



USPTO

Design Application

Written Description

Roundtable

March 5, 2014

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Establishing Adequate Written Description Support in the Original Disclosure

- ***In re Owens***

No. 2012-1261

(Fed. Cir. 2013)

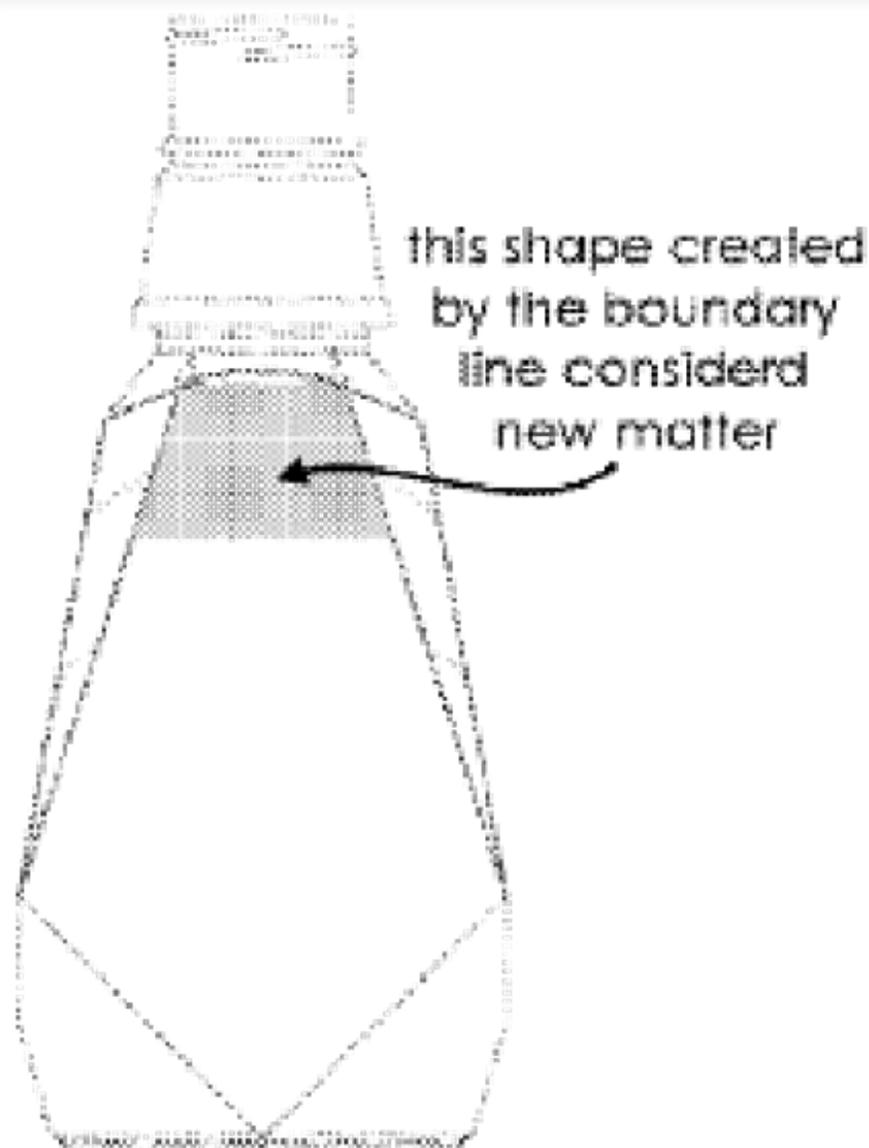


Fig. 2

Establishing Adequate Written Description Support in the Original Disclosure

- ***In re Zahn***

617 F.2d 261 (CCPA 1980)

- A design applicant may claim **LESS** than the entire article.
- Disclaimed portion identified in original application.

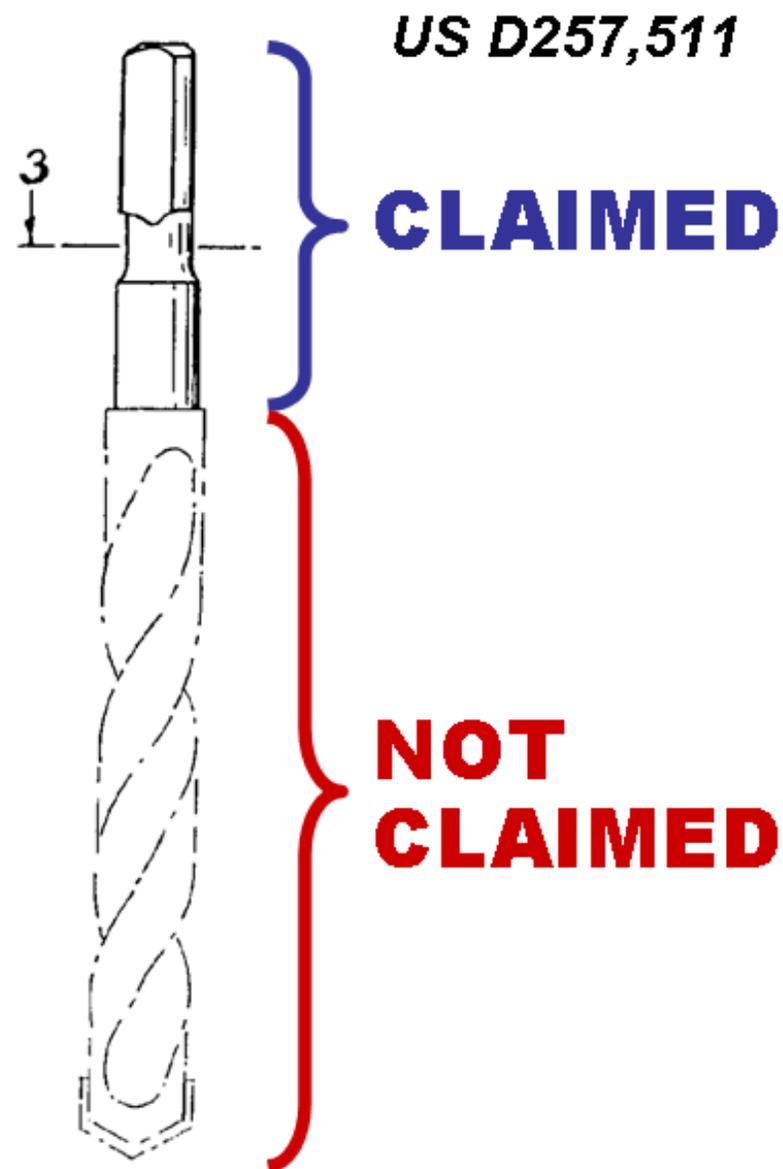


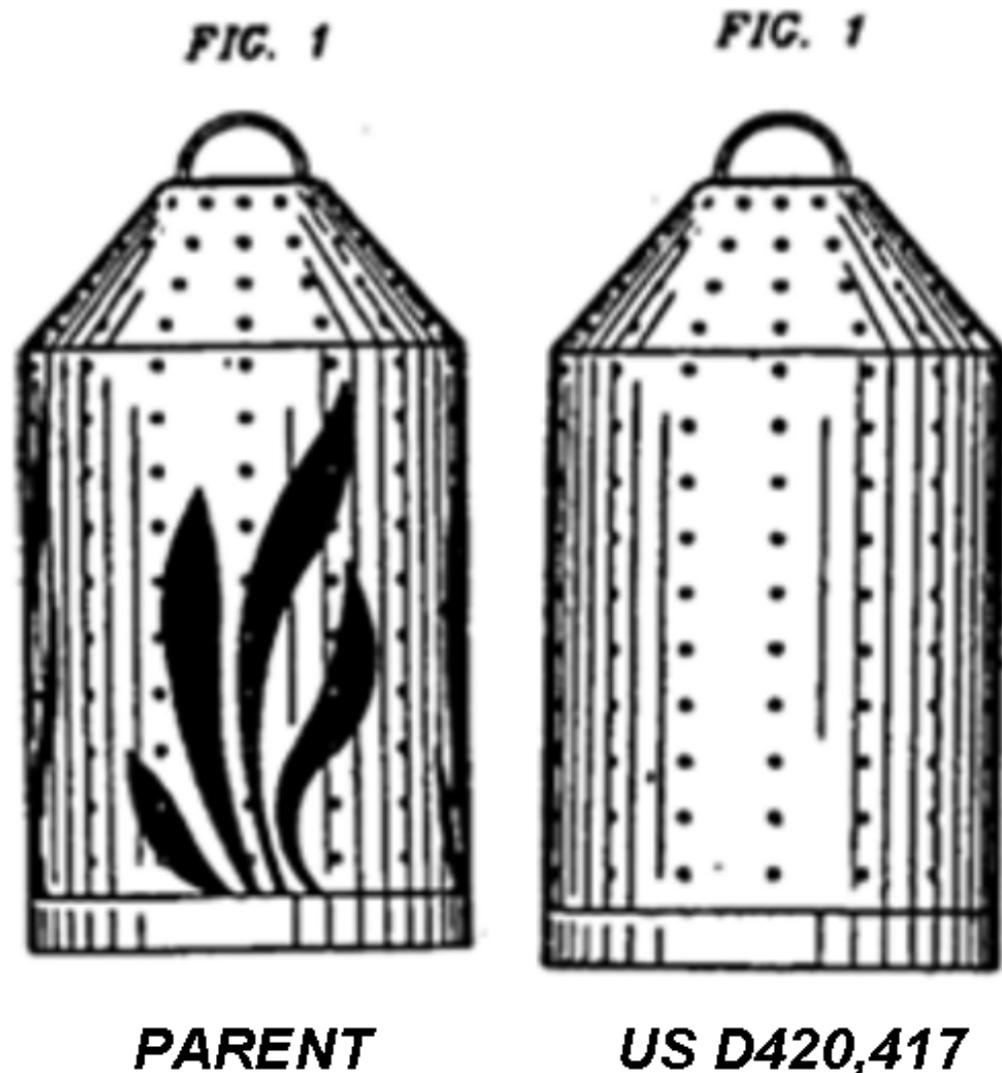
FIG-1

Establishing Adequate Written Description Support in the Original Disclosure

- *In re Daniels*

144 F.3d 1452 (Fed Cir. 1998)

- A design applicant may remove **ENTIRE** design element.
- Floral design removed in continuation



ISSUE:

When may a design applicant (dis)claim only a portion of a design element shown in the original application?



Establishing Adequate Written Description Support in the Original Disclosure

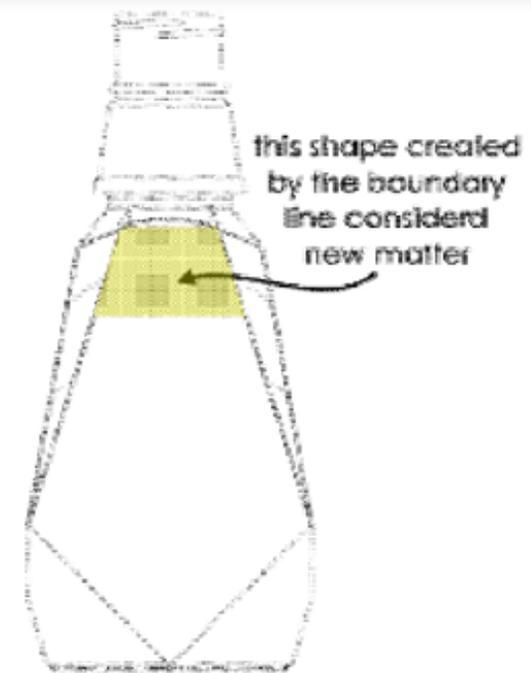
- *In re Owens*

No. 2012-1261

(Fed. Cir. 2013)

TEST:

What “**MIGHT** Be Claimed”



Therefore, the question for written description purposes is whether a skilled artisan would recognize upon reading the parent's disclosure that the trapezoidal top portion of the front panel might be claimed separately from the remainder of that area.

FINDING A NEW APPROACH:

- **Use standard specification and drawings.**
- **Add special description.**
- **MORE REQUIRED?**



STANDARD DRAWINGS:

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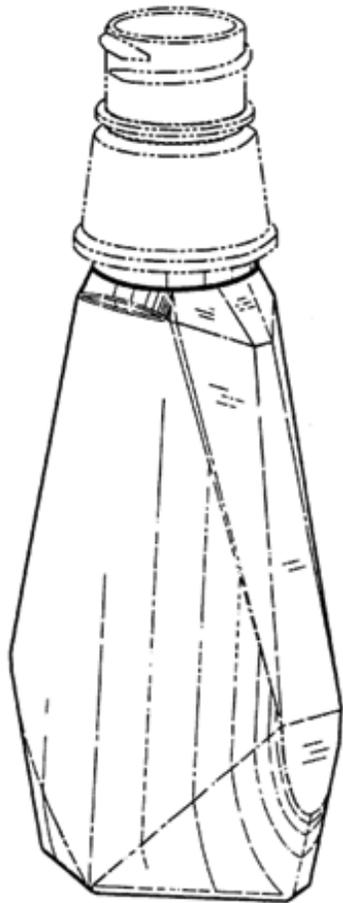


Fig. 1

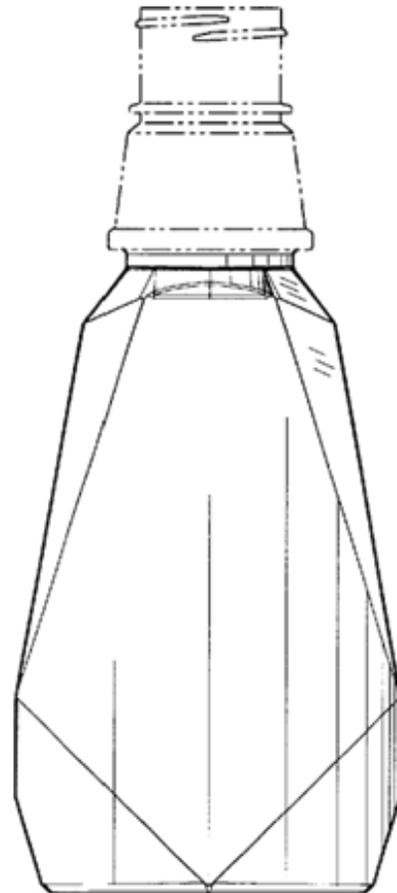


Fig. 2

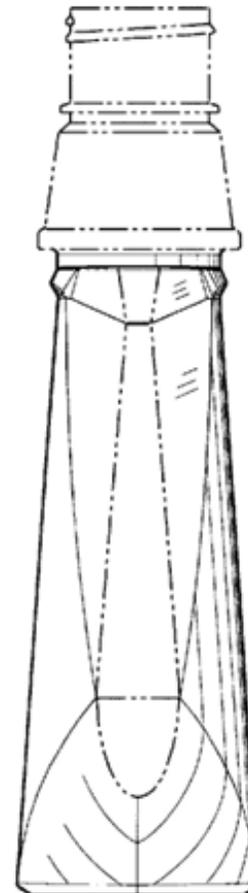
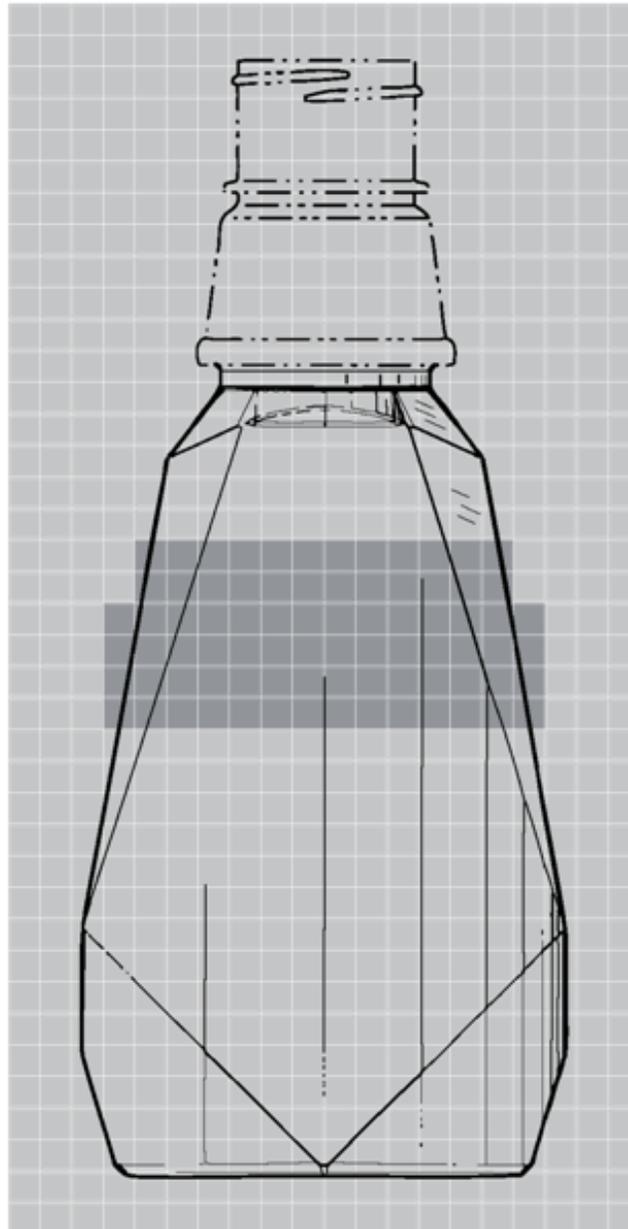


Fig. 3

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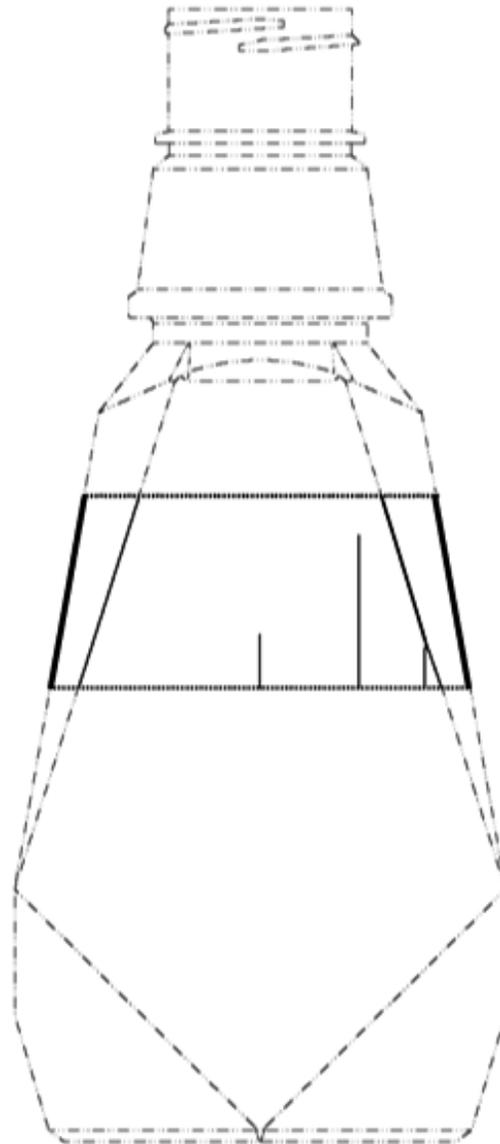
APPENDIX

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PAGE A-1

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PAGE A-2

Apply To Remaining Figures

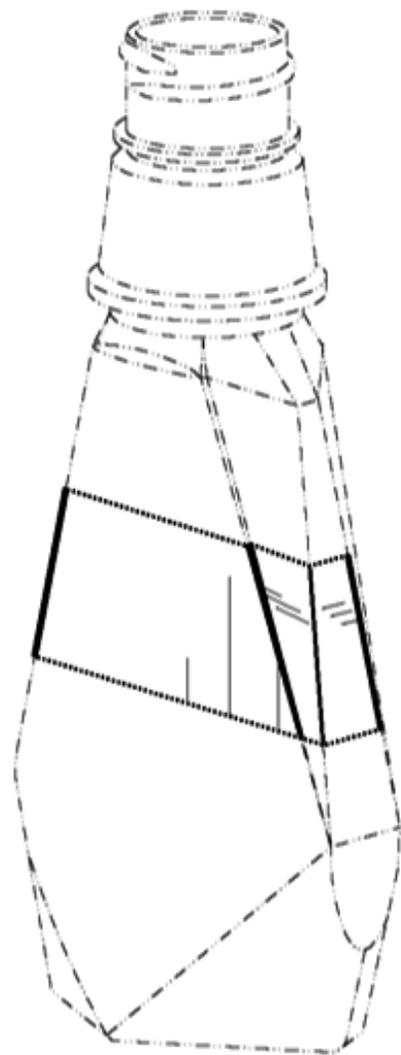


Fig. 1

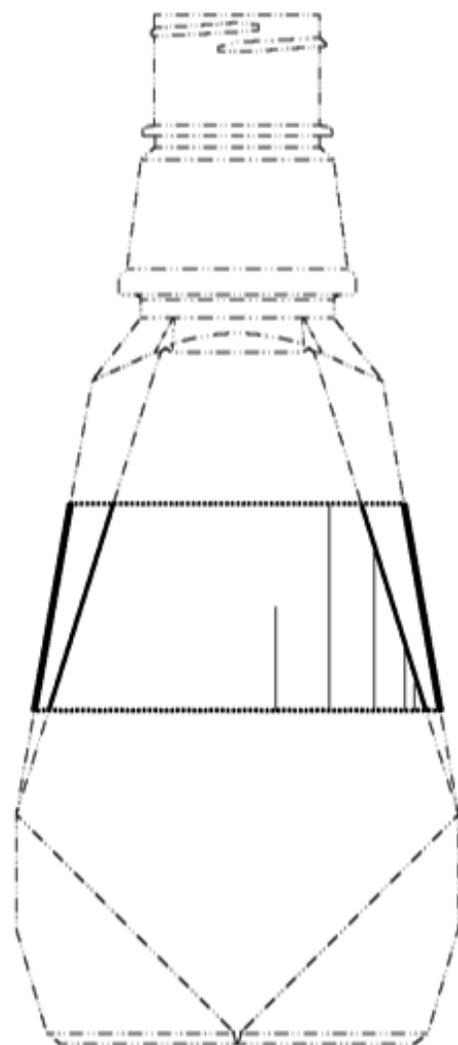


Fig. 2

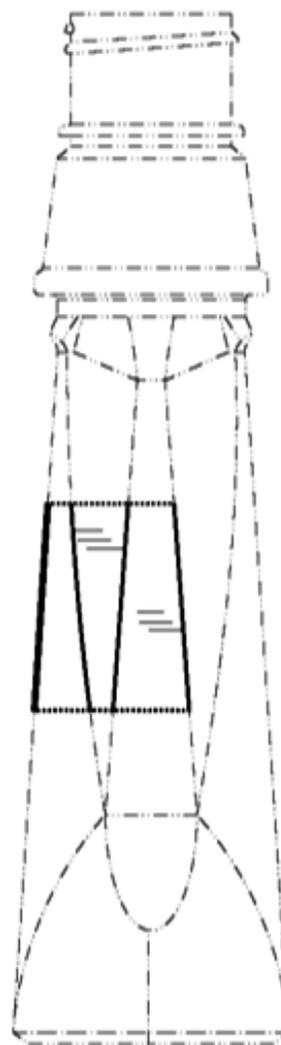


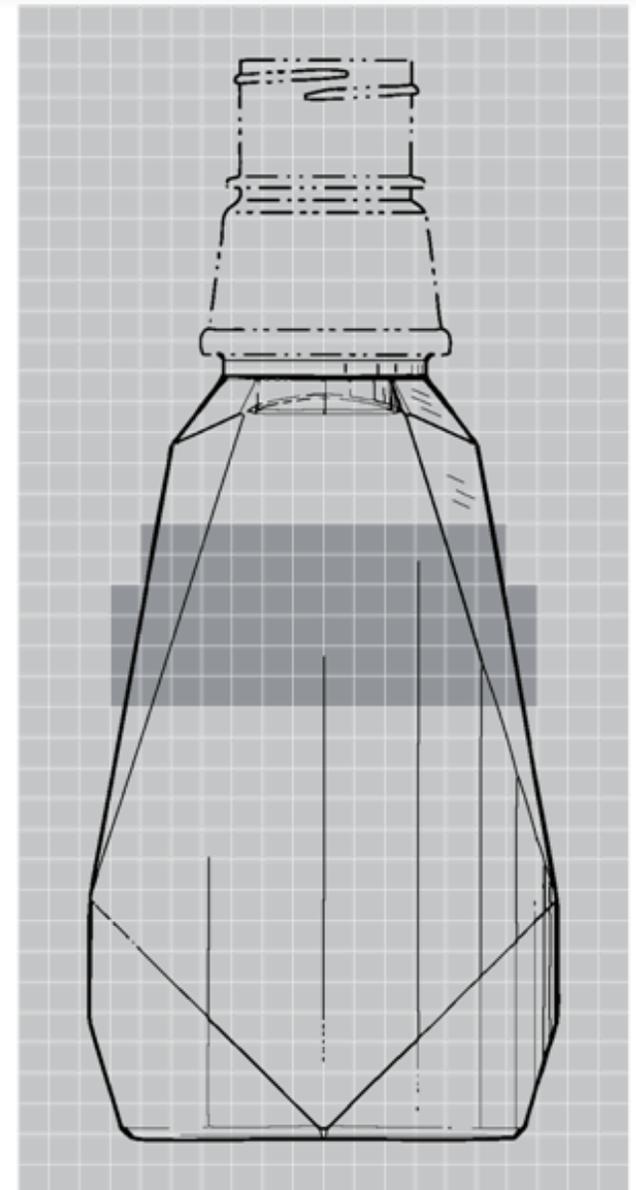
Fig. 3

*** Dotted
Lines
Added**

Sample Components Of The Special Description

The application includes an Appendix cover page and Appendix pages A-1 to A-2, showing additional design(s) for a bottle that constitute part of this **ORIGINAL** disclosure.

Appendix page A-1 shows the design of Figure 2 with a **GRID** applied thereto. The same grid may be applied to any figure of the application, including **ANY** Appendix page, whether a cross-sectional, elevation, side, top, bottom, front, rear or perspective view.

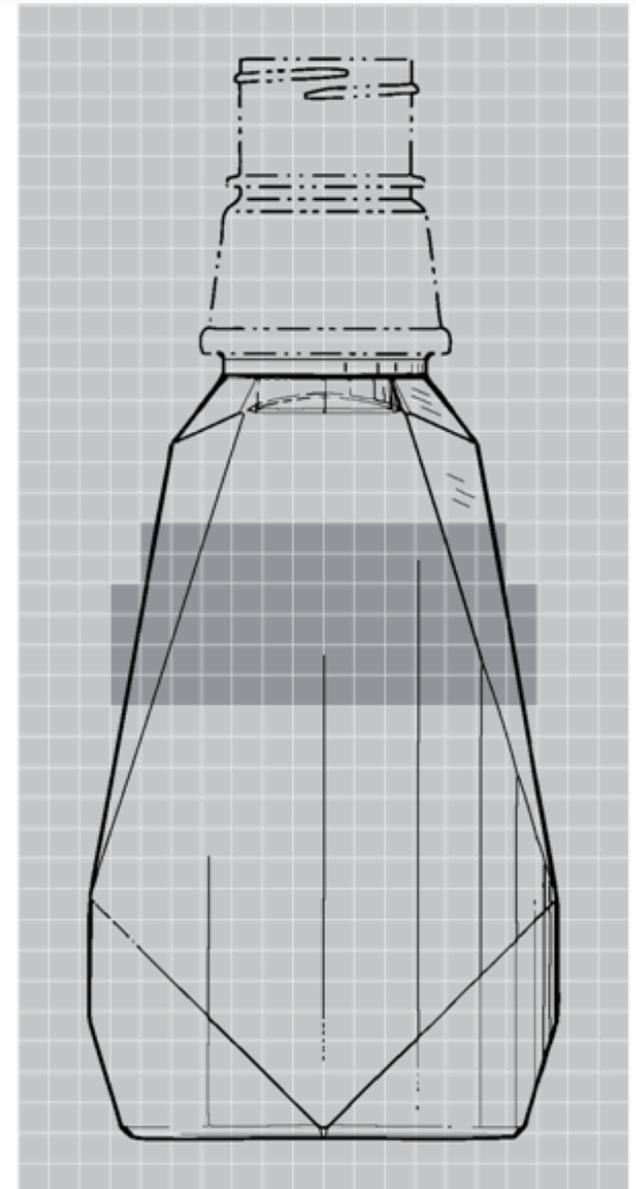


Sample Components Of The Special Description

Each grid square or combination of grid squares defines a “design element” that Applicant(s) may pursue in this or a continuing application.

The grid of page A-1 includes an example of several grid squares which are highlighted relative to the remaining squares.

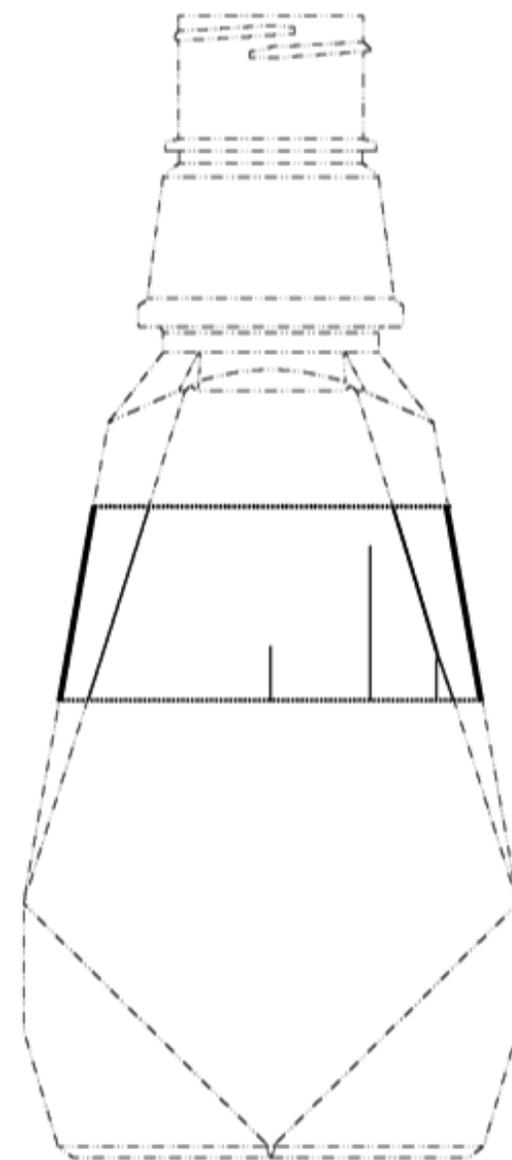
The grid squares may be either contiguous *or* non-contiguous.



Sample Components Of The Special Description

Appendix page A-2 includes the new design of page A-1, but **the grid has been removed and the remaining non-claimed structural features converted to broken lines**. Where a grid line had cut across a claimed part of the design that did not otherwise include a structure line, it has been converted to a dotted (boundary) line to delineate what is claimed and what is not claimed.

PAGE A-2





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OPEN DISCUSSION



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