

Emerging Technologies

March 25, 2014



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Peer to Patent

- A website hosted by NY Law School and in cooperation with the USPTO
- Peer to Patent was a Third Party Submission pilot conducted from 2007-2011 under 37 CFR 1.99
- Increased the time for submission of third party documents, allowed a brief description and used Internet crowdsourcing techniques
- Required consent by applicants
- Participation was good but tempered
- Demonstrated that public interaction is possible in uncovering useful prior art



America Invents Act

- Signed on September 16, 2011
- Preissuance Submissions provision became effective September 16, 2012
 - Allows electronic filing of up to three documents at no cost, limited to 10 documents per submission
 - Requires concise description of each document
 - May be filed the later of, up to 6 months from publication of an application or before the FAOM
 - Although a signature of the submitter is required, the real party of interest may remain anonymous



Third-Party Submissions Website

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- Patent Prosecution Highway
- Patents for Humanity

International Cooperation
Employee Locator

Preissuance Submissions ("Third Party Submissions")

35 U.S.C. 122(e) provides a mechanism for third parties to submit patents, published patent applications, or other printed publications of potential relevance to the examination of a patent application with a concise description of the asserted relevance of each document submitted. Under 35 U.S.C. 122(e), such submissions may be made before (1) the later of (i) 6 months after the date of publication or (ii) the date of a first Office action on the merits rejecting any claims, or (2) before the date of a notice of allowance, if earlier. Section 122(e) also provides for such fees as the Director may prescribe. This new provision was effective on September 16, 2012, and applies to any patent application.

NOTE: Some material listed on this page may require a plug-in or viewer, [available here](#).

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USPTO-led Executive Actions

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International Cooperation

USPTO-led Executive Actions on High Tech Patent Issues



On June 4, 2013, President Obama [announced](#) five executive actions "to help bring about greater transparency to the patent system and level the playing field for innovators." Four of these actions were undertaken by the USPTO. On February 20, 2014, the President [announced](#) three new initiatives aimed at encouraging innovation and strengthening the "quality and accessibility of the patent system." Below is a summary of the initiatives that the USPTO has implemented to realize the President's vision.

- [Announcements](#)
- [Executive Action 1: Attributable Patent Ownership \(formerly "Real Party in Interest"\)](#)
- [Executive Action 2: Clarity in Patent Claims \(formerly "Tightening Functional Claiming"\)](#)
- [Executive Action 3: Empowering Downstream Users](#)
- [Executive Action 4: Expanded Outreach and Focused Study](#)
- [Executive Action 5: Crowdsourcing Prior Art](#)
- [Executive Action 6: More Robust Technical Training and Expertise](#)
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Roundtable Event

- To solicit public opinions regarding the use of crowdsourcing and third-party preissuance submissions to identify prior art and enhance the quality of examination as well as the quality of issued patents
- Thursday, April 10, 2014, 12:30 – 5:00 p.m. EDT
- USPTO headquarters in Alexandria, VA
- Deadline to submit comments: April 25, 2014



Helpful Links

- Preissuance Submissions Website

http://www.uspto.gov/patents/init_events/preissuance_submissions.jsp

- USPTO – led Executive Actions

http://www.uspto.gov/patents/init_events/executive_actions.jsp#heading-6

- Federal Register Notice and Roundtable event

<http://www.gpo.gov/fdsys/pkg/FR-2014-03-19/pdf/2014-05996.pdf>

http://www.uspto.gov/patents/init_events/crowdsourcing_roundtable_04-2014.jsp



Thank You

PATENTING EMERGING TECHNOLOGIES: 3D PRINTING

Bryan J. Vogel

Robins, Kaplan, Miller & Ciresi L.L.P.

IPO PTO Day

Washington, DC

March 25, 2014

ROBINS, KAPLAN, MILLER & CIRESI L.L.P.

In the Headlines

- › “Printing a bit of me” (The Economist)
- › “What Happens When 3D Printing Turns Consumer Products Into Digital Content?” (Forbes)
- › “The 3D printing revolution might be Lego's biggest test ever” (Washington Post)
- › “Surgeons reconstruct baby's skull with 3D printing technology” (Fox News)
- › “Caterham drives F1 car design with 3D printing” (Financial Times)
- › “How NASA Is Launching 3D Printing Into Space” (Space.com)
- › “3D-printed exoskeleton helps paralyzed skier walk again” (CNET)
- › “Surgeons use 3D-printed heart to save a child's life, study heart defect” (ExtremeTech)
- › “3D printing lab opens new window into cancer research” (Phys.Org)
- › “Print your food: 3D printing accelerating food product development” (SiliconANGLE)
- › “Printshow NYC: 3D Printing Comes to Fashion, Medicine, and Art” (Popular Mechanics)
- › “3D Printing Saves a Baby's Life-Again” (HealthTechZone)
- › “3D Printed Clothing Debuts on the Runway During Fashion Week” (NY1)
- › “Will You Soon Be Able To Print Your Own 3D Burger?” (NYU Local)
- › “Shoes That Perfectly Fit Are Coming Soon Via 3D Printers” (WebProNews)

Of Interest to the USPTO

- › “USPTO to Host Additive Manufacturing Partnership Meeting”
– January 23, 2013
- › “USPTO to Host Additive Manufacturing Partnership Meeting”
– April 9, 2014

Of Interest to the White House

- › February 12, 2013
 - President Barack Obama
 - State of the Union Address



- › "Last year we created our first manufacturing innovation institute in Youngstown, Ohio... where workers are mastering 3D printing that has the potential to revolutionize the way we make almost everything."

Of Interest to the Financial Industry

- › Goldman Sachs recently cited 3D printing as one of eight trends poised to disrupt industries.
- › Analyst group Gartner recently projected that, by 2018, 3D printing will result in global annual IP losses of approximately \$100 billion. Made during the October Gartner Symposium/IT Expo 2013, the forecast was one of ten “Top Predictions for 2014” Gartner released.
- › *The Economist* has even gone so far as to suggest that this technology heralds a "third industrial revolution."

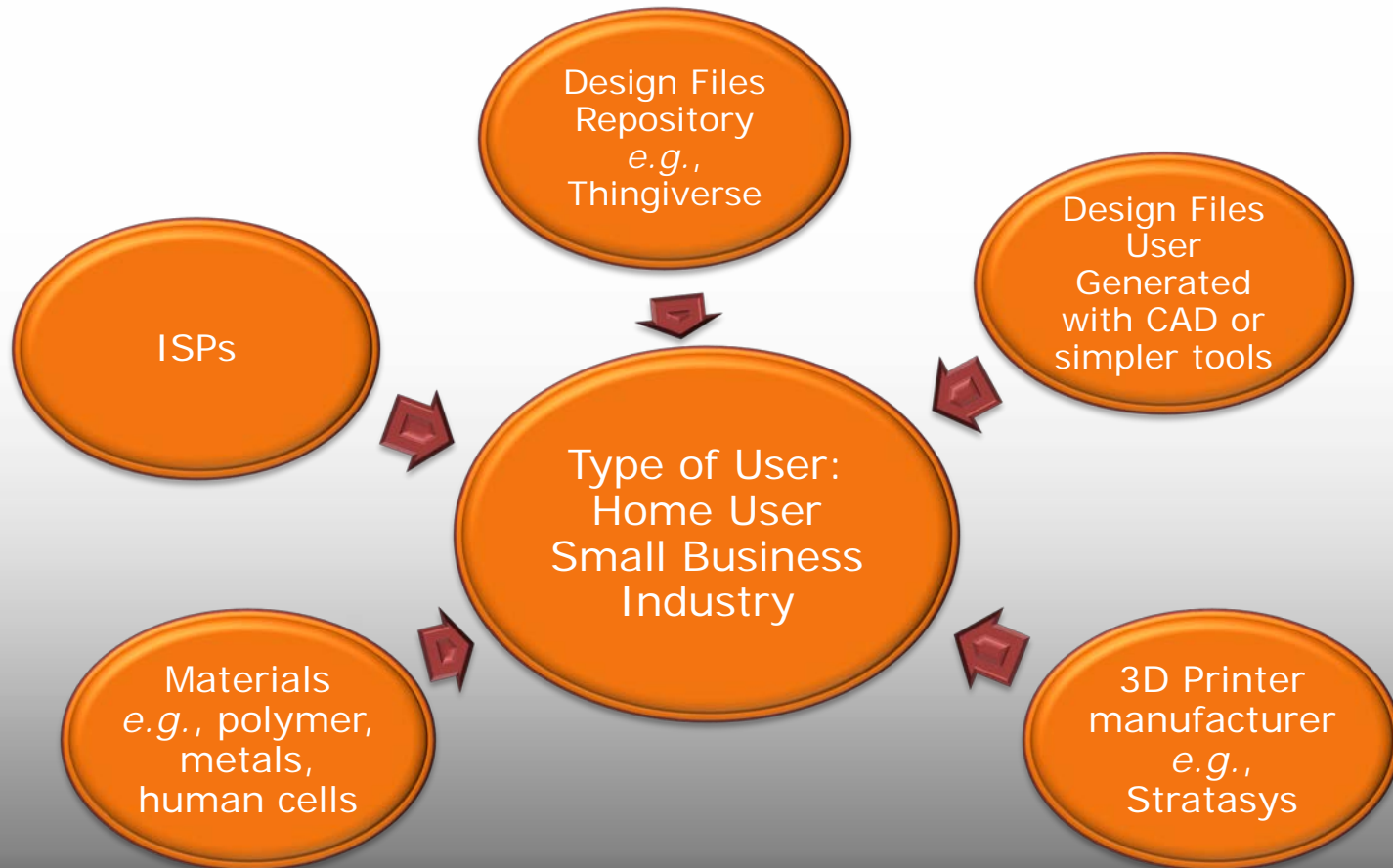
What is 3D Printing?

- › Uses CAD/CAM digital blueprint files or scans to create or copy objects that would otherwise often be impossible to build.
- › Work like inkjet printers—but, instead of a single layer of ink, the technology deposits the desired material in successive layers to create a physical object.
- › Materials ranging from polymers, plastic, resin, titanium, gold and silver, human cells and even nano-particles.

Industry Impact

- › Aerospace
- › Chemical/Plastics
- › Clothing
- › Consumer products
- › Electronics
- › Food
- › Manufacturing
- › Medical
- › Software
- › Transportation

Technology Impact



History of 3D Printing

- › 1984 – Charles Hull developed printing physical 3D objects from digital data
 - › Named stereo lithography
 - › Obtained a patent in 1986
- › Since then, other similar technologies, such as fused deposition modeling (FDM), selective laser sintering (SLS) and multi-jet modelling (MJM) have been introduced.

3D Printing Technologies

› Stereo lithography

- › Position a perforated platform just below the surface of a vat of liquid photo curable polymer.
- › A UV laser beam then traces the first slice of an object on the surface of this liquid, causing a very thin layer of photopolymer to harden.
- › The perforated platform is then lowered very slightly and another slice is traced out and hardened by the laser.
- › Another slice is then created, and then another, until a complete object has been printed and can be removed from the vat of photopolymer, drained of excess liquid, and cured.

3D Printing Technologies (cont'd)

- › Fused deposition modelling (FDM)
 - › Hot thermoplastic is extruded from a temperature-controlled print head to produce fairly robust objects to a high degree of accuracy.
- › Selective laser sintering (SLS)
 - › Builds objects by using a laser to selectively fuse together successive layers of a cocktail of powdered wax, ceramic, metal, nylon or one of a range of other materials.
 - › With this technology it is possible to print plastic, metal, ceramic, or glass — virtually anything that can be released as a powder and heat-fused to a growing print.
- › Multi-jet modelling (MJM)
 - › This again builds up objects from successive layers of powder, with an inkjet-like print head used to spray on a binder solution that glues only the required granules together.

U.S. Patent Filings

- › January 2014, patent concerning selective laser sintering (SLS) expired.
- › After the expiration of the patent for fused deposition modeling (FDM), an enormous open source movement appeared almost overnight.
- › During the last decade, USPTO has received more than 6,800 patent applications related to 3D printing
 - › Since 2007, about 680 patents a year have been filed —39.6% more than 2002, when 487 patents were filed.
 - › Since 2003, USPTO has granted 3,500 patents related to 3D printing.

U.S. Patent Filings (cont'd)

- › 3D Systems: 252 / 100
- › ExOne: 0 / 2
- › MakerBot: 9 / 14
- › Objet: 31 / 15
- › Organovo: 0 / 5
- › Stratasys: 122 / 177
- › Voxeljet: 6 / 21

U.S. Patent Filings (cont'd)

- › Apple: December 26, 2013, 28 new patent applications from Apple published.
 - › Generally relate to assemblies, methods, and inkjet printers configured for printing on three dimensional objects.

Patenting

- › Despite multi-disciplinary nature of 3D printing, CPC B83 established for Additive Manufacturing
- › Most activity in:
 - › Class 264 (plastic and nonmetallic article shaping or treating: processes)
 - › Class 156 (adhesive bonding and miscellaneous chemical manufacture)
 - › Class 428 (stock material or miscellaneous articles)
 - › Class 425 (plastic article or earthenware shaping or treating: apparatus)

Patentability Issues in 3D Printing

- › 35 USC 102 – Inherency
- › 35 USC 103 – Obvious to make smaller (?)
- › 35 USC 112 – Enablement
- › Product-by-Process Claims
- › Recent USPTO Guidance For Determining Subject Matter Eligibility

35 USC 102 – Inherency

- › “[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999).
- › The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252 (CCPA 1977).
- › There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003).

35 USC 103 – Obviousness

- › Aren't inventors always motivated to make things smaller, faster, better? *Maybe, but...*
- › “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007).

35 USC 103 – Obviousness (cont'd)

- › Exemplary rationales that may support a conclusion of obviousness include:
 - › Combining prior art elements according to known methods to yield predictable results;
 - › Simple substitution of one known element for another to obtain predictable results;
 - › Use of known technique to improve similar devices (methods, or products) in the same way;
 - › Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

35 USC 103 – Obviousness (cont'd)

- › “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- › Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- › Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Case Law –Size/Proportion, Sequence

- › *In re Rinehart*, 531 F.2d 1048, 1053 (CCPA 1976)
 - “mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled”
- › *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984)
 - Where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.
- › *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959)
 - › Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.

35 USC 112 – Enablement

- › Scope of Enablement: Full scope of claims
- › Enablement for specific claimed use
- › When is a claim not enabled?
 - › Undue Experimentation
 - › *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988)

35 USC 112 – Enablement (cont'd)

› *Wands* factors

- › The breadth of the claims;
- › The nature of the invention;
- › The state of the prior art;
- › The level of one of ordinary skill;
- › The level of predictability in the art;
- › The amount of direction provided by the inventor;
- › The existence of working examples; and
- › The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

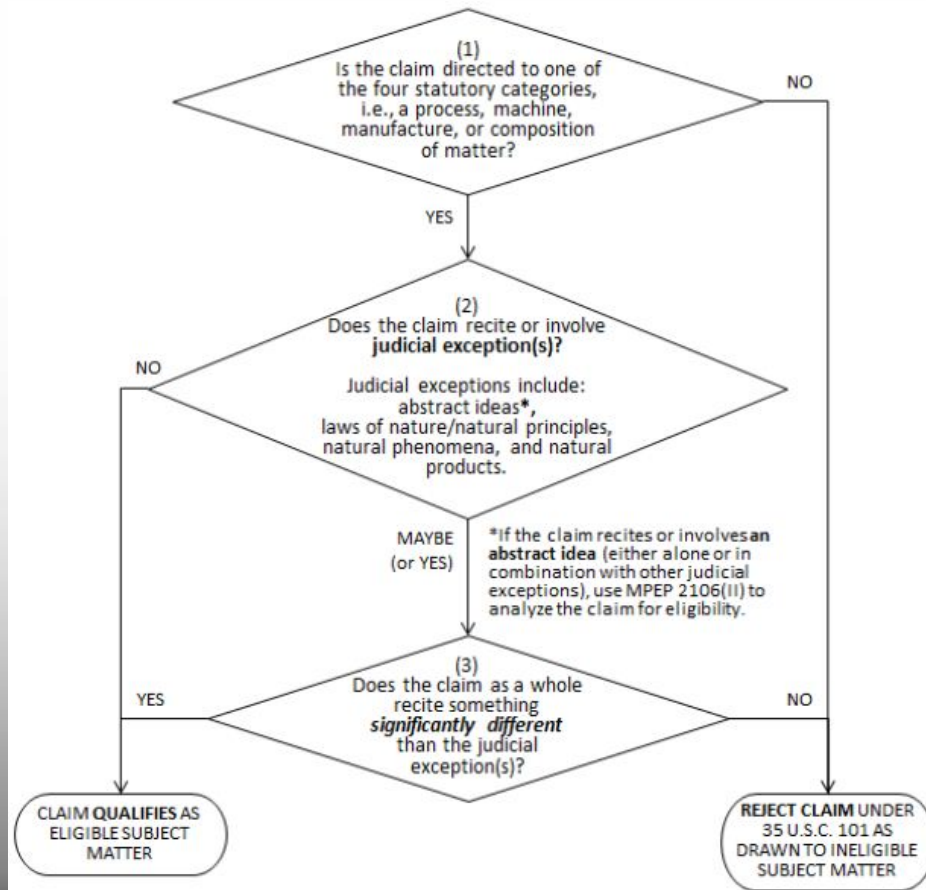
Product-by-Process Claims

- › “The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).
- › The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979).

USPTO Guidance

- › Guidance For Determining Subject Matter Eligibility Of Claims Reciting Or Involving Laws of Nature, Natural Phenomena, & Natural Products (March 4, 2014)
 - › *Association for Molecular Pathology v. Myriad Genetics* (2013)
 - › *Mayo Collaborative Services v. Prometheus Laboratories* (2012)
- › Advises examiners to reject patents that claim anything that is not “significantly different” from a natural material, law or phenomenon
 - › “A significant difference can be shown in multiple ways, such as: (1) the claim includes elements or steps in addition to the judicial exception that practically apply the judicial exception in a significant way ... or (2) the claim includes features or steps that demonstrate that the claimed subject matter is markedly different from what exists in nature.”

USPTO Guidance



Infringement Litigation

- › Proliferation of 3D printing patent filings are sure to inspire rights contests between and against those who manufacture 3D printing machinery and its related enabling software, especially as the technology shifts from its primary industrial use and transforms to more mass consumer availability.

Infringement Litigation (cont'd)

- › *3D Systems v. EnvisionTec* (E.D. Mich.)
- › *3D Systems v. Formlabs* (D. S.C.)
- › *3D Systems v. Formlabs* (SDNY)
- › *Stratasys v. Afinia* (D. Minn.)
- › *Leseman v. Stratasys* (D. Minn.)

Infringement Litigation (cont'd)

- › Doctrine of repair/reconstruction – an owner of a patented object may have the right to preserve the useful life of an object and may be able to produce a wide range of replacement parts for the patented objects, even if the replacement activity is done on a commercial scale
- › Induced and contributory infringement
 - › *Global-Tech v. SEB* (S. Ct.): held that indirect infringement requires knowledge of the patent and the direct infringement of the patent
 - › *Commil v. Cisco* (Fed. Cir.): divided panel held that a good-faith belief of invalidity is evidence that may negate the specific intent required for induced infringement

Embrace Change

- › “There is no need to repeat the mistakes of the copyright industry to reach a new patent equilibrium. 3D printing will foster outcomes for many patent industries that are similar to what we see in copyright. The temptation to lobby for legal limits on 3D printing technology will be strong, but firms would be better off embracing this change in production to cultivate new markets.”

(Desai, Devin; Magliocca, Gerard; McKinney, Robert, “Patents, Meet Napster: 3D Printing and the Digitization of Things.”)

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The opinions expressed are only those of the author/speaker and do not necessarily reflect the opinions of Robins, Kaplan, Miller & Ciresi L.L.P. or its attorneys.

Design Patent Law – After the Hague

Brent M. Dougal – Knobbe Martens

Mark A. Charles – Procter & Gamble Co.

Tracy-Gene G. Durkin – Sterne Kessler (Moderator)



Presentation Overview

- Part one: What is a design patent?
- Part two: What is the Hague Agreement?
- Part three: Real-World Walkthrough

Part One: What is a Design Patent?

Basics of Design Patents

- **35 U.S.C. § 171:** An Ornamental Design for an Article of Manufacture
- Other Requirements:
 - Configuration, Shape, Surface Ornamentation
 - Only the Appearance, Not Structural or Utilitarian Features
 - Original/Non-obvious
 - Not Offensive

Examples of Design Patents

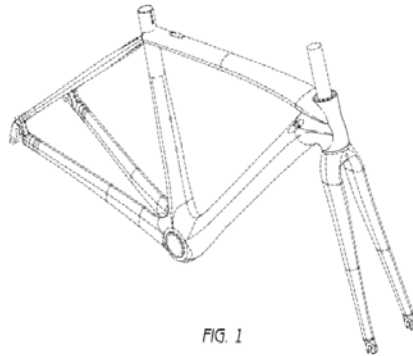
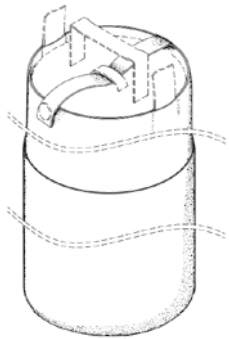


FIG. 1

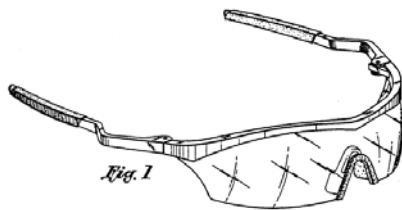
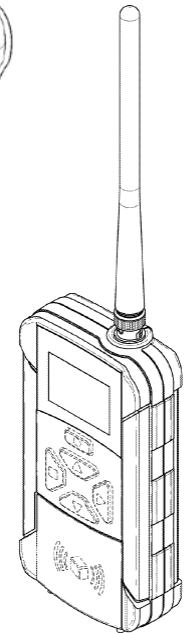
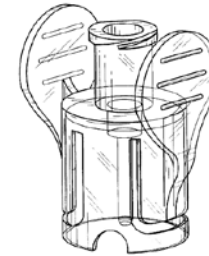
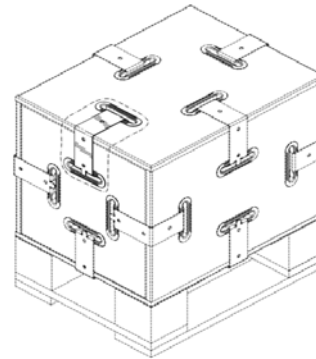
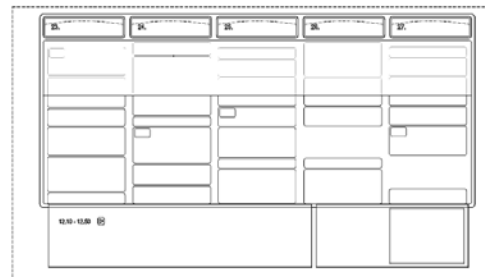
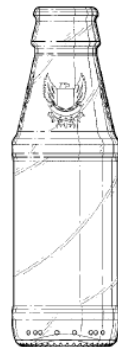


Fig. 1



Ins and Outs of the Application

- Drawings
 - Views
 - Non-essential lines
 - Hidden lines
 - Surface shading
- Description
- Claim

Ins and Outs of the Drawings

- 7 views

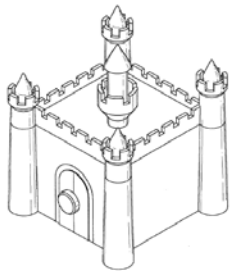


FIG. 1

Perspective



FIG. 2

Front

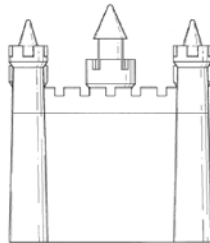


FIG. 3

Back

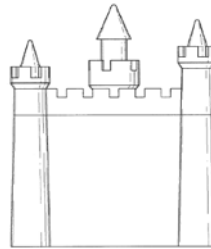


FIG. 4

Right
Side



FIG. 5

Left
Side

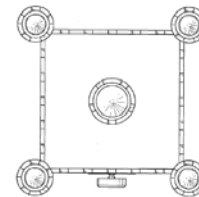


FIG. 6

Top

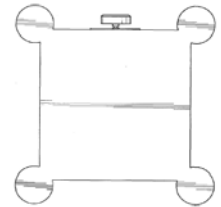
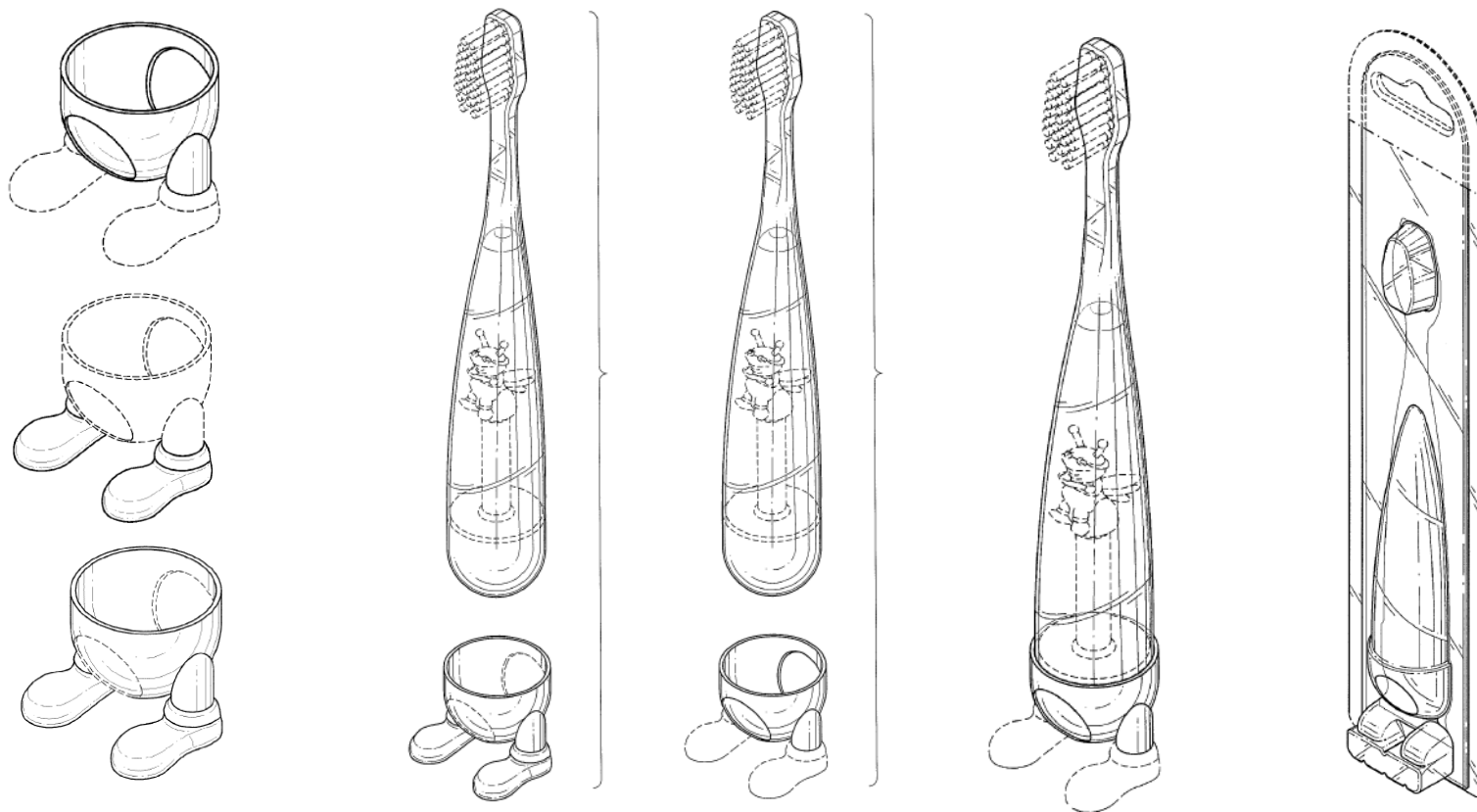


FIG. 7

Bottom

Ins and Outs of the Drawings

- Delete Non-Essential Lines
- Use Hidden Lines to show environment
- Use Hidden Lines to change scope of claim
- Add Surface Shading to enhance description



Part Two: What is the Hague Agreement?

What is the Hague Agreement?

- Administered by the World Intellectual Property Office (WIPO)
- Simplified design application filing procedure for member countries
 - Enables an applicant to use a single design application to obtain design patent and industrial design protection in multiple countries, much like a PCT utility patent application
- The U.S. is in process of joining through the Patent Law Treaties (PLT) Implementation Act of 2012

Who Can File a Hague Application?

- Any national, or any person who has a domicile, habitual residence, or a real and effective industrial or commercial establishment in a member country
- Access to 75 countries

Hague Application Process

- Applicant is located within Hague member jurisdiction
- Applicant files a standardized design application with either the applicant's home intellectual property office or with WIPO
 - Need to provide inventors at time of filing
- Applicant designates member countries and jurisdictions where design protection is desired and pays applicable fees
- After review for certain formalities, the application is automatically forwarded to the intellectual property offices of designated member countries and jurisdictions

Noteworthy Changes

- Global interface for coordinated filing and examination of design applications
- U.S. domestic and foreign priority entitlements enabled from the international design application
- Patent term increased from 14 years from issuance to 15 years from issuance
- Provisional rights resulting from publication of international design application

Technical Aspects of Hague Design Filings

- A maximum of 100 designs under a single Locarno Class allowed to be included in the initial filing
- Local substantive examination processes unchanged
- Hague applications can claim priority to original U.S. design applications and new U.S. design applications can claim priority to Hague applications that designate at least one country other than the United States

Benefits of Hague Design Filings

- Simplified process for obtaining foreign protection
- Applicants save time and money
 - Use of foreign counsel may be reduced
 - Ability to include up to 100 designs in the same Locarno class can save or delay costs
 - Annuity and Maintenance fees can go through WIPO
- Publishing of application grants provisional rights

Limitations of Hague Design Filings

- Limited membership
 - Many countries where US applicants file for foreign design protection are not part of the Treaty, including: Canada, Mexico, Japan, South Korea, China
- U.S. practitioners must ensure compliance of filings with idiosyncrasies of examination-based systems in other member countries
- Currently proposed that there will be no Continued Prosecution Applications (CPA) in US practice

Part Three: Real World Walkthrough

Case Study: Epilator

- Braun® Epilator
- Comfort Grips
- Unique Color Scheme
- Head Features
- Full Shape



Case Study: Epilator

- Product Designed in Germany
- Attorneys located in Germany
- Foreign Filing License
- Concern regarding acceptance of drawings in Hague countries (even before US ascension)
- Recognition of various local rules regarding design
- Understand Inventorship
- Ultimately, three cases filed

Case Study: Epilator – Get on Same PAGE

Sufficient for Hague Filing



Int'l counsel does not need to call you to file.

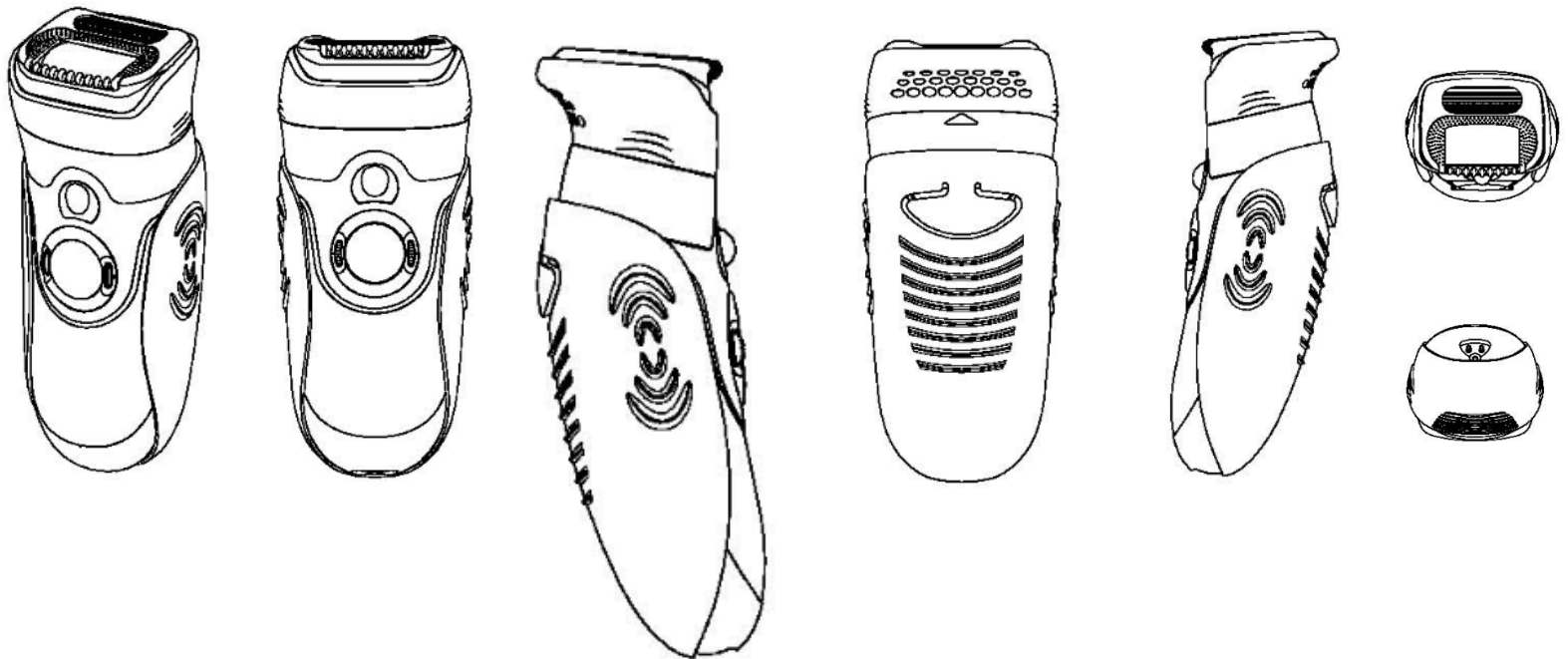
Case Study: Epilator – Case One

- Seven Designs - One



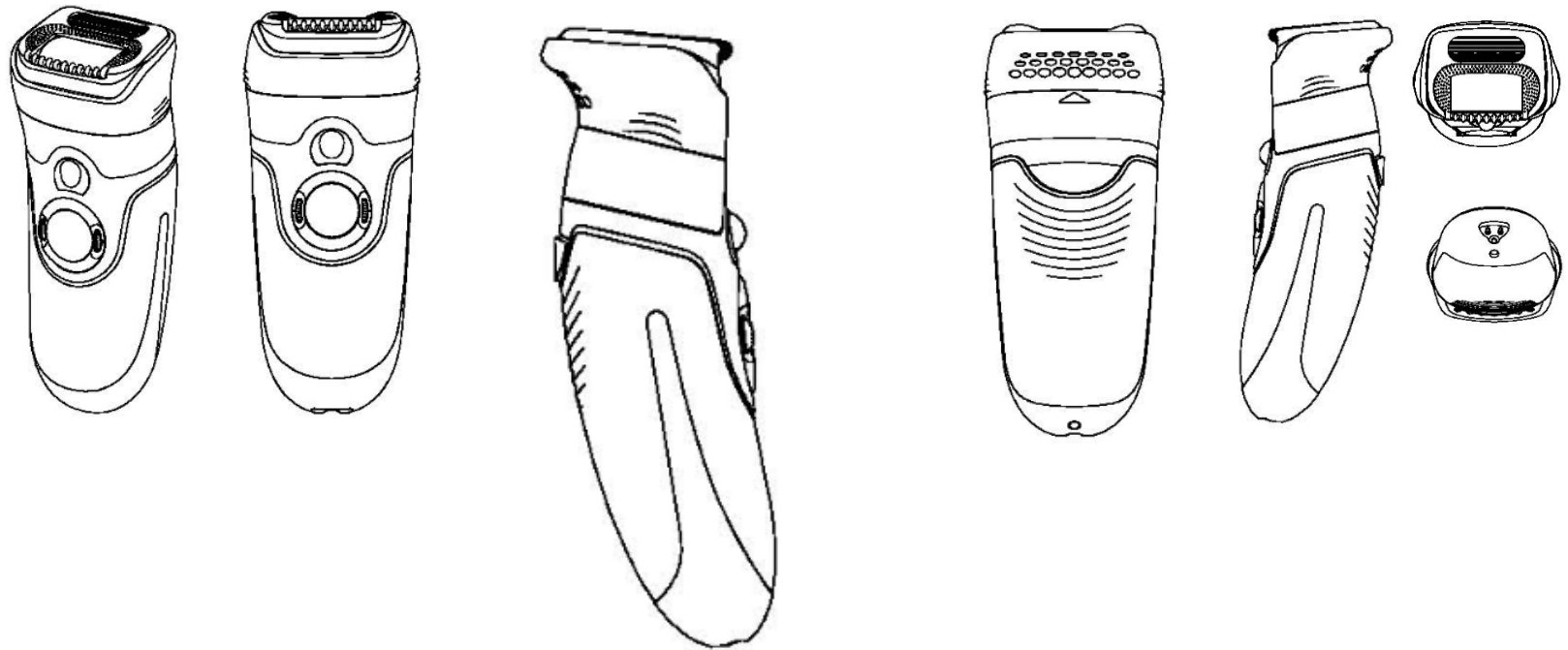
Case Study: Epilator – Case One

- Seven Designs - Two



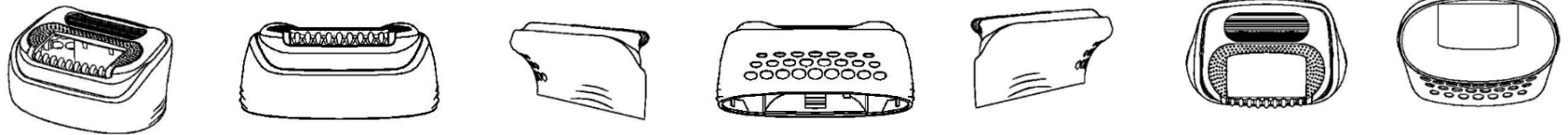
Case Study: Epilator – Case One

- Seven Designs - Three



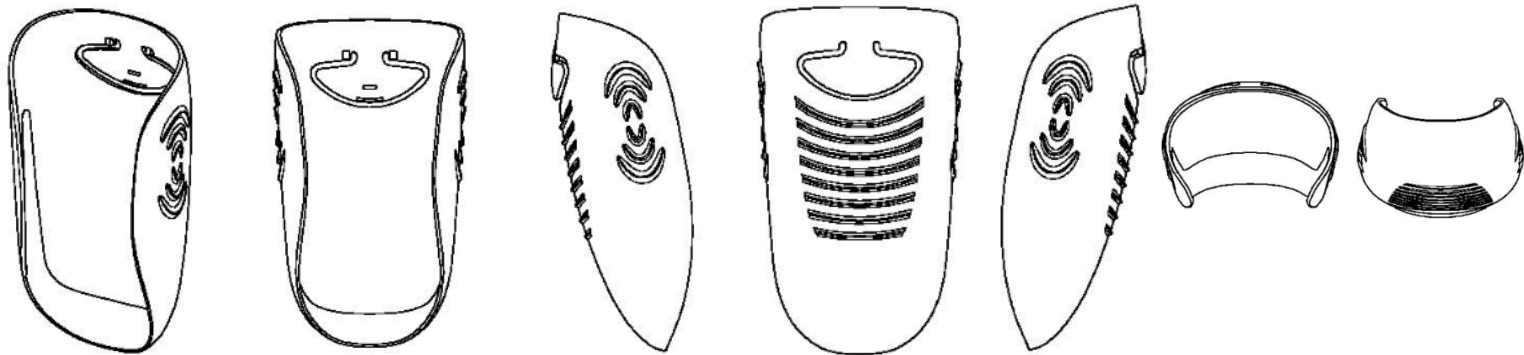
Case Study: Epilator – Case One

- Seven Designs - Four



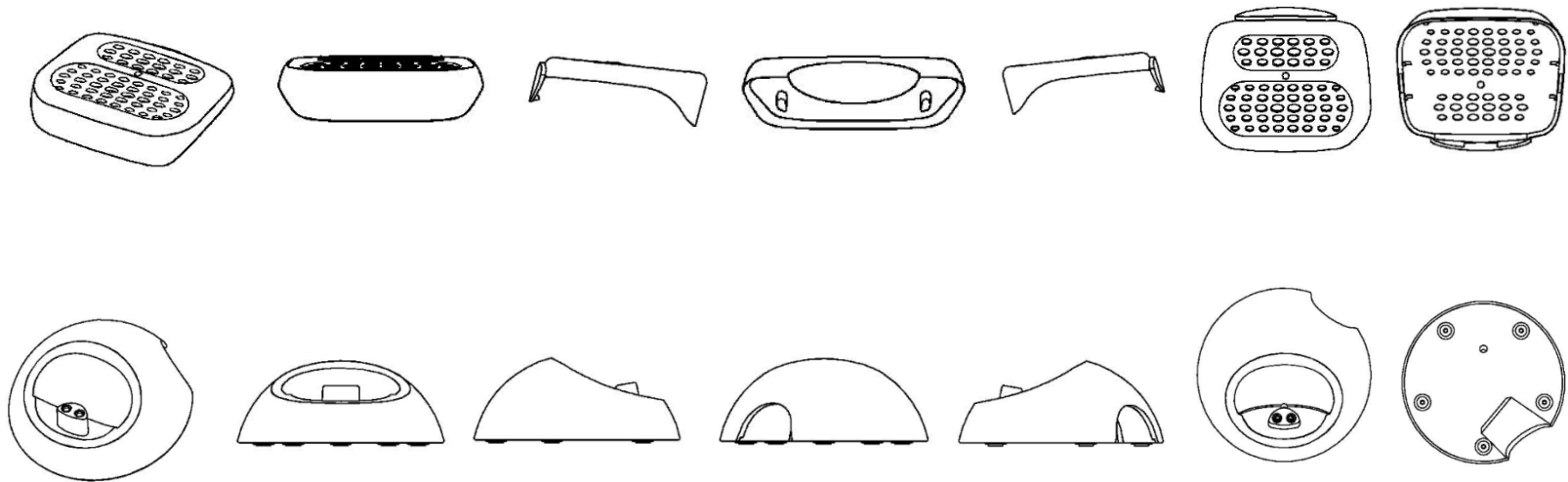
Case Study: Epilator – Case One

- Seven Designs - Five



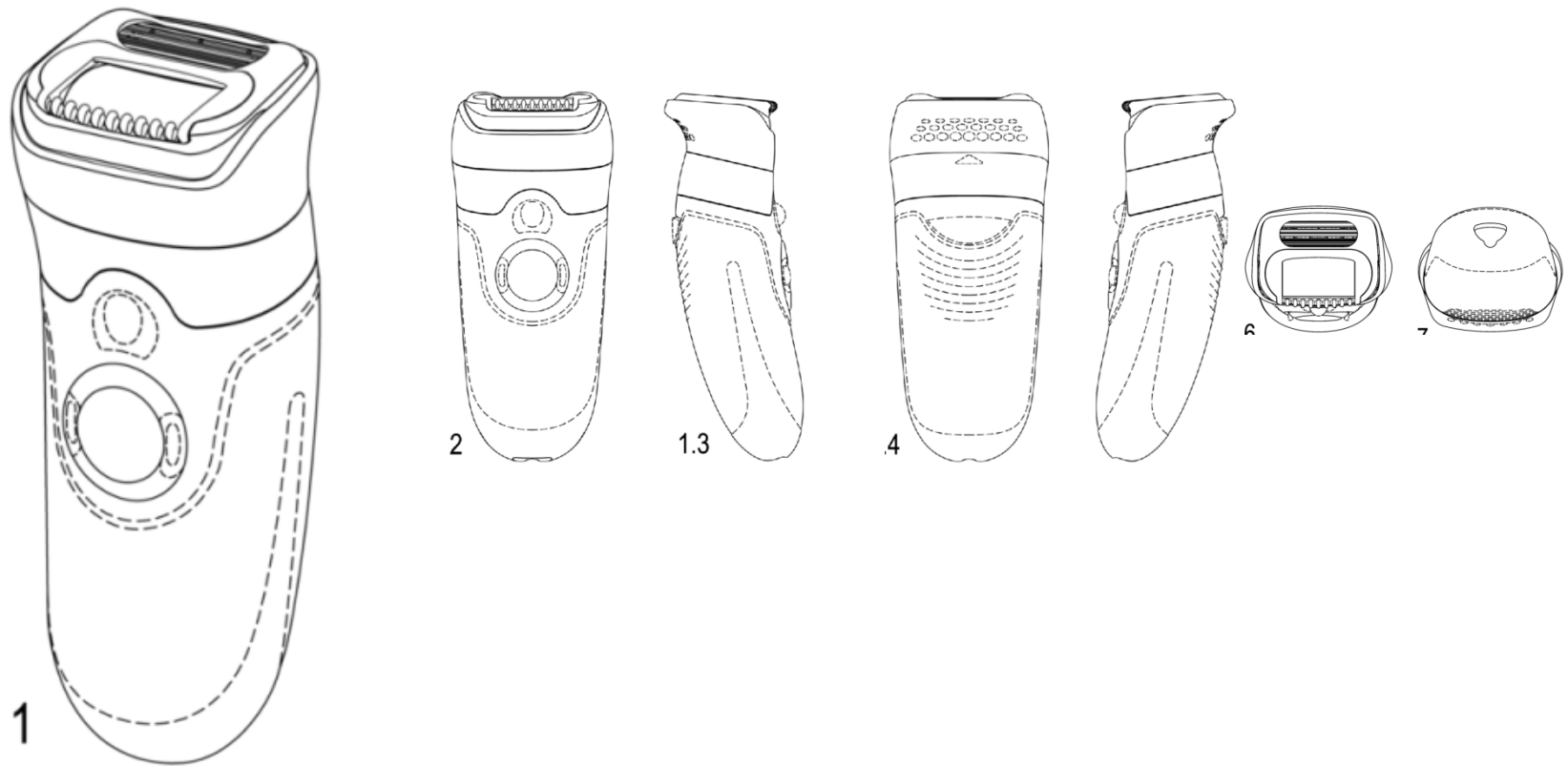
Case Study: Epilator – Case One

- Seven Designs – Six (Cap), Seven (Charger)



Case Study: Epilator – Case Two

- Three Designs – Upper Portion



Case Study: Epilator – Case Two

- Three Designs – Upper Portion



Case Study: Epilator – Case Three

- Three Designs – Color Focused



Case Study: Epilator

- Rationale: Ensure successful applications
- Scope of grant will vary on country basis
- Understand minimum acceptable scope
- Enforcement Mechanism
 - Local court system
 - Customs
- Business relevant features – maximize where possible.

Questions?



February 4, 2014

The Honorable Margaret Focarino, Commissioner for Patents
Attn.: Mr. Boris Milef, Senior PCT Legal Examiner
Office of PCT Legal Administration
United States Patent and Trademark Office
600 Dulany Street
P.O. Box 1450
Alexandria, VA 22313

Submitted to: AC87.comments@uspto.gov

**RE: IPO Comments on Notice of Proposed Rulemaking: Changes to Implement the
Hague Agreement Concerning International Registration of Industrial Designs,
78 Fed. Reg. 71870 (Nov. 29, 2013)**

Dear Commissioner Focarino:

Intellectual Property Owners Association (IPO) submits this letter in response to the USPTO's request for comments on the proposed rules to implement the Hague Agreement as codified in Title I of the Patent Law Treaties Implementation Act of 2012 (PLTIA). *See* 78 Fed. Reg. 71870 (Nov. 29, 2013). We appreciate the opportunity to comment.

IPO is a trade association representing owners of patents, trademarks, copyrights, and trade secrets. IPO's membership includes over 200 member companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO serves intellectual property owners in all industries and across all fields of technology.

IPO commends the USPTO's efforts in formulating the proposed rules to implement the Hague Agreement with regard to industrial designs. Our comments focus on two aspects of the proposed rules, the first being proposed rule 37 CFR § 1.53(d)(1)(ii) and the second relating to the payment of fees when filing through the USPTO. We address each issue below.

Comments regarding proposed rule 37 CFR § 1.53(d)(1)(ii)

Background

The proposed amendment to Section 1.53(d)(1)(ii) provides that a continued prosecution application (CPA) may not be filed in an international design application (IDA).

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The Federal Register notice states that “[t]he filing of a CPA of a prior nonprovisional international design application would not be appropriate, as a CPA is a design application under 35 U.S.C. chapter 16 and thus subject to different statutory and regulatory requirements relative to a nonprovisional international design application.” 78 Fed. Reg. 71870, 71877-78.

Additionally, at the Hague Agreement Public Forum at the USPTO on January 14, 2014, Mr. David Gerk, Office of Policy and International Affairs, and Mr. Boris Milef, Office of PCT Legal Administration, suggested that differing statutory requirements governing chapter 16 and IDA applications, as well as logistical complications, were reasons for not allowing CPAs to be filed in IDAs.

Suggestion

The USPTO should provide for filing a CPA in an IDA or should implement an alternative policy to effectively continue prosecution in an IDA so that an applicant can expeditiously address issues that are conventionally addressed with CPAs in chapter 16 design applications. Alternatively, the USPTO should implement a mechanism to prioritize/expedite examination of a continuation application of an IDA, similar to how the USPTO prioritizes/expedites examination of a CPA.

Rationale

In many instances, applicants use CPAs to quickly address one or two remaining issues in prosecution. After filing a CPA, the applicant often receives a notice of allowance as the next response from the USPTO. For many design patent applications, filing a CPA is much more efficient than filing a continuation or divisional application.

For example, when corresponding or related design applications are being examined in parallel, it is common that a new prior art reference is brought to the attention of an applicant after a Notice of Allowance has been received. At this late stage, the applicant has limited options to have the new reference considered by the USPTO. In a design application under chapter 16, a CPA can be filed and the new reference can be submitted in an Information Disclosure Statement to ensure consideration thereof.

The Proposed Rules, however, do not allow CPAs to be filed in IDAs. Although a continuation application could be filed, the proposed rules do not set forth any other mechanism to address newly-discovered art or other similar issues in a timely and cost effective manner.

35 U.S.C. § 382(c) recites, with reference to IDAs, “[e]xcept as otherwise provided in this chapter, the provisions of chapter 16 shall apply.” Additionally, 35 U.S.C. § 384(a) recites, “[n]otwithstanding the provisions of this part, an international design application designating the United States that otherwise meets the requirements of chapter 16 may be treated as a design application under chapter 16.” Moreover, the proposed treatment

of an IDA by the USPTO with respect to examination and general filing requirements appears to be modeled after the current treatment of chapter 16 applications before the USPTO.

Overall, 35 U.S.C. chapter 38 and the proposed rules demonstrate an intent to treat IDAs as chapter 16 design applications. The proposed changes to Section 1.53(d)(1)(ii) appear to be contradictory to the explicit language and intent of 35 U.S.C. chapter 38 and the other portions of the proposed rules, resulting in a disparity between the treatment of an IDA and a chapter 16 design application. The cost difference between filing a CPA (\$180) and a continuation (\$760 for a large entity) will further increase this disparity.

Not allowing CPAs of IDAs will serve to lengthen the time to resolution of a case, in contrast to the Office's policy of compact prosecution. There is no guarantee that the same Examiner will examine a new continuation application, and the application could be placed at the bottom of an Examiner's docket. The filing of a continuation, rather than a CPA or similar alternative, would most likely result in unnecessary delay.

The filing of a continuation may also remove the possibility of obtaining damages based on the prior publication of the IDA. One of the primary benefits of an IDA is the ability to obtain damages from the date of publication until patent grant under 35 U.S.C. § 154(d). Upon the filing of a continuation it appears that the Office would view the application no longer as an IDA with a prior publication, but as a new unpublished application. Thus, under the current law the public would not have access to the file history of the application and would not be able to determine the scope of the continuation until the design patent grants. Because the public would not be able to determine the scope of the pending continuation, there would be an argument that provisional rights are not available. If the USPTO does not ultimately allow the filing of a CPA to continue prosecution of an IDA, the USPTO should ensure that applicants can retain the benefits of 35 U.S.C. § 154(d) using an alternative approach.

If the USPTO allows filing of a CPA or similar request to continue prosecution/examination of an IDA, the IB could be notified when either the USPTO has granted a design patent or the application has been abandoned in the United States. This notification step would ensure that the IB is informed as to the final status of examination in the U.S. IPO would be willing to participate in a roundtable or other opportunity to help solve any logistical difficulties that may stem from allowing CPA practice for IDAs.

If the USPTO does not allow CPAs to be filed in IDAs and does not provide an alternative mechanism to continue prosecution of an IDA, then the USPTO should implement other policies to limit the disparity between the treatment of an IDA and a chapter 16 design application. One approach is for the USPTO to adopt policies to expedite or prioritize examination of a continuation application filed to address an issue in an IDA. This approach could be applied only in limited circumstances, such as to consider a new prior art reference or to address another issue that is conventionally

addressed with a CPA in a chapter 16 design application. Another possible approach is to amend petition practice to allow for consideration of IDSs or other issues after receipt of a Notice of Allowance with a conditional petition. If a new issue is raised, the filing of the petition would constitute the filing of a continuation, similar to the conditional Request for Continued Examination (RCE) pilot program for Utility Patents entitled “Quick Path Information Disclosure Statement” (QPIDS).

Conclusion

The rules should reflect equal treatment between chapter 16 design applications and IDAs as much as possible by allowing CPAs or similar requests in IDAs. Alternative but less preferred approaches to address issues that would arise from not allowing CPAs include: 1) expediting examination of continuation applications, and 2) allowing petitions for conditional consideration.

Comments regarding the payment of fees when filing through the USPTO (indirect filing)

Background

At the Hague Agreement Public Forum at the USPTO on January 14, 2014, the USPTO presented information on the payment of fees for IDAs when filing through the USPTO as an office of indirect filing. Two options were presented: (1) paying the USPTO all of the required fees, and (2) paying WIPO all of the fees except for the transmittal fee to the USPTO. The presentation also noted that WIPO will process the payment of fees in Swiss Francs, and that discrepancies may occur due to fluctuations in exchange rates.

Suggestion

Applicants should be advised as to any options pertaining to deposit accounts with WIPO to account for any fee discrepancies. The USPTO should process and send payments to WIPO with minimal delay and with same-day confirmations of fees received by WIPO in Swiss Francs. Also, the USPTO should prompt applicants filing IDAs through the USPTO with a link to pay fees directly to WIPO to avoid discrepancies.

Rationale

Although any discrepancy in fees due to fluctuations in exchange rate may be nominal, there is a concern that a deficiency in fees, even a nominal deficiency, may result in a delayed registration date. Consequently, the filing date under proposed rule 37 CFR § 1.1023 may also be delayed, which could cause the filing date of the IDA in the United States to be after a 6-month priority claim period. Additionally, the delay of the filing date will broaden the available prior art.

INTELLECTUAL PROPERTY OWNERS ASSOCIATION

Burdening an applicant with any of these exemplary issues due to a nominal deficiency in the payment of fees resulting from a fluctuation in exchange rates would be unreasonable.

Conclusion

Policies and procedures should be implemented to minimize the occurrence and impact of nominal fee discrepancies due to fluctuations in exchange rates.

* * *

IPO applauds the USPTO's efforts in developing the proposed rules to implement the Hague Agreement with regard to industrial designs and appreciates the opportunity to comment. IPO looks forward to working with the USPTO to support the continued implementation of the Hague Agreement with regard to industrial designs.

Sincerely,

A handwritten signature in black ink, reading "Herbert C. Wamsley". The signature is fluid and cursive, with the first name "Herbert" being more prominent and the last name "Wamsley" following in a similar style.

Herbert C. Wamsley
Executive Director