

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ZOOEY C. CHU

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Appeal No. 2001-0959  
Reissue Application 08/548,218<sup>1</sup>

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ON BRIEF

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Before HARKCOM, Vice Chief Administrative Patent Judge,  
and THOMAS and TORCZON, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the following design claim:

The ornamental design for a chair, as shown and described.

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<sup>1</sup> Application for patent filed October 25, 1995 for Reissue of Patent No. D 340,589, granted October 26, 1993; based on Application 07/419,634, filed October 11, 1989; which is a continuation-in-part of Application 07/150,093, filed January 29, 1988 (abandoned).

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There are no references relied on by the examiner.

We rendered a decision in a prior appeal in this application, Appeal No. 98-2307, mailed on July 29, 1999, in which we reversed pro forma an outstanding rejection under 35 U.S.C. § 251. This led to renewed examination in which the examiner set forth new bases for rejecting the present claim on appeal as set forth in Paper No. 17, mailed on November 30, 1999, to which a subsequent final rejection was issued in Paper No. 20, mailed on April 28, 2000. The examiner has restated these grounds of rejection at page 3 of the Answer. According to the examiner's reasoning, the design claim on appeal stands rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement thereof since the examiner has taken the view that the present reissue application introduces new matter not supported by the disclosure set forth in the design patent D 340,589 as originally filed. The present design claim on appeal also has been rejected under 35 U.S.C. § 171 as being directed to more than a single patentably distinct design. Finally, the claim stands rejected under 35 U.S.C. § 251 as not being for the same invention as disclosed in the original patent, the examiner taking the further view that there was a

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lack of defect in the original application and a lack of error in obtaining the original patent.

We refer to the Brief for a statement of the appellant's positions and to the rejections set forth by the examiner in the earlier-noted Office actions in Paper Nos. 17 and 20 as the basis for the rejection which has been succinctly restated at page 3 of the Answer with the examiner's responsive arguments in succeeding pages.

#### OPINION

For the detailed reasons which follow, we sustain only the first and third of the three stated rejections set forth by the examiner in the noted prior Office actions and the Answer.

We turn first to the rejection of the design claim on appeal under the written description portion of 35 U.S.C. § 112, first paragraph. Because appellant's brief contains repeated arguments urging in part that the presently claimed design has a proper basis within the originally filed application 07/150,093, filed January 29, 1998, we turn now to address the prosecution history of that application.

This first or grandparent application was filed with a single figure in the form of a photograph allegedly depicting a

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perspective view of the chair design in that application. The examiner's first Office action, Paper No. 6, mailed on August 27, 1990, rejected (see page 2) the design claim on appeal on the ground of "indefiniteness of disclosure under the provisions of 35 U.S.C. § 112, second paragraph." A Notice of Abandonment was mailed on April 4, 1991, based upon appellant's failure to respond to this first Office action mailed on August 27, 1990.

Appellant subsequently filed Application 07/419,634, filed October 11, 1989, as a continuation-in-part of the grandparent application. Thus, the parent application from which the design patent D 340,589, granted on October 26, 1993, issued had copendency with the grandparent application. The single figure comprising the design in the grandparent application was not present in this second or parent application. The prosecution history of the parent application revisited the issue of appellant's compliance with the first paragraph of 35 U.S.C. § 112 of the grandparent application because the examiner denied continuation-in-part status to the second application thus taking the position that appellant was not entitled to the earlier filing date of the grandparent application. Appellant contested this finding of the examiner through the Final Rejection. In the

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Interview Summary Record, Paper No. 11, mailed on March 18, 1993, the examiner continued the position set forth in the Final Rejection including a rejection under 35 U.S.C. § 103.

Subsequent papers filed by appellant in the parent application did not further contest the examiner's view that appellant was not entitled to priority of the grandparent application and led to the allowance of the parent application because the examiner withdrew the rejection under 35 U.S.C. § 103 based upon appellant's filing of an affidavit within 37 CFR § 1.131. This allowance caused issuance of this parent application as D 340,589 on October 26, 1993, from which the present application for reissue was filed on October 25, 1995, appellant generally seeking broader claim protection within the two-year time frame provided by 35 U.S.C. § 251 in the present reissue application than provided by D 340,589.

The examiner continued to raise the issue with respect to appellant relying upon the grandparent application for priority purposes in the first Office action in this reissue application, Paper No. 4, mailed on April 11, 1996. Page 3 of this Office action rephrased again the basis for the rejection in the grandparent application based upon "indefiniteness of disclosure"

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as we noted earlier, but also alluded at the bottom of page 3 of this Office action that the subject design "was not fully disclosed, and therefore indefinite." This "not fully disclosed" analysis indicates to us that the examiner was articulating lack of enablement within 35 U.S.C. § 112, first paragraph, as well as indefiniteness within the second paragraph of 35 U.S.C. § 112. Appellant appeared to think the same as expressed at page 4 of the Amendment filed under 37 CFR § 1.116 in the present reissue application, Paper No. 9, received on February 18, 1997. The examiner took the position in this first Office action, and it has continued in some form in this application during prosecution, that because of these noted deficiencies within the first and second paragraphs of 35 U.S.C. § 112, appellant cannot be accorded priority to his grandparent application within 35 U.S.C. § 120 for the design present in the parent application which issued as D 340,589 and, of course, the present reissue application thereof. Obviously, there is no copendency of the grandparent application with the present reissue application.

That a succeeding application is accorded the filing date of a parent application within 35 U.S.C. § 120 only if the prior application complies with the provisions of 35 U.S.C. § 112,

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first paragraph is well-stated in In re Daniels, 144 F.3d 1452, 1456, 46 USPQ2d 1788, 1790-91 (Fed. Cir. 1998). We agree with the examiner's view that the grandparent application was indefinite within the second paragraph of 35 U.S.C. § 112 and the examiner's apparent view additionally in this application that the enablement provision of the first paragraph of 35 U.S.C. § 112 was also not met. These issues included indefiniteness characterized in incomplete showings of the spider base, the pedestal support column of the chair, both adjustment levers under the seat, the under-seat support structure and even the seat member and backrest themselves. Recalling that there was only a single photograph presentation filed in the grandparent application alleged to be a perspective view of the chair, there was no showing of bottom, back, clear frontal, or side views thereof in the grandparent application. Additionally, the grandparent application did not show any arms attached to the chair in any manner. As noted earlier, the single figure comprising the design in the grandparent application was not present in the second or parent application from which D 340,589 issued.

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Since the parent application was a CIP application of the grandparent application, the filing of the CIP application to overcome a rejection creates a rebuttable presumption that the rejection was proper. Pennwalt Corp. v. Akzona, Inc., 740 F.2d 1573, 1578, 222 USPQ 833, 836 (Fed. Cir. 1984) (affirming a denial of benefit); Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1438-40, 221 USPQ 97, 106-07 (Fed. Cir. 1984) (estopping the patentee from retroactively challenging a new matter finding). The prosecution history has never overcome this rebuttable presumption. Moreover, it is noted that appellant's grandparent application was held abandoned for failure to prosecute the application after the first Office action was issued in it and appellant did not contest the issue as raised by the examiner in the final Office action of the parent application, Paper No. 10, mailed on December 14, 1992, in 07/419,634 from which D 340,589 issued.

Similar/related priority issues were present in Studiengesellschaft Kohle m.b.H v. Shell Oil Co., 112 F.3d 1561, 42 USPQ2d 1674 (Fed. Cir. 1997). The district court concluded that the disclosure of two earlier filed applications cannot be combined to acquire an earlier filing date under 35 U.S.C. § 120.

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On appeal the Court of Appeals for the Federal Circuit stated at  
112 F.2d 1564, 42 USPQ2d 1677:

Section 120 sets forth the requirements for a patent application to receive the benefit of the earlier filing date from a prior application:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States . . . which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application . . . if it contains or is amended to contain a specific reference to the earlier filed application.

35 U.S.C. § 120. To qualify for an earlier filing date, section 120 requires, inter alia, that the earlier-filed U.S. patent application contain a disclosure which complies with 35 U.S.C. § 112, ¶ 1 (1994) for each claim in the newly filed application. Thus, this benefit only applies to claims that recite subject matter adequately described in an earlier application, and does not extend to claims with subject matter outside the description in the earlier application. See Waldemar Link, GmbH & Co. v. Osteonics Corp., 32 F.3d 556, 558-59, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994). In other words, a claim complies with 35 U.S.C. § 120 and acquires an earlier filing date if, and only if, it could have been added to an earlier application without introducing new matter. See Mendenhall v. Cedarapids, Inc., 5 F.3d 1557, 1566, 28 USPQ2d 1081, 1088-89 (Fed. Cir. 1993).

Under 35 U.S.C. § 112, ¶ 1, and consequently under 35 U.S.C. § 120 as well, an applicant must "convey with reasonable clarity to those skilled in the art that, as of the filing date should, he or she was in possession of the invention." Vas-Cath Inc v. Mahurkar, 935 F.2d

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1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant cannot show possession of an invention based upon a combination of several distinct previous applications unless he shows that one of the applications discloses the invention. See In re Scheiber, 199 USPQ 782, 785 (CCPA 1978) (Baldwin, J., concurring). In other words, a claim that relies upon a combination of previously-filed applications is not entitled to an earlier filing date because the applicant has not demonstrated possession of the complete invention at the time of an earlier application. *Id.* at 785 ("[A]ppellant is asking [the court] to make the decision that various bits of his claimed invention are supported in the parent applications.... The majority opinion properly rejects this approach."). In sum, 35 U.S.C. § 120 requires an applicant to meet the disclosure requirement of § 112, ¶ 1 in a single parent application in order to obtain an earlier filing date for individual claims.

Here, appellant seeks to in-part reach back to the grandparent application for a design concept for a chair without arms and to its CIP application, from which issued D 340,589, for other design features. Appellant is thus not eligible for either earlier filing date based on his grandparent and parent applications since disclosures of these two earlier-filed applications cannot be combined to acquire an earlier filing date under 35 U.S.C. § 120, since neither application alone shows complete possession of the invention claimed in the patent, and since the claim of the patent thus could not have been added to any single previously filed application without introducing new matter.

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In view of the foregoing, we therefore find appellant may not rely upon the grandparent application in this series of applications as a basis for certain aspects of the design claim on appeal in this reissue application, including a chair without arms.

We now take a focused view of the written description issue within 35 U.S.C. § 112, first paragraph, as it applies to the present design claim on appeal in this reissue application as it relates to the presentation of the design claimed in the earlier noted parent application, from which D 340,589 issued. Design patent D 340,589 issued with six drawing figures, four of which are identical to Figures 1 through 4 present in this reissue application. Figure 5 in the design patent depicted a bottom view of the claimed design, which figure has presently been deleted in this reissue application. Because the examiner permitted this, the present Figure 5 in this reissue application was original Figure 6, a top view of the claimed design, in the design patent itself. It is noted that the Figure 5 description in the design patent itself stated that this figure "is a bottom view thereof." The present reissue application was filed with the additional language associated with this Figure 5 description

by adding “, the bottom view not forming a part of the present invention.” This language was not present in the patent or the prosecution thereof in obtaining it.

Moreover, the present application was filed with additional Figures 6 through 24 setting forth three additional embodiments not per se shown in the design patent itself. By subsequent amendment the drawings and their brief description were amended in this reissue application to eliminate the Figure 5, Figure 11, Figure 17, and Figure 23 showings altogether, thus causing the number of figures present in this reissue application to be renumbered as present Figures 1 through 20. It is on the basis of this latter numbering that the examiner and appellant appear to agree to the following:

- Embodiment I: Figures 1 through 5;
- Embodiment II: Figures 6 through 10;
- Embodiment III: Figures 11 through 15;
- Embodiment IV: Figures 16 through 20.

Our study of the prosecution history in the parent application which led to the design patent D 340,589 itself provides no basis for appellant to presently claim any of the above noted embodiments. There is no dispute between the

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examiner and appellant that appellant filed the present reissue application within the two-year time frame provided by 35 U.S.C. § 251 to seek broader claim protection than that afforded by D 340,589. The manner in which appellant undertook this approach was to essentially carve out or set forth for the first time in this reissue application three additional new embodiments labeled as embodiments II through IV, along with an attempt to preserve the integrity of the first embodiment. There is no written description in D 340,589 for any of these embodiments including the removal of the bottom showing of the design patent itself, originally labeled Figure 5, as a part of the first noted embodiment. Consistent with the examiner's position maintained throughout prosecution in this reissue application, appellant has no basis within the written description portion of 35 U.S.C. § 112 to now claim any embodiment which does not include the bottom showing in original Figure 5. There is no evidence in the prosecution history of the so-called parent application from which the present design issued as a patent that appellant possessed then any design without the bottom showing. The remedial nature of 35 U.S.C. § 251 might have permitted appellant to now claim in this reissue application broader embodiments

depicted in the four embodiments II through IV noted earlier in this opinion had they been presented in the so-called parent application from which the present design patent issued but were unclaimed features or embodiments.

We have just indicated that there is no written support within the written description provision of 35 U.S.C. § 112, first paragraph, in the original patent for the embodiment shown in Figures 1 through 5 for a chair without a base. Correspondingly, there is no basis in the original patented drawing figures for a chair without arms, presently depicted in Figures 6 through 10 in embodiment II. Additionally, there is no basis in the original patent's drawings directed to a chair without arms and without an adjustment grip at the base of the backrest presently shown in Figures 11 through 15. Finally, there is no basis in the original patent for a chair directed to only a seat and backrest portion as depicted in Figures 16 through 20. In each of these enumerated embodiments I through IV and Figures 1 through 20, appellant has in this reissue application for the first time selectively deleted or essentially carved out selective features or combinations of features of the design present in the original design patent D 340,589. This

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deletion or carving out process occurred in this reissue application and not in the prosecution of the design patent itself. Thus, it is clear to us that there was no possession by appellant in D 340,589, and that there was no written description basis then, for any of the presently claimed four embodiments shown in Figures 1 through 20 in this application.

It is apparent that we do not agree with the examiner's view that appellant may delete the original Figure 5 showing from the design patent depicting the bottom view of the claimed chair design because this too amounts to a written description issue and new matter by deletion. The examiner's view that the absence of a bottom view presently complies with the sufficiency of disclosure as per Ex parte Kohler, 1905 C.D. 192, 116 O.G. 1185, is misplaced. We view Kohler as limited to the examiner's requirement therein of the cancellation of Figure 3 of the drawings in that design because this Figure 3 showing was of a cross-sectional view of the claimed design where the Commissioner indicated that the article in question would never have such a cross-sectional appearance. Because appellant regarded the original design as including the bottom view that issued in the design patent here, it would be new matter to presently delete it

because appellant had no written description for the absence of this view in the design patent itself.

Again, even the remedial provisions of 35 U.S.C. § 251 do not now permit appellant to claim any design he did not have in his possession in the parent application to begin with.

Appellant's reliance upon In re Daniels, supra, is misplaced. The court in Daniels permitted in a subsequent application the removal of leaf or surface ornamentation in a claimed design set forth in an earlier application because the court observed that the leaf ornamentation did not obscure the underlying design, all details of which were visible in the drawings of the earlier filed application. The leaf design was considered a "mere indicium that did not override the underlying design." Daniels, 144 F.3d at 1457, 46 USPQ2d at 1790-91. Further, the court observed that the subject matter remaining in the later application was "common to that of the earlier application." Id. Because the superimposition of the leaf design upon the underlying design did not obscure the underlying design itself, the court considered the appellant in that case to have possessed the invention in the prior application that is claimed in the second application, thereby entitling appellant in

that case to priority within 35 U.S.C. § 120. We view this case as indicating basically that surface indicia is not a part of an initial design. The teaching value of this case would indicate that a logo or part number or the like may be removed in a subsequent application to the extent it may be fairly characterized as surface indicia not a part of the original or initial design.

Appellant's apparent position is bottomed upon an extension of this view such that if the design is "clearly visible" in the earlier design it may be claimed in any manner of combination and subcombination of elements in a subsequent design application such as this reissue. We do not see any "clear visibility" test as noted by appellant at page 12 of the Brief to be derived from In re Daniels beyond removal of surface ornamentation which did not obscure the underlying design itself, such as to permit appellant here to file a reissue application and essentially carve out now something for which no possession within 35 U.S.C. § 112, first paragraph, existed in the underlying patent. Thus, the deletion or absence now of a base figure view of the claimed design (embodiment I) does not correspond to the removal of surface indicia according to Daniels. Similarly, the deletion or

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absence now of an arm or set of arms in the chair set forth in embodiments II and III does not correspond to the removal of a logo or part number or surface indicia as in Daniels. Most telling, however, is the absence now of a base and arms as in the fourth embodiment of the present design Figures 16 through 20 does not correspond in any manner to the removal of surface indicia as in Daniels. As the examiner essentially sets forth at page 5 of the Answer, Daniels does not stand for the proposition that appellants are now permitted to remove elements or parts of an original design without running afoul of the written description portion of the first paragraph of 35 U.S.C. § 112. All four embodiments present in this reissue application result from appellant's presently changing the underlying patented design itself.

We agree with the examiner's observation at the bottom of page 6 of the Answer that appellant appears to be arguing in part in the Brief that the ordinary designer would identify the present chair design in the four embodiments herein as obvious variations of the single design set forth in the design patent itself. The best statement of resolving this issue that we are aware of is set forth in Lockwood v. American Airlines, Inc.,

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107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997), from  
which we quote:

Lockwood argues that the district court erred by looking solely at the applications themselves. We do not agree. It is the disclosures of the applications that count. Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. It extends only to that which is disclosed. While the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all the limitations must appear in the specification. The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought. See Martin v. Mayer, 823 F.2d 500, 504, 3 USPQ2d 1333,1337 (Fed. Cir. 1987) (stating that it is "not a question of whether one skilled in the art might be able to construct the patentee's device from the teachings of the disclosure. ... Rather, it is a question whether the application necessarily discloses that particular device.") (quoting Jepson v. Coleman, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963)). Lockwood argues that all that is necessary to satisfy the description requirement is to show that one is "in possession" of the invention. Lockwood accurately states the test, see Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), but fails to state how it is satisfied. One shows that one is "in possession of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious. Id. ("[T]he applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed.") (emphasis in original). One does that by

such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention. Although the exact terms need not be used in haec verba, see Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (“[T]he prior application need not describe the claimed subject matter in exactly the same terms as used in the claims. ...”), the specification must contain an equivalent description of the claimed subject matter. A description which renders obvious the invention for which an earlier filing date is sought is not sufficient.

In view of the foregoing, we sustain the rejection of the design claim on appeal under the written description portion of 35 U.S.C. § 112, first paragraph.

Turning next to the outstanding rejection of the design claim on appeal under 35 U.S.C. § 171, we reverse this rejection. The examiner has provided us no authority for making this rejection under 35 U.S.C. § 171. In effect, this rejection here is like the indefiniteness rejection in In re Platner, 155 USPQ 222 (Comm'r Pats. 1967). In that case the proper solution was said to be a restriction requirement. See MPEP § 1504.05; see also our discussion of In re Amos below. Accordingly, the Section 171 rejection of the design claim on appeal here is reversed.

Lastly, we turn to the examiner's rejection of the design claim on appeal under 35 U.S.C. § 251. We also sustain this rejection essentially for the reasons set forth by the examiner

in the last two Office actions and in the Answer. Many of the appellant's arguments and the examiner's positions as well appear to us to be somewhat of a rehash of positions already discussed but in a context of a different statutory basis. During the more recent prosecution history and appellant's responses thereto, the notion of the original patent not disclosing any of the present four designs presented in this reissue application amounted in part to a view of an intent not to claim the added designs in the original design patent. Appellant cites at page 17 of the Brief C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1354, 48 USPQ2d 1225, 1234 (Fed. Cir. 1998) which in part relies upon In re Amos, 953 F.2d 613, 21 USPQ2d 1271 (Fed. Cir. 1991), rehearing denied, (Fed. Cir. February 18, 1992). Here Bard relies on Amos for the proposition that reissue applications are not subject to rejection for failure to demonstrate an initial intent to claim, when the subject matter of the reissue claims satisfies § 112 requirements. This takes us back to our original analysis that we set forth in this opinion.

Moreover, at 953 F.2d 617-18, 21 USPQ2d 1274, the Court in Amos gives an instructive historical basis in statute and case law for the present "intent to claim" analysis within 35 U.S.C.

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§ 251. This statutory portion requires the Office to issue a reissue patent "for the invention disclosed in the original patent" when certain conditions have been met by a patentee. This quoted portion of the statute has been variously referred to as the "original patent" or "same invention" clause of 35 U.S.C. § 251. The noted portions of Amos emphasize the significant portions of In re Mead, 581 F.2d 251, 198 USPQ 412 (CCPA 1978) and In re Rowand, 526 F.2d 558, 187 USPQ 487 (CCPA 1975). The Court went on to indicate that the purpose of the "intent to claim" rationale is to ask essentially the same questions as to whether "new matter" has been introduced in the application for reissue, thus indicating that the new claims are not drawn to the same invention that was originally disclosed.

The Court in Amos cautioned at 953 F.2d 618 and 21 USPQ2d 1275 that the issue of whether the test for written description and enablement under 35 U.S.C. § 112, first paragraph, and for the "same invention" under 35 U.S.C. § 251 are in every case exactly coextensive had not been briefed or argued in the appeal in Amos. The Court, however, went on to give the following guidance at 953 F.2d 618-19, 21 USPQ2d 1275:

We conclude that, under both Mead and Rowand, a claim submitted in reissue may be rejected under the "original patent" clause if the original specification

demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent. [footnote 2 omitted] [emphasis added].

It is thus apparent that the analysis under § 251 essentially asks the same questions as are present with respect to a proper analysis within the written description portion of 35 U.S.C. § 112, first paragraph, that we have undertaken at length earlier in this opinion. Paraphrasing the quoted portion of Amos above, it is apparent to us and the examiner that as we set forth at length earlier in this opinion, there is no evidence in the original specification to the ordinary designer that appellant actually invented the design set forth in what appellant and the examiner characterize as the earlier-noted four embodiments. There has been asserted by the examiner, and we agree with the assertion, that there is a total absence of any disclosure in the parent design patent sufficient to indicate

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that the patentee could have claimed there the subject matter present in these four embodiments. There is no issue presented to us by the examiner that appellant did not enable and therefore did not disclose elements of the designs present among these four embodiments present in this reissue application in D 340,589. Therefore, an enablement issue within 35 U.S.C. § 112, first paragraph, has not been raised by the examiner. The so-called "objective intent to claim"-type of analysis is problematic in the context of a design application since generally there is very little if any written description per se beyond the description of the drawings in a design application and patent, and the design itself is characterized in the figures presented in the design application and patent. Thus, where as there is an apparent compliance with the enablement portion of 35 U.S.C. § 112, first paragraph, there is not in our judgment in this appeal any written description in D 340,589 to support the present designs according to the four embodiments in this reissue application.

Even In re Daniels, 144 F.3d at 1456, 46 USPQ2d at 1790 states the following:

It is the drawings of the design patent that provide the description of the invention. In re Klein, 987 F.2d 1569, 1571, 26 USPQ2d 1133, 1134 (Fed. Cir. 1993)

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(usual[ly] in design applications, there is no description, other than the drawings". Although linguists distinguish between a drawing and a writing, the drawings of the design patent are viewed in terms of the "written description" requirement of §112. Thus when an issue of priority arises under §120, one looks to the drawings of the earlier application for disclosure of the subject matter claimed in the later application. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991); Racing Strollers, 878 F.2d at 1420, 11 USPQ2d at 1301. The inquiry is simply to determine whether the inventor had possession at the earlier date of what was claimed at the later date.

We are essentially therefore back to the same issue that appellant had not possessed, intended to possess, or invented, or intended to claim the designs depicted in the various figures in this reissue application, in accordance with the characterization of the four embodiments comprising the present Figures 1 through 20, in the design patent D 340,589 itself.

In summary, we have sustained the examiner's rejection of the design claim on appeal under the written description portion of 35 U.S.C. § 112, first paragraph; reversed the rejection under 35 U.S.C. § 171; and sustained the third rejection within the provisions of 35 U.S.C. § 251. Therefore, since only one claim is before us, the decision of the examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Gary V. Harkcom, Vice Chief	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
James D. Thomas	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Richard Torczon	)	
Administrative Patent Judge	)	

JDT/cam

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Price, Heneveld, Cooper, DeWitt & Litton  
695 Kenmoor Drive S.E.  
P.O. Box 2567  
Grand Rapids, MI 49501