

**PUBLISH AND PERISH:
Early publication of design patent applications would give copyists the edge**

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For good reason, design patent applications are not published before they grant. Congress excluded them from pre-grant publication because the considerations weighing in favor of publishing utility patent applications simply do not apply to design applications. A handful of new-to-design commentators have recently pronounced this exception to be a mistake, and have come to the misguided conclusion that design applications should be published while pending. They were excited to this conclusion by the public's recent interest in design patents, piqued by the Apple-Samsung litigation.

Design patents are not new. Designers have been relying on design patents to protect their inventions since the mid-1800s. The Apple-Samsung case is unique only for the scale of infringement involved and the fortitude of the parties in litigating it. But one high-profile case does not justify upending the design patent system by introducing publication of design applications. This misguided approach would harm US designers and US design protection.

Inventors shouldn't have to race against the clock to beat their own application publication

Publishing design applications is antithetical to the Constitutional mandate to promote innovation. Design inventions are more easily copied than utility inventions. Immediately on disclosing a design, inventors must worry about counterfeiting and fast copyists, often unimaginative companies appropriating the work of design leaders to shape their "new" designs. Publishing design applications early will make it easier for the copyists to copy, and to beat actual inventors to market. They will have even less incentive to invest in innovative design themselves.

Right now inventors can have a first-mover advantage. If they introduce their product within the 15 monthsⁱ their design application is typically pending, they control when competitors learn of their design. But publish that application early and the inventors could be racing against the clock to release their product before publication. This is bad. It would encourage cutting corners in development, or delaying filing a design application as long as possible, to better protect their advantage. This conflicts with one of the goals of the new America Invents Act (AIA): encouraging early application filing.ⁱⁱ It also conflicts with the design system's goal of protecting innovative design. Every day of delay is another day that the design in development could be leaked to the public, which could prevent the inventor from protecting his own design in foreign countries that require absolute novelty. Such delay should not be promoted by introducing publication.

The beneficiary of publishing design patent applications would be the fast copyists who would—through premature publication—get a complete disclosure of a competitor’s new design, and possibly beat the actual designer to market. This expropriates the designer’s first-mover advantage, which can be paramount to his success in the market.

What’s the point of publication?

For most of their history, pending patent applications were not published. But since 2000, the US Patent and Trademark Office (USPTO) has published utility applications before they grant as patents. Congress provided publication to address a competitive disadvantage to American industry: American inventors’ foreign patent applications sometimes published—in the local foreign language—six months after the foreign application was filed. But, since the USPTO did not publish applications before they issued as patents, English-language versions of foreign-originated US applications remained secret.

Under this *status quo ante*, a large body of pre-grant publication was in non-English languages; technically public, but unintelligible to English-speaking US industry. This gave foreign competitors early access to US-developed technology described in their own foreign language, but denied the same access by Americans to foreign competitors’ technology filed in the US.ⁱⁱⁱ

To address this inequity, Congress made utility applications subject to publication, generally 18 months after their earliest filing date. But a utility application only publishes if it has a foreign counterpart. Purely domestic applications may still be kept secret.^{iv}

There is no need to translate a drawing

Congress exempted design applications from the publication requirement because design applications are by their nature visual: they claim a design shown in drawings.^v This is fundamentally different from a utility application. One does not need a translation of a design application to understand its disclosure; the drawings speak for themselves. In other words, “the illustration in the drawing views is its own best description.”^{vi} So American inventors are not disadvantaged when looking at foreign design material as they are with foreign utility material—the design drawings do not need to be translated to be understood. The drawings themselves disclose the design to US and foreign actors alike, no matter what language they understand, whenever a design is first made public anywhere in the world.

Congress made the right call. Publication is limited to the applications that need to be published in order to normalize international competition. Design applications are not among these.

Design applications are already issued as patents by the time they would be published

Even though Congress saw fit to require publication of some utility applications, it built in a delay: utility applications that publish generally do so after 18 months of secrecy. Design applications progress more quickly through the USPTO; most are issued patents by that time.^{vii}

This 18-month period is a balance between the interests of the patent applicant and the public. As put by the Tegernsee Experts Group^{viii}:

On the one hand, 18 months is thought to represent a reasonable period of time after filing of the application for the inventor to make an assessment whether to continue prosecution of the application or to withdraw or abandon it. On the other hand, 18 months is believed to be a reasonable period of time for third parties to wait to obtain information about a new technology.^{ix}

This balance would apply to design applications as well. After all, design and utility patent inventors deserve equal treatment. But in the US, third parties can already access design patents earlier than the 18 months they must wait for utility application publications, because design applications are usually patented within 15 months.^x They can tailor their efforts and resource allocation around a competitor's design invention much earlier—and with more certainty, since the design publication is an issued patent, not just a pending application—than a competitor's utility invention.

If he chooses, a design applicant can opt for early publication of his design in exchange for other benefits such as filing for protection abroad under the Paris convention, or filing an international design application under the Hague agreement.^{xi, xii} In both cases, the foreign or international application may publish before the US patent issues. But the designer is not forced to take advantage of either of these options, and so is not forced to give his competitors an early look at his design. He may choose to maintain it in confidence until he publicly unveils it, or until it issues as a US patent. We should not take away this freedom by forcing early publication.

Since designs are usually disclosed in an issued patent—and, in some cases, a foreign or international publication—earlier than 18 months after their applications are filed, their publication at 18 months would be useless and a waste of government resources.

Publication is a drag

Though it discloses applicants' design inventions to the public earlier than their utility inventions, the relatively quick pace of design-application prosecution helps the USPTO keep its design-application backlog down. It also helps applicants receive their patent protection while it can be most useful: early in a new design's life. The USPTO cites patent

publication as a factor in increasing design application pendency.^{xiii} Incorporating a second publication into the design application process can only slow it down, increasing the USPTO's backlog and decreasing the eventual patent's value. This benefits no one but would-be infringers.

Don't give the USPTO more of a job it can't do

Even now the USPTO cannot reliably print design patents. Their quality ranges from serviceable to unacceptable. This in spite of the USPTO's recognition that "it is of utmost importance that the drawing or photograph be clear and complete" in a design application.^{xiv}

Design publications are not like utility publications. Words printed poorly that can still be read convey the same meaning as words printed well. But a drawing printed poorly risks inaccurately depicting the design, and granting patent protection for a design that doesn't accurately represent what was applied for or examined. This disserves the applicant and the public. The USPTO's subpar efforts to print design patents themselves is ample evidence that the agency is unprepared to carry the additional burden of accurately and reliably printing design application publications. Before tasking the USPTO with printing design application publications is even considered, the Office should show an ability to reliably print accurate design patents. Otherwise the same problems in patent printing will surely arise in application publication printing, as will the need for applicants to repeatedly take action to correct printing errors.

The burden is not worth its weight

Proponents of early publication of design applications profess concern that the AIA's new pre-issuance submission procedure isn't effective enough for design applications. Without pre-grant publication, they say, design examiners do not have the public's help—by making a pre-grant submission of art—in finding the best art against which to assess the validity of a pending design application. These concerns are unfounded. Beyond the fact that pre-issuance submissions are rarely relied on by examiners,^{xv} the USPTO's design examiners have a history of high-quality searching and examination. Their work is rarely challenged after one of their patents issues.

But challenges do occur; the public has the same opportunities to contest the validity of a design patent as for a utility patent. These include new *inter partes review* and post-grant review, as well as decades-old reexamination or litigation. The effectiveness of these proceedings does not suffer from the absence of design application publication. For instance, there is ample time after a design patent issues to prepare and file a post-grant review request, without the need for advance notice of the patent's issuance. The single claim and relative brevity of design patents make preparing the request much less onerous than it might be for utility patents, where the advance notice could be helpful.

Even in the rare case where a design patent's validity is challenged by one of these mechanisms, these challenges routinely fail, even though there is every incentive to uncover the best prior art.^{xvi} The fact that these mechanisms are so rarely used and so rarely successful in contesting design patents is a testament to the high-quality work of the USPTO's design examiners.

For instance, there have been only 8 *inter partes* review requests filed against design patents (0.4% of total requests), and no post-grant review requests. For reexaminations the numbers are similarly small: reexamination has been requested for just over 200 design patents (about 1.5% of total requests) in the 33 years reexamination has been available.^{xvii} Of this small number that are even challenged by reexamination, more than half are confirmed valid.^{xviii}

Pushers for early design application publication are really just looking for a way to subvert the pre-issuance submission process to hinder design patent issuance while buying time to copy newly-published designs. Pre-issuance submissions in design applications would only introduce delay in the application process, without making a substantive difference. The minimal and illusory benefits that might come from publishing design applications do not justify imposing such a burden on the USPTO, even if the agency could carry it.

Publishing design applications would undermine innovation

The positives that justified publication of utility patent applications in the first place simply do not apply to design applications, and are overwhelmed by the negative of selling US design innovation down the river to benefit fast copyists. It is indefensible to promote a copyist beating a designer to market with the designer's own work.

And practically, the timing of patent application publication would not work for designs: most are already issued patents by the time they would come up for publication. Trying to introduce publication would only slow the application process and give copyists both more time to peddle their copies and a blueprint for making them.

No good can come from publishing US design patent applications. But bad surely would. Let's keep promoting original US design innovation and its protection.

ⁱ U.S. Dept. of Commerce, U.S. Patent and Trademark Office, "Design Patents: January 1989–December 2013" at 2 under heading "Explanation of Data" (2014).

ⁱⁱ See S.R. Rep. 111-18, at 4-5 (2009) ("In addition, the grace period benefits the public by encouraging early disclosure of new inventions")

ⁱⁱⁱ H.R. Rep. 106-287, pt. 1, at 33 (1999) ("While our foreign competitors are able to see the latest U.S. patent technology in their native languages barely six months after a U.S. inventor files a patent application in their country, the reverse is not true. U.S. researchers and investors are denied the opportunity to learn what their foreign competitors are working on until a U.S. patent issues. This causes duplicative research and wasted developmental expenditures, putting U.S. inventors at a serious disadvantage vis-a-vis their foreign counterparts and competitors.").

^{iv} H.R. Rep. 106-287, pt. 1, at 52 (1999) (“Title IV provides for the publication of pending patent applications which have a corresponding foreign counterpart. Any pending U.S. application filed only in the United States (e.g., one that does not have a foreign counterpart) will not be published if the applicant so requests. Thus, an applicant wishing to maintain her application in confidence may do so merely by filing only in the United States and requesting that the PTO not publish the application. For those applicants who do file abroad or who voluntarily publish their applications, provisional rights will be available for assertion against any third party who uses the claimed invention between publication and grant provided that substantially similar claims are contained in both the published application and granted patent. This change will ensure that American inventors will be able to see the technology that our foreign competition is seeking to patent much earlier than is possible today.”).

^v H.R. Rep. 106-287, pt. 1, at 53 (1999) (“Since design applications do not disclose technology, inventors do not have a particular interest in having them published. The bill as written therefore simplifies the proposed system of publication to confine the requirement to those applications for which there is a need for publication.”).

^{vi} MPEP § 1503.01, 9th ed. (2014) (citing *In re Freeman*, 23 App. D.C. 226 (App. D.C. 1904)).

^{vii} U.S. Dept. of Commerce, U.S. Patent and Trademark Office, “Design Patents: January 1989–December 2013” at 2 under heading “Explanation of Data” (2014) (“[T]he average time period between filing for a design patent and the issuing of that patent (i.e., the patent’s issue “pendency”) is now about 15 months....”)

^{viii} Heads of Offices of and experts from the USPTO, the JPO, the EPO and the patent offices of the UK, Denmark, Germany and France.

^{ix} Tegernsee Experts Group, “Study Mandated by the Tegernsee Heads: 18-Month Publication” at 3 (2012).

^x U.S. Dept. of Commerce, U.S. Patent and Trademark Office, “Design Patents: January 1989–December 2013” at 2 under heading “Explanation of Data” (2014).

^{xi} In some countries this publication can be deferred on request by the applicant.

^{xii} Design applicants who choose to file an international application under the Hague agreement are also eligible for “provisional rights” allowing them to collect damages from those who copy their design from the time it is published until it issues as a patent.

^{xiii} U.S. Dept. of Commerce, U.S. Patent and Trademark Office, “Design Patents: January 1989–December 2013” at 2 under heading “Explanation of Data” (2014) (“[V]ariation in pendency is determined by many factors, including PTO workload ..., budget and manpower levels, patent printing schedules, etc.”)

^{xiv} MPEP § 1503.02, 9th ed. (2014)

^{xv} Even for utility applications, the art provided in pre-issuance submissions is relied on only about 12.5% of the time. U.S. Dept. of Commerce, U.S. Patent and Trademark Office, “Message From Janet Gongola, Patent Reform Coordinator: Update On The Frequency, Compliance, And Content Of Preissuance Submissions,” http://www.uspto.gov/blog/aia/entry/message_from_janet_gongola_patent8 (February 24, 2014). This proportion would be much lower for design applications, which are rarely rejected, or invalidated after they issue.

^{xvi} Even in the recent high-profile Apple-Samsung litigation, none of Apple’s 6 challenged US design patents were found invalid, both before the federal courts and the International Trade Commission. *Apple Inc. v. Samsung Electronics Co., Ltd., et al.*, 5-11-cv-01846 (ND Cal); *Electronic Digital Media Devices and Components Thereof*, 337-TA-796 (ITC).

^{xvii} 223 total *ex parte* and *inter partes* reexamination requests were filed for design patents as of September 30, 2013. See U.S. Dept. of Commerce, U.S. Patent and Trademark Office, “*Ex Parte* Reexamination Filing Data - September 30, 2013” (2013); and U.S. Dept. of Commerce, U.S. Patent and Trademark Office, “*Inter Parte* Reexamination Filing Data - September 30, 2013” (2013).

^{xviii} Sterne, Kessler, Goldstein & Fox P.L.L.C., “Patent Office Litigation,” e-Book version, Thompson Reuters, Chapter 24 (2012).

