On April 15, 2016, the U.S. Patent and Trademark Office (“USPTO”) published a Request for Comments on the Application of the Written Description Requirement to Specific Situations in Design Applications (“Request”). See 81 F.R. 73, pp. 22233-22236. In particular, the USPTO is seeking the public’s help in identifying examples “to illustrate [its] proposed approach or any suggested approach for applying the written description requirement in design applications.” Id. (emphasis added).

Importantly, this Request also points out that “it became clear that there exists a need to supplement the current provisions in the Manual of Patent Examining Procedure (“MPEP”) relating to 35 U.S.C. 112 for design applications.” Id. (Stop the press! Does the Request really say that? Yes, yes it does. Please read on...)

According to today’s Request, the USPTO recognizes that:

in the vast majority of cases[,] there is no question that a later-claimed design [i.e., in a continuing design application], composed of only a subset of originally disclosed elements [in the parent application], satisfies the written description requirement. In certain limited situations, however, the subset of originally disclosed elements, although visible in the original disclosure, composes a later-claimed design that an ordinary designer might not have recognized in the original disclosure. In those certain limited situations, a question arises as to whether the later-claimed design satisfies the written description requirement.

81 F.R. 73, p. 22234 (emphases added). Previously, the USPTO had proposed an enumerated factors-based approach for design examiners to evaluate compliance with the written description requirement. This builds from the USPTO’s earlier Request for Comments and Notice of Roundtable Event on the Written Description Requirement for Design Applications of February 6, 2014, and subsequent roundtable event held on March 5, 2014, which were previously reported in this blog (here). See also 79 F.R., pp. 7171-7173. However, as indicated in today’s Request, the USPTO ultimately “decided not to pursue the factors-based approach” set forth in the earlier Request and discussed during the roundtable event. 81 F.R. 73, p. 22233.

Section II of today’s Request then outlines general principles in evaluating compliance with the written description requirement for design applications. For example, the Request recognizes that the “test for sufficiency of written description is the same for design and utility patents,” with citation to In re Daniels, 144 F.3d 1452, 1456 (Fed. Cir. 1998). And, referring to Daniels, such a written description analysis “must be conducted from the perspective of an ordinary designer.” In a nod to In re Owens, 710 F.3d 1362 (Fed. Cir. 2013), the Request notes that these principles are articulated again therein. See our previous post on In re Owens (here).

Section III of the Request discusses another proposed approach to apply these general principles in “limited situations … where a later-claimed design, composed of only a subset of originally disclosed elements (claimed or unclaimed), raises a question as to whether the later-claimed design is supported by the original/earlier disclosure, even though the elements composing the later-claimed design are visible in the original/earlier disclosure.” 81 F.R. 73, p. 22235 (emphasis added). The USPTO proposes that in such situations, “the examiner would determine whether an ordinary designer would recognize upon reviewing the complete original/earlier application that the inventor had possession of the later-claimed design in the original/earlier disclosure.” Id.

To make this determination, the USPTO proposes that the examiner consider “what the original/earlier application, in its totality (e.g., including the title, any descriptive statements, and the drawings), would have reasonably conveyed to an ordinary designer at the time of the invention, and how an ordinary designer in the art would have designed the article that is the subject of the design claim.” Id. According to the Request, such considerations “can include the nature and intended use of the article embodying the claimed design as identified by the title or description.” Id. Thereafter,
“the examiner would reject the design claim for lack of written description (or in the case of a priority or benefit claim, the application would not be entitled to the earlier date)” if he or she “determines that [upon reviewing the complete original/earlier application,] an ordinary designer would not recognize … the later-claimed design in the original/earlier disclosure.” *Id.*

Accordingly, the USPTO requests written comments from the public, including specific examples “that demonstrate adequate written description as well as examples that demonstrate a lack of written description.” *Id.*, p. 22236. Importantly, the USPTO indicates that it “would be most helpful” to receive “examples of situations in which the presence or lack of written description is not readily apparent, *i.e.*, examples that are close to the line between adequate written description and insufficient written description.” *Id.*

Those of us in the design practitioner community should heed today’s Request, especially considering that well-formulated examples might influence a supplement to the MPEP. The topic of this Request will almost certainly be discussed during the upcoming 2016 USPTO Design Day, which will be held on April 19th. We will report on Design Day in a future post.

**Tags:** Design Day, Design Patents, Prosecution, USPTO, Written Description

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