that the Federal Circuit acknowledged that if a design patent covers certain components of the product, if those components are included in the design of the accused infringing product, infringement may be found, even if the accused design includes additional features that are not a part of the design claim. The inclusion of those additional features may not preclude a finding of infringement. Under the Federal Circuit's reasoning in *Advantek Marketing*, those additional features may even, in certain circumstances, include the exact features that were given up during prosecution. Therefore, this decision may actually limit the circumstances under which prosecution history estoppel will be found in a design patent case, and thereby increase the value of design patents.

U.S. FEDERAL DISTRICT COURT MODIFIES JURY'S AWARD OF DAMAGES FOR DESIGN PATENT INFRINGEMENT AND RULES THAT A SOFTWARE PRODUCT CAN BE AN "ARTICLE OF MANUFACTURE" WHICH SUPPORTS AN AWARD OF THE INFRINGERS PROFITS UNDER THE DESIGN PATENT DAMAGES STATUTE

On May 8, 2018, the U.S. District Court for the Northern District of California, San Jose Division, issued an Order in which it modified an award of damages for design patent infringement that had been entered by a jury after a full trial. In *Microsoft Corp. v. Corel Corp.*, Case No. CV-15-05836-EJD (N.D. Cal 2018), Microsoft had asserted that Corel infringed two of its utility patents, which were directed to user interfaces which control certain application software functionality, and four of its design patents, which were directed to the ornamental designs for certain graphical user interfaces. In general, these patents related to the operation and visual ornamental appearance of Microsoft's "ribbon" functionality, which is employed across its well-known software application products. Prior to trial, Corel acknowledged that it had infringed the Microsoft Patents, and that those patents were valid. Therefore, the only issue for the jury trial was the **amount** of damages that Corel was required to pay to Microsoft as a result of the infringement.

Microsoft, through its damages expert, Ms. Ambreen Salters, requested that Corel pay a "reasonable royalty" for its infringement of the utility patents under 35 U.S.C. 284, based on the 16-factor test set forth in the *Georgia Pacific* case. Ms. Salters also indicated that Microsoft was seeking an award of Corel's total profit that it earned from the sale of products that incorporated the patented designs, under the special design patent damages statute, 35 U.S.C. 289.

Under U.S. Patent law, 35 U.S.C. 287, damages cannot be recovered unless or until the infringer receives **notice** of the patents-in-suit, and then only for the period **after** such notice is provided. Under Section 287, such notice may be provided by 1) **marking** the patent owner's products or its packaging with the relevant patent number(s), which will give a general notice to the public, including the infringer; 2) providing **actual notice** of the patents directly to a potential infringer; or 3) **filing a lawsuit** against the infringer for infringement of those patents.

Under Section 287, Microsoft could only collect damages for patent infringement for acts of infringement that occurred **after** it was found to have given notice of its patents to Corel. Microsoft had alleged that it gave Corel actual notice of its patents during a telephone call that occurred in 2009. Corel alleged that Microsoft only gave notice of its **design patents** much later, when it actually filed the lawsuit in December 2015. There was no dispute that Microsoft had given Corel notice of its **utility patents** in 2009. However, the parties disputed whether Microsoft provided Corel with notice of its **design patents**.

At trial, Microsoft's damages expert, Ms. Salters, testified that Corel had only earned \$3.4 million in **total revenue** from the accused infringing Corel Home Office products since 2009, when they were introduced. The jury was asked specifically in its verdict form whether Microsoft had proven that it had given notice of its design patents to Corel prior to the date on which the lawsuit was filed. With respect to each Microsoft design patent, the jury determined that Microsoft **had not proven** that it had given notice of its patents to Corel prior to the date that the lawsuit was filed in December 2015. Therefore, Microsoft could only recover the total profit under Section 289 that Corel earned from its infringing Home Office Product based on the sales that took place from December 2015 through the date of the trial, which was substantially less than the \$3.4 million that had been earned by Corel from sales of those infringing products since 2009.

Microsoft reduced the amount of money it was seeking from Corel even further when Ms. Salters testified that she had based the "reasonable royalty" component of Microsoft's damages request primarily on the cost that Corel would have incurred to re-engineer the software functionality for its infringing products in order to avoid infringement of Microsoft's utility patents. This is one of the factors that should be considered under the *Georgia Pacific* decision. According to *Georgia Pacific*, the reasonable royalty is calculated based on a "hypothetical negotiation" for a license to the Microsoft patents that would have taken place between Microsoft and Corel at the time Corel began its infringement in 2009 when it launched its Corel Home Office Product.

At that time, Corel would have known that it would have been able to redesign its product by using Microsoft's free "ribbon API" to replace the infringing "ribbon" functionality of the Corel user interface. Therefore, Corel could have used a no-cost licensed version of Microsoft's own "ribbon" functionality, rather than commit the infringement. Therefore, Corel would have easily ceased infringement in 2009 without causing substantial damage to Microsoft. Such an easy design-around, which would have hypothetically been implemented at the time the infringement began in 2009, acts as a "cap" or limit on the reasonable royalty damages that Microsoft could recover, because it would have stopped the infringement. Ms. Salters calculated that this cost would be only \$25,000, which would be the "reasonable royalty" for infringement of the Microsoft utility patents. Therefore, this damage calculation did not involve applying a percentage "reasonable royalty rate" to the \$3.4 million in sales of the infringing Corel Home Office products since 2009, which would have been the typical method of calculating damages for utility patent infringement in a case

such as this.

With respect to the profit that Corel had earned from the sale of Corel Home Office products beginning in December 2015, Ms. Salters calculated that amount to be only \$74,000 (based on total revenue for this shorter time period of only \$256,000), for a total amount of damages for patent infringement of \$99,000. The jury found that Corel had willfully infringed Microsoft's patents, and awarded Microsoft a total of \$287,000 in damages. This was substantially more than the total amount that Microsoft had requested.

Therefore, Corel filed a post-trial motion with the Court for "remittitur" to reduce the amount of damages awarded by the jury to reflect the \$99,000 amount that was requested at trial by Microsoft. Corel also sought to avoid "enhanced damages" under 35 U.S.C. 284 for its willful infringement of Microsoft's patents, which could have doubled or tripled the amount of the jury's damage award, and it also argued that Microsoft should not recover *both* a reasonable royalty from Corel's infringement of its utility patent *and* an award of Corel's profits for infringement of its design patents. Finally, Corel argued that Microsoft was not entitled to an award of Corel's profits from its sale of infringing products under the special design patent damages statute, Section 289. Microsoft brought its own post-trial motion in which it requested enhanced damages from Corel, as well as for an award of its attorneys' fees and court costs because this was an exceptional case under 35 U.S.C. 285.

On May 8, 2018, the District Court decided the parties' post-trial motions. The District Court granted Corel's motion for remittitur and reduced the jury's damages award to the \$99,000 that Microsoft's damages expert had calculated as the proper amount. On the other hand, the District Court agreed with Microsoft that this damage award should be "enhanced" (*i.e.*, increased) as a result of Corel's willful infringement of Microsoft's patents. Under Section 284 of the Patent Act, a court "may increase damages up to three times the amount found or assessed" in instances where a jury finds that the infringement is willful. The Court found that Corel's efforts to copy Microsoft's Ribbon interface were deliberate, and that Corel at least had some awareness that it could be infringing Microsoft's patent rights in the process.

Evidence presented at trial established that Corel desired to introduce a copy of Microsoft Office that was available "at a fraction of the price." Corel also ignored concerns raised both inside the company and from its customers that the ribbon user interface used by its Home Office product infringed Microsoft's intellectual property rights. Microsoft informed Corel in 2009 that its Home Office product infringed Microsoft's patents, but Corel made no attempt to redesign that product or to stop selling it, because Corel considered it "a very small matter," and that they could negotiate a license with Microsoft to resolve the issue. Corel's decision to continue its infringement therefore amounted to willfulness. As a result, the District Court increased the damage award to \$124,000.

The District Court also found that Microsoft had not obtained a duplicate recovery for patent infringement by requesting a reasonable royalty for infringement of its utility patents and an award of Corel's profits for infringement of its design patents. Under U.S. patent law, a patent owner cannot recover damages under *both* Section 284 (reasonable royalty) and Section 289 (profits from the sale of the infringing design) for the same *sale* of an infringing product. However, Microsoft was entitled to recover a reasonable royalty as damages for infringement of its utility patents beginning in 2009, because it had given proper notice to Corel of those utility patents at that time. Therefore, the jury properly awarded Microsoft \$25,000 as the reasonable royalty.

For the period from December 2015 until the trial of the case in February 2018, Microsoft only requested an award of Corel's profits for infringement of its design patents in the amount of \$74,000. The two types of patents, utility and design, cover different categories of property rights. Therefore, the Court found that there was no overlapping of damages between the infringement of Microsoft's utility patents and infringement of its design patents.

However, the most significant decision that the District Court made was to deny Corel's motion to prevent Microsoft from recovering the profits from its sale of the Home Office Product under the special patent damages statute, 35 U.S.C. 289. Corel had argued that Microsoft's design patents claim a "display screen" as their article of manufacture. Therefore, according to Corel, Microsoft was not entitled to an award of their profits because Microsoft only presented evidence that Corel earned profits from the sale of a software product (*i.e.*, Corel Home Office), and not a physical display screen. The District Court disagreed. It interpreted Section 289 to involve two steps. First, an "article of manufacture" to which the infringed design has been applied must be identified. Then, the total profit made from the sale of that article of manufacture must be calculated. The District Court noted the broad definition that the Supreme Court gave to the term "article of manufacture" in Section 289 in *Samsung Elecs. Co. v. Apple Inc.*, as "a thing made by hand or machine." The Court found that software meets this definition, and can thus be an "article of manufacture." According to the Court, Microsoft is not precluded from receiving an award of Corel's profits because the infringing article is a software product. Microsoft's design patents for its Ribbon interface all claim "[t]he ornamental design for a user interface portion of a display screen, as shown and described. Thus, the Microsoft design patent claim a design for a "user interface," and it is possible to apply the patented design to the user interface of a software product and therefore infringe.

If the District Court's interpretation and application of Section 289 to design patents which claim graphical user interfaces that are shown on a display screen is upheld by the U.S. Court of Appeals for the Federal Circuit, it will represent a confirmation of the value of design patents which claim those interfaces, which have grown exponentially in numbers in recent years along with the development of technology.

USPTO UPDATES GUIDANCE ON COMPLYING WITH THE WRITTEN DESCRIPTION REQUIREMENT IN DESIGN PATENT CASES

The USPTO recently revised the guidance that it provides in the Manual of Patent Examination Procedure ("MPEP") for complying with the written description requirement of 35 U.S.C. 112(a) and avoiding the introduction of new matter in design patent applications. This guidance represents the Office's most current statement of its examination policies regarding the interpretation and application of the written description requirement to design patent cases. Those policies are intended to be used by design patent examiners when reviewing design patent applications during their review of design patent applications. The Office's revisions represent an update of those guidelines to include a discussion of recent decisions of the U.S. Court of Appeals for the Federal Circuit, in which the Court has interpreted the written description requirement of Section 112(a) and applied it to several factual situations that may arise in design patent practice. Those decisions are binding on the USPTO,

The written description requirement of Section 112(a) must be complied with whenever the design claim is amended, such as by making changes to the drawing figures of the application. It is also a critical issue

whenever a continuation application is filed which claims domestic priority back to the earlier filing date of a parent application. Failure to comply with the written description requirement will result in a rejection of the design claim in the former circumstance, and will result in an objection to the Applicant's claim of domestic priority in the latter. It is common in U.S. design patent practice for the drawing figures to be presented which show the design with some or all of the features in solid lines (which indicate that they are claimed), while the remaining features of the design are shown in broken lines (to indicate that they are not claimed).

Applicants may later amend the drawing figures, and hence the design claim, during the prosecution of the application by either converting claimed solid line features to broken lines, in order to remove them from the design claim, or by converting features from broken lines to solid lines in order to claim them. Applicants do this in order to change the scope of the design claim by claiming different combinations or subsets of the features that are shown in the drawing figures, such as to avoid the prior art that has been cited by the Examiner. Applicants may also file continuing design patent applications which claim different subsets or combinations of features of the design as it was originally disclosed, or they may seek a reissuance of an already granted design patent in order to broaden or narrow the scope of the design claim. Those actions must also comply with the written description requirement.

The Office's interpretation and application of the written description requirements to design claims has been one of the most controversial issues in U.S. design patent practice in recent years. Attorneys representing design patent applicants have for several years expressed their dissatisfaction with the way that design patent examiners have applied the written description requirement in order to reject or object to design claims during prosecution. The Office held a Roundtable Discussion with design patent practitioners and interested members of the design community on March 5, 2014 to solicit public comments regarding the application of the written description requirement in instances where a design claim has been amended, or where a continuing or reissue design application has been filed which claims a different subset or combination of features than were originally claimed. Several intellectual property organizations (such as the American Intellectual Property Law Association and the Intellectual Property Owners), industrial design experts and prominent law firms (including NSIP Law) provided their comments in oral presentations or in written submissions.

The oral presentations and written comments that resulted from the roundtable were generally critical of the Office's interpretation and application of the written description requirement to design patent cases, particularly because the Office was not applying the rulings of the Federal Circuit in its recently-decided cases. Two years later on April 15, 2016, the U.S. Patent and Trademark Office followed up on the Roundtable Discussion by issuing a Notice in the Federal Register in which it proposed new examination guidelines for the written description requirement of 35 U.S.C. 112(a) that will be applied to design patent applications. The Office requested comments to the proposed examination guidelines, as well as examples of how those guidelines may be implemented. The Notice included an extensive discussion of the recent Federal Circuit decisions that interpreted and applied the written description requirement of Section 112(a) to design patent cases. The comments that were submitted, including those of NSIP Law, were generally supportive of the new guidelines, because they followed the current legal pronouncements of the Federal Circuit on the written description issue.

During the four (4) year period from 2014 until 2018 during which Office debated and finalized these examination guidelines, the Office interpreted and applied them broadly, so that Examiners routinely rejected design claims that had been amended, or objected to design claims that had been presented as part of continuing design patent applications. The Examiners typically argued that the amended design claim allegedly failed to provide a written description that supported the change in the subset or combination of design features that were claimed. The Examiners would regularly argue that the original disclosure of the design that was provided in the parent application did not provide a specific identification, or provide specific guidance that would have directed a designer of ordinary skill in the art to select the individual feature or the particular combination or subset of features that were claimed in the amendment or continuation application, and recognize that they could be claimed as a separate design invention. Unfortunately, the Office neglected to provide guidance or examples for how the drawing figures or written specification of the original application could provide the specific identification of the newly-claimed combination or subset of design features that the Examiners required. This created confusion among applicants and their attorneys regarding how they may best prepare their original application filing for a particular design in order to anticipate future issues relating to the written description requirement. A tremendous amount of controversy and uncertainty in this area of design patent practice was the result.

The practical effect of this examination policy has been, in many instances, the denial of the right to amend the drawing figures (which define the design claim) in any way which changed the grouping of the claimed features. As a result, it was very difficult for an applicant to narrow the scope of the design claim in order to, for example, avoid prior art that had been used to reject the application, or correct alleged inconsistencies in the drawing figures that the Examiner had pointed out. This practice also made it challenging for an applicant to claim domestic priority for a continuation application back to the earlier filing date of its parent application, or to seek a broadening of a design claim through the Office's patent reissue process.

In the revisions to MPEP 1504.05 regarding the written description requirement that the Office has now issued, the Office has acknowledged that the scope of a design claim is defined by what is shown in full lines in the application drawings, not what is shown or not shown in the broken lines that define unclaimed subject matter. The Office has also acknowledged the Federal Circuit's ruling in *Racing Strollers Inc. v. TRI Industries Inc.*, 878 F.2d 1418, 1420, 11 USPQ2d 1300, 1301 (Fed. Cir. 1989) (*en banc*), that “[a]s a practical matter, meeting the [written description] requirement of § 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 and claimed therein” As long as the features that are claimed in the amended or continuation application may be seen in the original disclosure of the design, and those features have the same visual appearance, the written description requirement should be met under the *Racing Strollers* decision. Subsequent decisions by the Federal Circuit explain that the written description analysis must be conducted from the perspective of an ordinary designer.

The revised MPEP provisions also provide guidance for applying these general principles to specific situations in the design patent context to determine whether the written description requirement of Section 112(a) has been complied with. That guidance is generally favorable to applicants, with one exception. In determining whether a design claim complies with the written description requirement, Examiners have been instructed to consider that “the written description question does not turn upon what has been disclaimed, but

instead upon whether the original disclosure ‘clearly allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is *claimed*.’”

As noted above, the Office acknowledged that issues of compliance with the written description requirement may arise where an amended claim or a claim in a continuing design application (i.e., a later-claimed design) is composed of only a subset of elements of the originally disclosed design. As examples, the Office discusses common situations where the later-claimed design converts originally-disclosed solid line structure to broken lines or converts originally-disclosed broken line structure to solid lines, but does not introduce any new elements that were not originally disclosed. The Office concludes that “[i]n the vast majority of such situations, the examiner will be able to determine based on a review of the drawings that the inventor had possession of the later-claimed design at the time of filing the original/earlier application,” citing the *Racing Strollers*, decision. This broad interpretation of the written description requirement should be very favorable to applicants, because if an Examiner can see the features in the amended design claim in the original drawing figures, and the visual appearance of those features has not changed, then the Examiner should find that the written description has been complied with. This will most likely result in fewer instances where a rejection of a design claim or an objection to an Applicant’s claim of domestic priority will be entered, so that fewer amendments to the design claim and fewer continuation applications will be called into question.

However, the revised MPEP guidelines also provide an opening for Examiners to question whether an amendment to a design claim or a revised design claim in a continuation application finds written description support in the original disclosure, based on similar arguments that they relied upon before the revisions to the MPEP. MPEP 1504.04 now provides that

“In limited situations, however, the Examiner will not be able to conclude based on a simple review of the drawings that the inventor had possession of the later-claimed design at the time of filing the original/earlier application. That is, even though elements of the later-claimed design may be individually visible in the original/earlier disclosure (whether shown in solid or broken lines), additional consideration is required by the examiner to determine whether the later-claimed design was reasonably conveyed to the ordinary skilled designer and therefore, supported by the original/earlier disclosure. As with all determinations for compliance with the written description requirement, the examiner should consider what design the original/earlier application -- in its totality- - would have reasonably conveyed to an ordinary designer at the time of the invention.”

This exception to the general rule appears to allow Examiners to reject an amendment, or object to a claim of domestic priority even if they are able to see the same features that are now claimed in the original drawing figures without any change in their visual appearance. The Examiners may do so if they do not believe that the changes to the design claim would have been recognized by a designer of ordinary skill in the art. Unfortunately, the Office fails to provide examples for when it is proper for Examiners to rely on this exception to enter a rejection or objection, thus leaving it to the Examiner’s discretion to interpret and apply this provision to many different situations.

Although hopefully this exception will only be used in extreme situations where the amended/revised design claim looks nothing like the original design, there is always the risk that it will be used by Examiners to continue to enter the same rejections and objections based on the written description requirement that the Office’s revised examination policies were intended to end. As these changes to MPEP 1504.04 are still

relatively new, only time will tell whether rejections or objections based on the written description requirement will become an infrequent occurrence, or whether the exception will swallow the rule.

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