

February 12, 2016

Commissioner for Patents of the United States Patent and Trademark Office
Attn: Michael Cygan
Senior Legal Advisor, Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy
Mail Stop Comments Patents
P.O. Box 1450
Alexandria, VA 22313-1450
via email: TopicSubmissionForCaseStudies@uspto.gov

**Re: Submission of Topic in response to USPTO's Request for Submission
of Topics for USPTO Quality Case Studies, Fed. Reg. Vol. 80, No.
244 (December 21 2015)**

Dear Commissioner:

We are attorneys with Sterne Kessler Goldstein & Fox, an intellectual property law firm with more than 170 IP professionals in Washington, DC. In 2015 alone, our firm filed over 3200 design applications worldwide, nearly 500 of which were filed at the USPTO. Together we have over 34 years' experience filing and prosecuting design patent applications before the USPTO on behalf of over 100 companies and individuals, including 2 companies that are regularly among the top 50 annual US design patent grantees.

As a firm and as individual practitioners we regularly contribute to efforts to shape and improve design prosecution practice. We work with the USPTO and foreign patent offices, and with nongovernmental intellectual property groups around the world.

We write today to suggest that the Office study the frequent imposition of requirements to change the drawings of design applications simultaneously with closing prosecution on the merits in notices of allowance and *ex parte Quayle* actions.

We believe investigation of this topic will result in identification of areas in which the Office can improve the quality and efficiency of its examination.

PROPOSED CASE STUDY

Title: Requiring changes to design application drawings in *Ex parte Quayle* actions and notices of allowance.

Proposal for study: The Office should study the practice of requiring applicants to change the drawings of a design application simultaneously with closing prosecution on the merits in notices of allowance and *Ex parte Quayle* actions.

Explanation: The claims in design applications necessarily are defined by the specification and drawings, due to the requirement that they be “in formal terms to the ornamental design for the article (specifying name) *as shown, or as shown and described.*” MPEP § 1503.01 (emphasis added). Therefore, unlike in utility applications, any change to the drawings directly affects the claim, and so is substantive and affects the merits of the application. Yet with design applications the Office very often sets forth in notices of allowance or *Ex parte Quayle* actions requirements that applicants change some aspect of the drawings.

The probable reason for this practice is a misunderstanding among design examiners as to the applicability of *Ex parte Quayle* to a design application, especially because *Ex parte Quayle* itself dealt with a drawing objection. But the drawing change in *Ex parte Quayle* dealt with the character of a lead line in a *utility* application, and was described as “most trivial in character.” 25 USPQ 74. *Ex parte Quayle* turned on the *triviality* of the change being made; the fact that it was in a drawing was incidental. In contrast, changes to design application drawings are almost never trivial because how a drawing looks defines the scope of the claim, and explicitly forms a part of it. Examiners should never close prosecution taking the position that a claim is allowable, while at the same time effectively indicating the claim is objectionable by requiring a substantive change to the drawings of a design application in an *Ex parte Quayle* action or notice of allowance.

The effect of these improper notices of allowance and *Ex parte Quayle* actions is to prematurely close prosecution on the merits while substantive issues requiring treatment on the merits remain unresolved. The applicant may try to convince the Examiner that closing prosecution was premature, but this rarely works because design Examiners in our experience believe that *Ex parte Quayle* has particular applicability to drawing changes, as noted above. An applicant’s only practical recourse is to file a wasteful and expensive

continued prosecution application to force prosecution on the merits to be reopened to contest the requirement.

An applicant is entitled to claim his invention as he sees fit and to challenge any substantive requirement imposed by the Office until prosecution is justifiably closed. The Office's practice of imposing substantive requirements while prematurely closing prosecution on the merits denies these rights to design applicants and should be studied to help determine the most effective way to discontinue this practice.

It is suggested that review of these practices be undertaken by personnel outside of the design unit to ensure consistency with Office-wide standards and practices.

Respectfully submitted,

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The views expressed herein are our own and are not to be attributed to any other person or entity including Sterne, Kessler, Goldstein & Fox P.L.L.C., or any client of the firm.

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