[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO-P-2014-0002]

Request for Comments and Notice of Roundtable Event on the Written Description Requirement for Design Applications

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of public meeting; request for comments.

SUMMARY: The United States Patent and Trademark Office (Office) is hosting a roundtable event to solicit public opinions regarding the written description requirement as applied to design applications in certain limited situations. Members of the public are invited to participate. The roundtable will provide a forum for an informal discussion of the topics identified in this notice. Written comments in response to these topics also are requested.

DATES: Event: The roundtable event will be held on March 5, 2014, beginning at 1:00 p.m. Eastern Daylight Time (EDT), and ending at 4:00 p.m. EDT.

Comments: Written comments must be received on or before March 14, 2014 to ensure consideration.

Registration: Registration is required to attend the roundtable in person or via Web cast. Additionally, members of the public who wish to participate in the roundtable as a speaker must do so by request in writing no later than February 14, 2014. See the "Registration Information" section of this notice for additional details on how to register.

ADDRESSES: Event: The roundtable event will be held in the Madison Auditorium on the concourse level of the Madison Building, which is located at 600 Dulany Street, Alexandria, Virginia 22314**.**

Comments: Any member of the public, whether attending the roundtable or not, may submit written comments on any of the topics identified in section III, below, for consideration by the Office. Persons submitting written comments should note that the Office will not provide a response because this notice is not a notice of proposed rulemaking. Written comments should be sent by electronic mail addressed to DesignRoundtable2014@uspto.gov. Comments also may be submitted by mail addressed to: Mail Stop Comments – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Nicole Dretar Haines. Although comments may be submitted by mail, the Office prefers to receive comments via the Internet. To ensure consideration, written comments must be received on or before March 14, 2014.

Comments will be available via the Office's Internet Web site at http://www.uspto.gov/patents/init_events/index.jsp, and will be available for public inspection at the Office of the Commissioner for Patents, located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia 22314, upon request. Because comments will be available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

EVENT REGISTRATION INFORMATION: There is no fee to register for the roundtable, and registration will be on a first-come, first-served basis. Additionally, members of the public who wish to participate in the roundtable as a speaker must do so by request in writing no later than February 14, 2014. Registration on the day of the roundtable will be permitted for members of the public who wish solely to observe on a space-available basis beginning 30 minutes before the roundtable.

To register, please send an e-mail message to DesignRoundtable2014@uspto.gov and provide the following information: (1) Your name, title, and if applicable, company or organization, address, phone number, and e-mail address; (2) whether you wish to attend in person or via Web cast; and (3) if you wish to make an oral presentation at the roundtable, which of the topics identified in section III, below, will be addressed and the approximate desired length of your presentation. Each attendee, even if from the same organization, must register separately.

Due to time constraints, there is the potential that not all persons who wish to make a presentation will be accommodated. However, the Office will attempt to accommodate all

persons who wish to make a presentation at the roundtable event. After reviewing the list of speakers and the information regarding the presentations provided in the registration, the Office will contact each speaker prior to the event with the amount of time available and the approximate time that the speaker's presentation is scheduled to begin. The amount of time available for each presentation will be limited to ensure that all persons selected to speak will have a meaningful chance to do so. Speakers must send the final electronic copies of their presentations in Microsoft PowerPoint or Microsoft Word to DesignRoundtable2014@uspto.gov by February 26, 2014, so that the presentation can be displayed at the roundtable. If time permits, the Office will provide an opportunity for persons in the audience not previously selected as speakers to speak at the roundtable without a formal presentation.

The Office plans to make the roundtable event available via Web cast. Web cast information will be available on the Office's Internet Web site before the roundtable event at http://www.uspto.gov/patents/init_events/index.jsp.

If special accommodations due to a disability are needed, please inform the contact person(s) identified below.

FOR FURTHER INFORMATION CONTACT: Requests for additional information regarding registration and speaker presentations should be directed to the attention of Robert Olszewski, Director, Technology Center 2900, by telephone at 571-272-2200, or by e-mail to robert.olszewski@uspto.gov. Requests for additional information regarding the topics for written comments and discussion at the roundtable event should be directed to Nicole Dretar

Haines, Senior Legal Advisor, Office of Patent Legal Administration, by telephone at 571-272-7717, or by e-mail to nicole.haines@uspto.gov.

SUPPLEMENTARY INFORMATION:

I. Purpose of Notice: This notice is directed to announcing a roundtable event to solicit public opinions concerning the topics identified in section III, below, relating to the written description requirement under 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph) (hereinafter collectively referred to as "35 U.S.C. 112(a)") as applied to design applications. The topics selected for comment and discussion have been chosen based on input the Office received following the Seventh Annual Office Design Patent Conference "Design Day 2013: Designs in the New Digital Age" (Design Day) held on April 23, 2013. The public is invited to provide comments on these topics and to identify future topics for discussion.

II. Background: A question as to whether an originally disclosed design provides an adequate written description may arise where a new or amended claim is presented, or where a claim to entitlement of an earlier priority date or effective filing date (e.g., under 35 U.S.C. 120) has been made. During discussions between the Office and members of the public attending Design Day, some attendees requested that the Office reconsider how the written description requirement under 35 U.S.C. 112(a) is applied to design applications where only a subset of elements of the original disclosure are shown using solid lines in an amendment or continuation application. In

order to obtain a better understanding of the attendees' concerns, the Office is hosting this roundtable event.

III. Topics for Written Comments and Discussion at the Roundtable Event: The Office 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.[1] Specifically, the Office seeks input on the following topics relating to the written description requirement under 35 U.S.C. 112(a) as applied to design applications in certain limited situations.

A. Factors in Determining Whether an Amended/Continuation Design Claim Satisfies the Written Description Requirement

It has been the experience of the Office that in the majority of cases there is no question that the amended/continuation design claim satisfies the written description requirement. However, in some rare situations, it has been the experience of the Office that a question may arise as to whether the applicant had possession of the newly claimed design at the time of filing the original application, where the design results from the applicant including only a subset of seemingly unrelated, originally disclosed elements in the claim by way of an amendment or continuation application.

[1] The Office is not seeking comments on the issue of the introduction of boundary lines via amendment or in a continuation application, as addressed in In re Owens, 710 F.3d 1362 (Fed. Cir. 2013).

At Design Day, during the Office's presentation titled "More About Written Description Requirement of 35 U.S.C. 112(a)" (available on the Office's Internet Web site at http://www.uspto.gov/patents/init_events/index.jsp), specific examples illustrating an original design claim and an amended design claim were discussed where, in the amended claim, only a subset of seemingly unrelated elements of the original disclosure were shown using solid lines. Some members of the public attending Design Day raised concerns regarding the Office's position that the inventor may not have had possession of the newly claimed design in some of these examples. See, e.g., the Office's presentation titled "More About Written Description Requirement of 35 U.S.C. 112(a)" at slide 8. These attendees took the position, relying on Racing Strollers Inc. v. TRI Industries Inc., 878 F.2d 1418, 1420 (Fed. Cir. 1989), that as long as the subset of elements forming the newly claimed design were contained in the originally filed drawings, the written description requirement of 35 U.S.C. 112(a) is satisfied and no further analysis is needed.

Accordingly, input is requested as to whether it would be useful for design examiners to consider any of the following factors in determining whether an amended/continuation design claim, which includes only a subset of the originally disclosed elements (no new elements are introduced that were not originally disclosed), satisfies the written description requirement. These factors would only be applied by design examiners in the rare situation where there is a question as to whether an amended/continuation design claim satisfies the written description requirement. The factors are as follows:

(1) the presence of a common theme among the subset of elements forming the newly identified design claim, such as a common appearance;

(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);

(3) the subset of elements forming the newly identified design claim is a self-contained design within the original design;

(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; and/or

(5) the subset of elements forming the newly identified design claim gives the same overall impression as the original design claim.

The Office also seeks comments on any additional factors, not listed above, 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. Further, the Office seeks comments on the potential advantages and/or disadvantages of using such a factors-based approach.

Examples that can be used to aid discussion of the factors identified above will be made available on the Office's Internet Web site at http://www.uspto.gov/patents/init_events/index.jsp prior to the roundtable event.

B. Establishing Adequate Written Description Support in the Original Disclosure

Additionally, the Office seeks comments on whether there are mechanisms applicants can use to demonstrate that they had possession of designs claimed in future amendments/continuation applications at the time their original applications were filed. For instance, the Office seeks comments on whether use of a descriptive statement in the originally-filed application (e.g., that specifically identifies different combinations of elements which respectively form additional designs) could be a meaningful way for applicants to demonstrate that they had possession of designs claimed in future amendments/continuation applications. The Office's initial impression is that generic boilerplate statements would not adequately reflect what the designer had in his or her possession at the time of filing the application.

Dated: January 31, 2014._ _____

Michelle K. Lee,
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office.

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