

June 10, 2016

Ms. Päivi Lähdesmäki
Head, Legal Section, The Hague Registry
World Intellectual Property Organization

Via email (wipo.mail@wipo.int)

Re: Comments on Draft “Guidance on Preparing and Providing Reproductions in Order to Forestall Possible Refusals on the Ground of Insufficient Disclosure of an Industrial Design by Examining Offices” (“Guidance”) Document Received May 27, 2016

Dear Ms. Lähdesmäki:

The American Intellectual Property Law Association (“AIPLA”) is pleased to respond to the request by the Secretariat of the fifth session of the Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs (December 14 to 16, 2015)(“Secretariat”) for comments on the draft Guidance document.

AIPLA is a U.S.-based national bar association with approximately 14,000 members who are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA members represent a diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, unfair competition, and trade secret law, as well as other fields of law intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective global laws and policies that stimulate and reward invention and authorship while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

AIPLA applauds the Secretariat goal in assisting the Hague System users in disclosing an industrial design in a way that caters to the requirements before the Examining Offices and to providing guidance to Hague System applicants regarding how to avoid refusals of protection, including when and if reproductions contained in the international registration do not clearly or sufficiently disclose the industrial design.

We have the following comments relating to the information contained in the draft Guidance document that are generally directed to U.S. law and practice.

- 1) In the General Disclaimer in the Guidance document, AIPLA respectfully suggests inclusion of statements to the effect that:
 - a) the Guidance document should also not be intended to replace the assistance of qualified counsel, and

- b) that other issues beyond insufficient disclosure may also give rise to refusals.¹
- 2) An express reference, as a resource to the U.S. Patent and Trademark Office’s “Design Patent Application Guide,” available at the URL <http://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide>. Another document to consider is a presentation from USPTO Design Day 2012 by USPTO Supervisory Patent Examiner Cathron Brooks titled “Selecting Suitable Media for Design Patent Application Drawings,” which is attached to the cover email of this response.

For each of the Guidance provisions quoted in the text boxes below, AIPLA also submits the following specific comments, highlighting where U.S. practice may differ from the quoted provisions, for consideration by the Secretariat as the Guidance is revised:

Guidance I(a)(iii):

“Each view should be of the same scale as the others.” (footnote omitted)

3) AIPLA Comment to Guidance I(a)(iii):

In the U.S., the views may be differently scaled provided that the scaling is appropriately identified (*e.g.*, “enlarged side view”). *See also* 37 CFR 1.84(h) (“Detail views of portions of elements, on a larger scale if necessary, may also be used.”).

Guidance I(a)(iv):

“Appropriate legend (max 40 characters) or description indicating a direction (an angle) of each view should be provided.”

4) AIPLA Comment to Guidance I(a)(iv):

In the U.S., it is not strictly speaking necessary to indicate a direction or angle of each view. Indeed, the Manual of Patent Examining Procedure, Ninth Edition (Revision 07.2015, Last Revised November 2015) (“MPEP”) states that “[d]escriptions of the figures are not required to be written in any particular format, however, if they do not describe the views of the drawing clearly and accurately, the examiner should object to the unclear and/or inaccurate descriptions and suggest language which is more clearly descriptive of the views.” MPEP 1503.01(II). This language is often relied upon in practice often relied upon by examiners to require a direction to be indicated.

¹ For example, the U.S. unity standard for multiple designs in an application is stricter than the European Union’s standard. Moreover, current U.S. case law suggests that if design patents are not obtained for certain applied-for, unity-violating designs, negative ramifications may result.

Guidance I(c):

- (i) The entire configuration of the product may be represented in six views or perspective views, even though protection is sought only for a certain part of it. In those views, the disclaimed part of the product must be indicated by means of dotted or broken lines or coloring, according to Section 403 of the Administrative Instructions for the Application of the Hague Agreement.
- (ii) An explanation on how the disclaimed part is indicated may be given in the description; if the disclaimed part is indicated with dotted or broken lines or coloring and no explanation is given on how to identify the disclaimed part of the design, it may create an ambiguity in the sense that the dotted or broken lines or color may be considered part of an integral element of the claimed design. For example, where broken lines are shown on a shoe without any explanation, it may be unclear whether the broken lines indicate a disclaimed part of the design or stitches on the shoe.

5) AIPLA Comment to Guidance I(c):

U.S. statutes and regulations do not prohibit the use of “coloring” to disclaim part of an article from the claimed design. However, the only expressly identified means for disclaiming in U.S. regulations is broken lines (*see* 37 CFR 1.152 (“Broken lines may be used to show visible environmental structure”)), and coloring could potentially be confused with surface shading.²

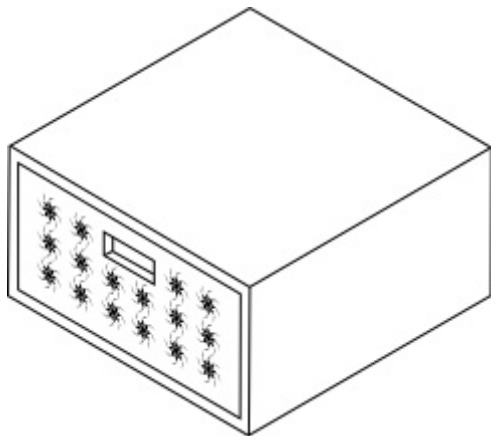
Guidance II(a)-(c) (and subsequent Illustrative Implementations):

- (a) For a clearer disclosure of the configuration of a certain part of the product, where necessary to adequately disclose the design, other specific views such as (partially-) enlarged view, exploded view, cross sectional view, view showing a state where the product has transformed, etc., in addition to standard views showing the appearance of the whole product (refer to Guidance I(a)), should be submitted at the time of filing.
- (b) An appropriate legend or description of the other specific view should be provided to avoid any ambiguity. For example, the representations may be considered inconsistent with one another if a certain part of the product is represented largely in a view without an indication of “enlarged view” because the view is deemed to be different in scale from the other views.
- (c) When an enlarged view or cross-sectional view is submitted, an indication of which portion of the product is shown in those views should be given in the

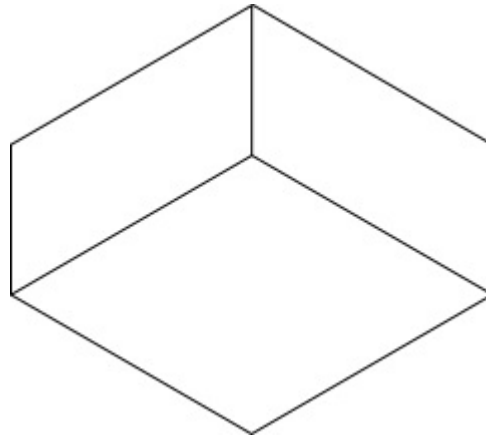
² An example of an issued design patent featuring coloring to disclaim part of an article from the claimed design is U.S. Pat. No. D654,399. This patent features a clarifying description that states: “The claimed design is indicated by the relatively dark portions in the figures, while the relatively light portions are environmental and form no part of the claimed design.”

Illustrative Implementations Taking into Account Guidance II

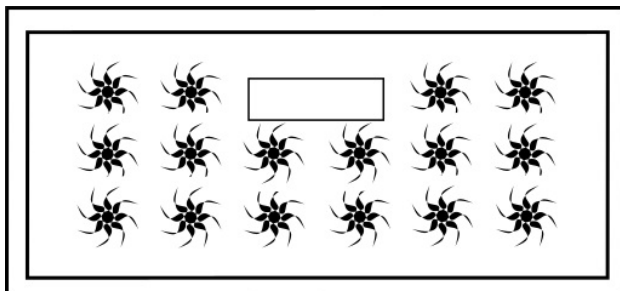
1.1



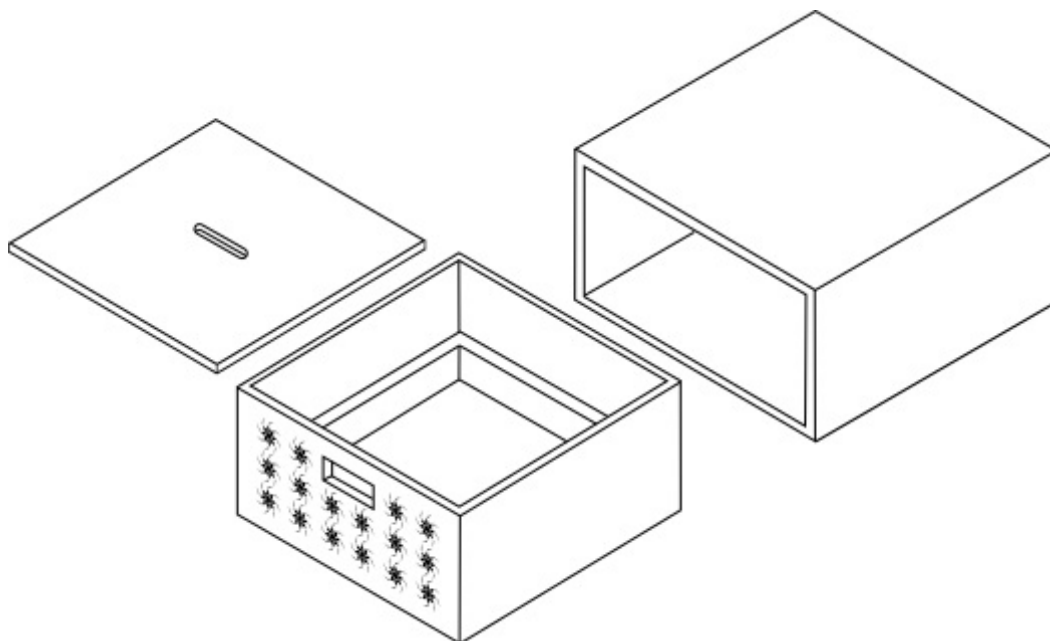
1.2

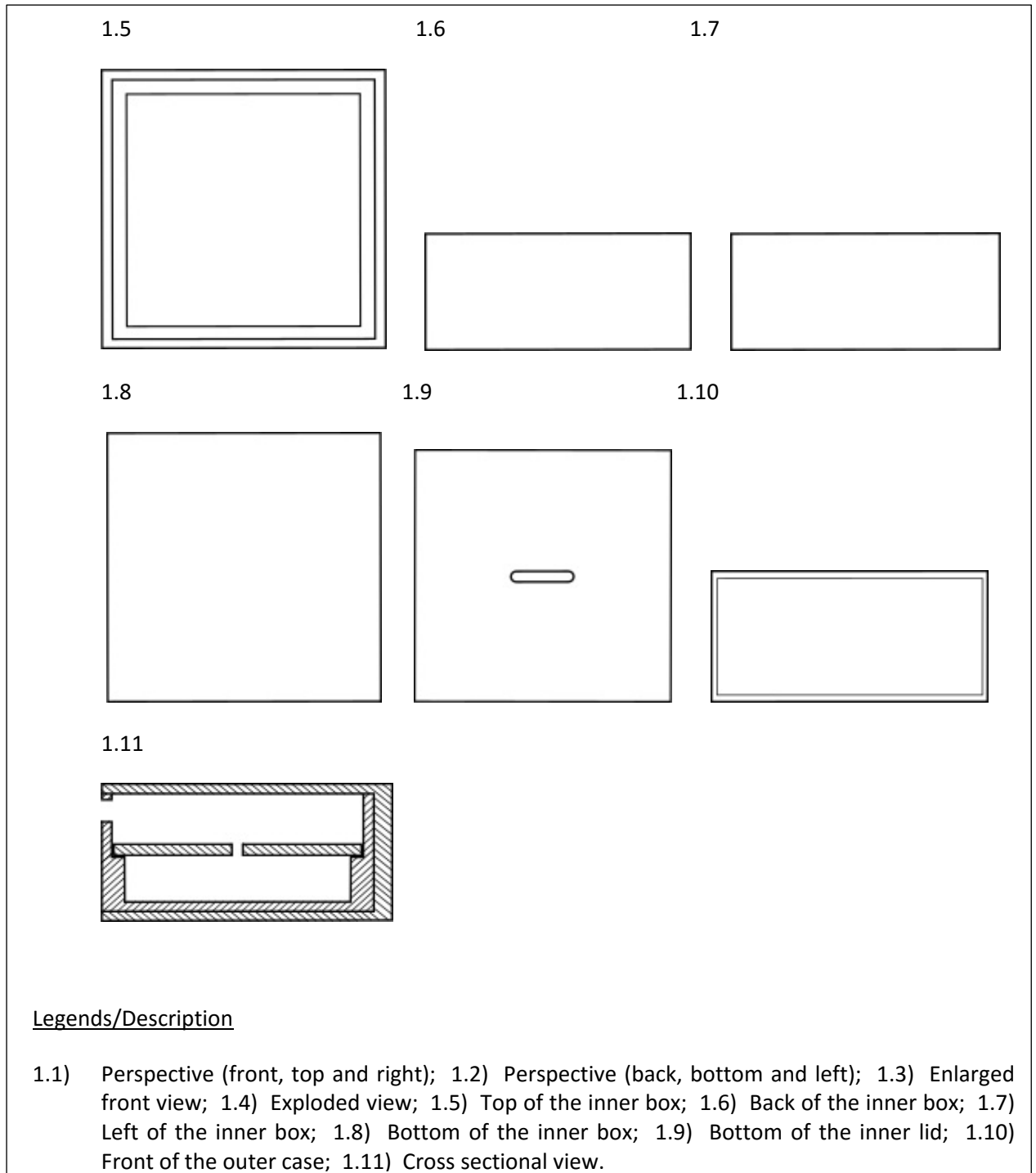


1.3



1.4





6) AIPLA Comment to Guidance II(a)-(c) (and subsequent Illustrative Implementations):

See the comments 7) *infra* regarding claim scope issues raised by a lack of shading in Guidance III (“Possible Problematic Practice”).

In the U.S., the additional representations in 1.4 to 1.11 are shown in solid lines and thus would add claimed subject matter.

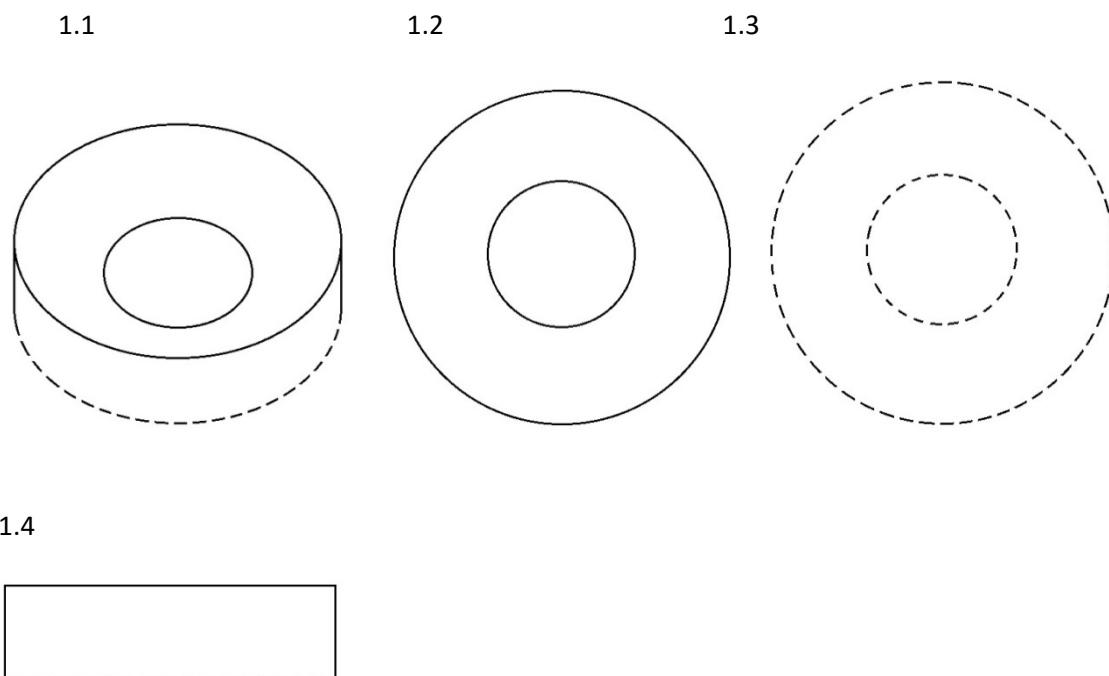
Also, cross-sectional representation 1.11 does not seem consistent with, *e.g.*, representation 1.3. In particular, the height of the drawer opening in representation 1.3 is less than the height of the drawer opening in representation 1.11. Regarding cross-sectional views generally, the MPEP states that

Sectional views presented solely for the purpose of showing the internal construction or functional/ mechanical features are unnecessary and may lead to confusion as to the scope of the claimed design. The examiner should object to such views and require their cancellation. *Ex parte Tucker*, 1901 C.D. 140, 97 O.G. 187 (Comm'r Pat. 1901); *Ex parte Kohler*, 1905 C.D. 192, 116 O.G. 1185 (Comm'r Pat. 1905). However, where the exact contour or configuration of the exterior surface of a claimed design is not apparent from the views of the drawing, and no attempt is made to illustrate features of internal construction, a sectional view may be included to clarify the shape of said design. *Ex parte Lohman*, 1912 C.D. 336, 184 O.G. 287 (Comm'r Pat. 1912).

MPEP 1503.02(I). Here, representations 1.4 and 1.5 seem to convey many, if not all, of the contours of the exterior surface of the claimed design, and thus according to the MPEP it seems an objection may result from including cross-sectional representation 1.11.

Guidance III ("Possible Problematic Practice"):

Indication of the product: "Pharmaceutical tablet"



Legends

1.1) Perspective (front, top and right); 1.2) Top; 1.3) Bottom; 1.4) Front.

7) AIPLA Comment to Guidance III (“Possible Problematic Practice”):

In the U.S., it may be possible to argue that the disclosure is sufficient. Representation 1.2 teaches that the interior circle is concentrically situated. Because Representation 1.1 does not situate the interior circle concentrically (and assuming the representations are consistent), it necessarily follows that the interior circle is not situated on the same plane as the remainder of the design shown in Representation 1.2. Representation 1.4 confirms that the interior circle must be submerged, and the degree of submergence is a function of the “drift” of the interior circle from the axial center (also, generally speaking, without shading, the surfaces would be interpreted and accepted as being flat).

However, the claim scope might be viewed as unclear because while it is clear which edges are claimed, without shading it is unclear which surfaces are claimed. For example, it is unclear whether the surface corresponding to the area of the interior circle, although it seems certain that, *inter alia*, the interior circle “edge” shown in solid lines is claimed. Moreover, the USPTO has in the past rejected applications on the ground of “new matter” when applicants have subsequently attempted to illustrate some but not all surfaces with shading (*i.e.*, to claim some surfaces but not all surfaces), particularly with more complicated designs. The USPTO is currently evaluating how this “written description” requirement applies (see the URL <https://www.federalregister.gov/articles/2016/04/15/2016-08760/request-for-comments-on-the-application-of-the-written-description-requirement-to-specific>).

Guidance III(b):

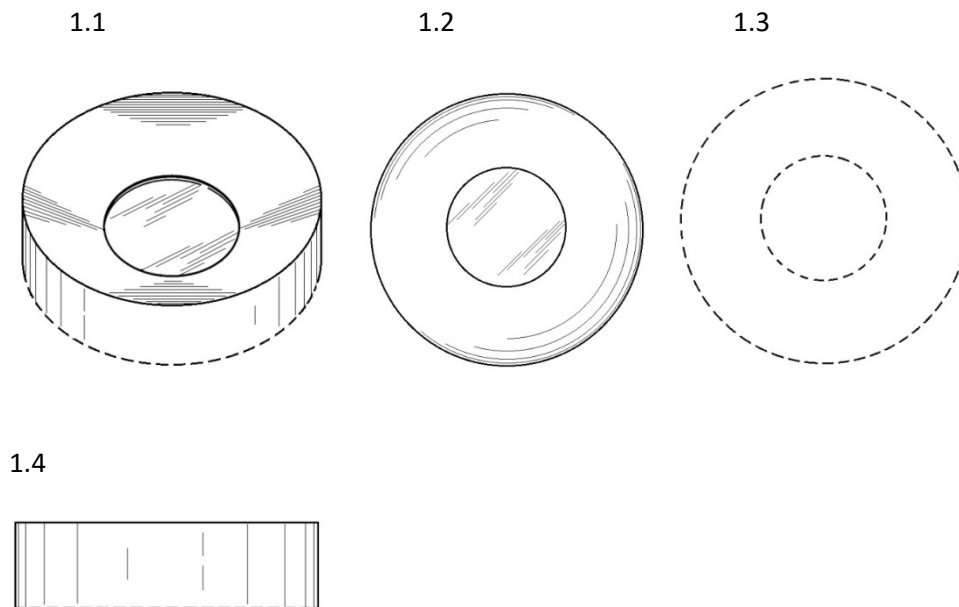
Shading, hatching or lines should not be provided on unclaimed subject matter where they may lead to confusion as to the scope of the claimed design.

8) AIPLA Comment to Guidance III(b):

In the U.S., shading, hatching or solid lines should never be provided on unclaimed subject matter.

Guidance III (Illustrative Implementations):

Illustrative Implementations Taking Into Account Guidance III



Legends

1.1) Perspective (front, top and right); 1.2) Top; 1.3) Bottom; 1.4) Front.

Description

The parts shown by means of broken lines in the reproductions are not part of the claimed design. The lines in the representation represent contours only and do not illustrate an ornamentation or decoration on the surface of the product. The left side view, the right side view and the back view are omitted because they are identical with the front view, respectively.

9) AIPLA Comment to Guidance III (Illustrative Implementations):

Illustrative implementations 1.1 and 1.2 include obliquely-oriented lines in the innermost circular area. In the U.S., the MPEP states that “[o]blique line shading must be used to show transparent, translucent and highly polished or reflective surfaces, such as a mirror.” MPEP 1503.01(II). Accordingly, the design as illustrated may be interpreted as having such a surface within that area. Further to Guidance III(c), a description clarifying the meaning of the obliquely-oriented lines should be provided.

Moreover, in the U.S., sometimes there are objections to differences in contours/shading/lines between views. While the obliquely-oriented lines in the center

circle appear consistent between illustrative implementations 1.1 and 1.2, the remaining contours/shading/lines are not consistent between views.

Guidance IV (and Footnote 12):

No Mixing of the Reproductions in Different Forms; No Mixing of the Representations in Black and White and in Color

(a) All reproductions should be in the same form.¹²

(b) Representations should be all in either black and white or color.

¹² In Japan, Romania and the United States of America, mixing the reproductions of a design in different forms is accepted unless the examiner finds an inconsistency in color, pattern, or other elements of the design between those reproductions.

10) AIPLA Comment to Guidance IV (generally):

The Secretariat may want to consider adding an additional guidance point that extraneous matter (*e.g.*, a room and table upon which the article embodying the design rests in the background of a view) should not be included. *See* 37 CFR 1.152 (“Photographs submitted in lieu of ink drawings in design patent applications must not disclose environmental structure but must be limited to the design claimed for the article.”).

It is also worth noting that, in the U.S., “[p]hotographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. [The USPTO] will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention.” 37 CFR 1.84(b)(1). Photographs of “ornamental effects” are acceptable. *Id.* In practice, the USPTO sometimes objects to photographic figures (and photorendered figures, which are generally treated the same) to the extent ornamental effects beyond what would be shown in line drawings are not visible. Regardless, clear photographs are required. *See* 37 CFR 1.84(b)(1) (“The photographs must be of sufficient quality so that all details in the photographs are reproducible in the printed patent.”).

11) AIPLA Comment to Guidance IV(a) and Footnote 12:

The MPEP states that “[p]hotographs and drawings must not be combined in a formal submission of the visual disclosure of the claimed design in one application. The introduction of both photographs and drawings in a design application would result in a high probability of inconsistencies between corresponding elements on the drawings as compared with the photographs.” MPEP 1503.01(V) (emphasis added) (*see also* 37 CFR 1.152 (“Photographs and ink drawings are not permitted to be combined as formal drawings in one application.”)). This statement does suggest that mixing the reproductions would not *per se* result a disclosure objection for *informal* (*i.e.*, preliminary) submissions, but it seems likely that such submissions would receive a refusal.

12) AIPLA Comment to Guidance IV(b):

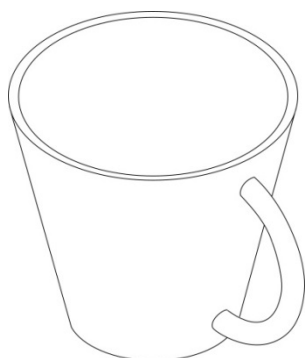
In the U.S., claiming a design in color and also in black and white (*i.e.*, two designs) may not result in a unity rejection. Accordingly, it may be permissible to submit representations in color and black and white. Although no publicly available USPTO documents expressly prohibit submitting representations for a *single* design with some views in color and other views in black and white, this may render the claim scope ambiguous and thus is likely impermissible.

Guidance IV (Illustrative Implementations Taking Into Account Guidance IV):

Illustrative Implementations Taking Into Account Guidance IV

Design 1 is represented in the form of a line drawing and design 2 is represented in the form of a computer graphic representation in the same international application. Design 1 is in black and white and design 2 is in color.

1.1



2.1



13) AIPLA Comment to Guidance IV (Illustrative Implementations Taking Into Account Guidance IV):

Generally speaking, in the U.S., illustrative implementation 1.1 would be seen as having a greater claim scope than illustrative implementation 2.1, although illustrative implementation 1.1 may be correspondingly more susceptible to a novelty/obviousness challenge. *See* MPEP 1503.01(V) (“If color photographs or color drawings are filed with the original application, color will be considered an integral part of the disclosed and claimed design.”). Note also that the MPEP still states that the use of lines to represent color is allowable, if the schema in Section 608.02 of the MPEP is followed (but surface shading cannot simultaneously be used).

AIPLA appreciates the opportunity to provide comments on this draft Guidance. AIPLA looks forward to further dialogue with WIPO, the Contracting Parties of the Hague System

AIPLA Comments on Draft Guidance

June 10, 2016

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and the Examining Offices in improving the international registration system for Industrial Designs.

Sincerely,

A handwritten signature in blue ink that reads "Denise W. DeFranco". The signature is written in a cursive style with a long horizontal flourish extending to the right.

Denise W. DeFranco, President
American Intellectual Property Law Association