

AIPLA

American Intellectual Property Law Association

Roundtable on the Written Description Requirement for Design Applications

Richard Stockton

AIPLA Industrial Design Committee

Principal Shareholder, Banner & Witcoff, Ltd. (Chicago)

March 5, 2014

- Factors: Perceived Advantages
- A Key Disadvantage: “Factor Infusion”
- How to Prevent “Factor Infusion”

Factors: Perceived Advantages

- Clarify How 112(a) Will be Applied in “Rare Situations”
- Lessen Need for:
 - “Gazillion embodiment” applications (GEAs)
 - Behemoth descriptive statements (BDSs)
- Counteract Specious Amendments

BDS: Simplified Example

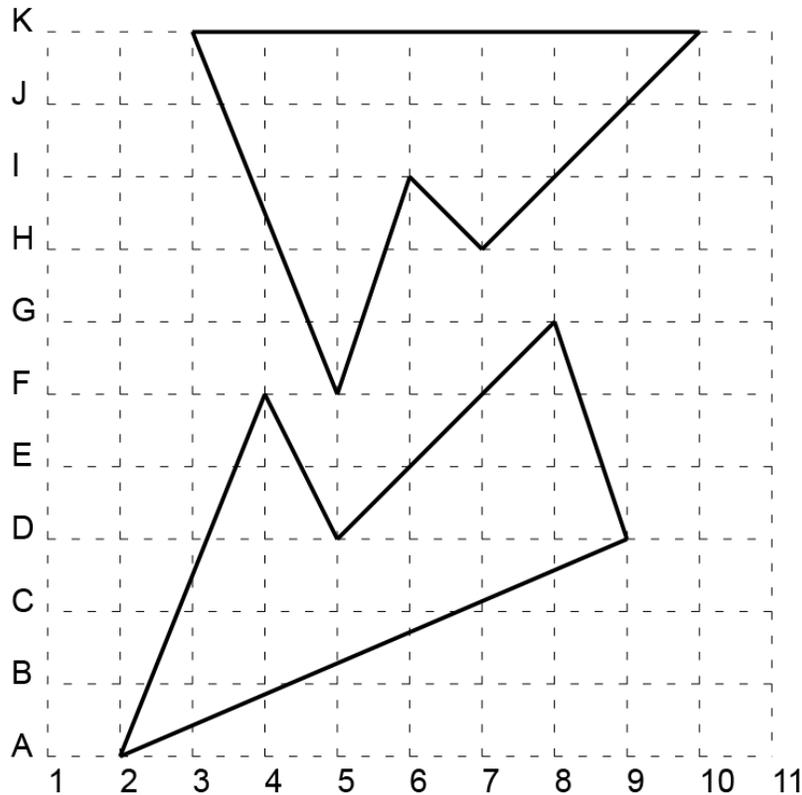


Fig. 1

The letters “A” through “K” shown in Fig. 1 are abscissa reference symbols only and form no part of the claimed design. The numbers “1” through “11” shown in Fig. 1 are ordinate reference symbols only and form no part of the claimed design. The dash-dot lines are for environmental purposes only and form no part of the claimed design.

The inventor is in possession of, and reserves the right to file divisional applications to all combinations of line segments shown (and identified by abscissa-ordinate reference symbols in the following inventor-certified appendix), including but not limited to any of the following unclaimed embodiments defined by the abscissa-ordinate-defined line segments in brackets set forth below: (1) {A2-D9-G8-D5-F4-A2}, (2) {K3-K10-H7-I6-F5-K3}, (3) ...

Specious Amendment: Example

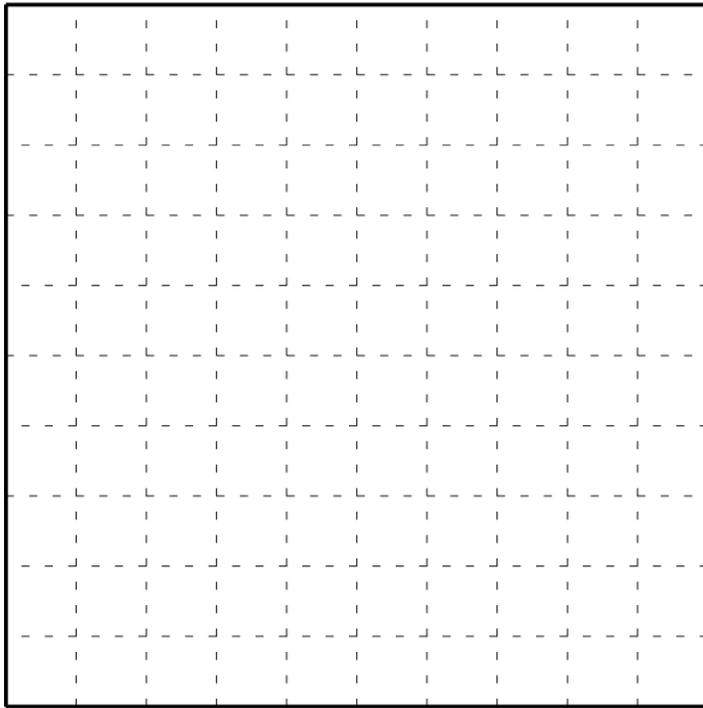


Fig. 1

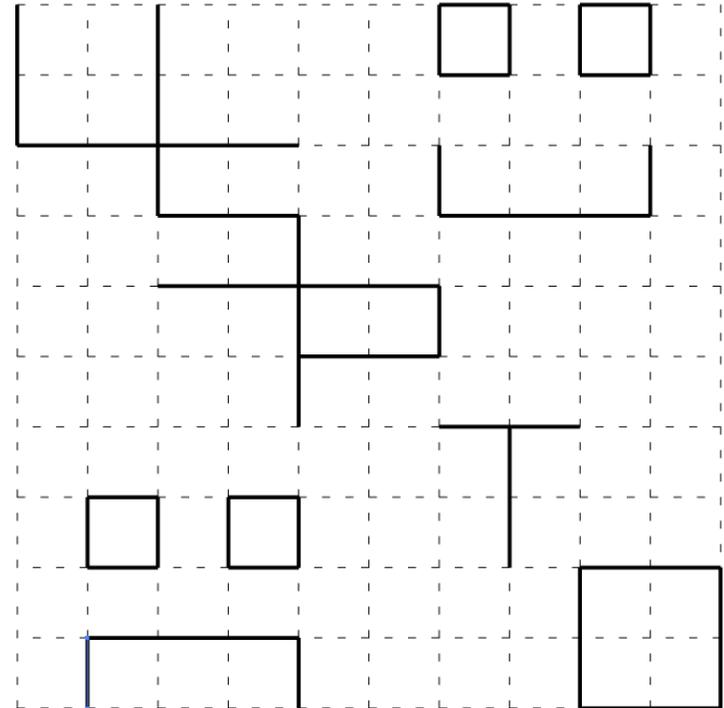


Fig. 1

(note: no descriptive statement)

Without protections, the mere existence of factors is likely to trigger express or tacit application of factors in non-
"rare situations"

("Factor Infusion")

“Factor Infusion”: Negative Consequences

- Forces applicants to continue preparing, and the USPTO to continue examining, otherwise unnecessary GEAs and/or BDSs
- Disadvantages small applicants
- Inconsistent with prior practice/case law
- Must avoid factor infusion to realize the overall goals of 112(a) clarity and efficient prosecution

Avoiding “Factor Infusion”: Thresholding

rare¹  [raɪr]  [Show IPA](#)

adjective, rar·er, rar·est.

1. coming or occurring far apart in time; unusual; uncommon: *a rare disease; His visits are rare occasions.*
2. thinly distributed over an area; few and widely separated: *Lighthouses are rare on that part of the coast.*
3. having the component parts not closely compacted together; not dense: *rare gases; lightheaded from the rare mountain air.*
4. unusually great: *a rare display of courage.*
5. unusually excellent; admirable; fine: *She showed rare tact in inviting them.*

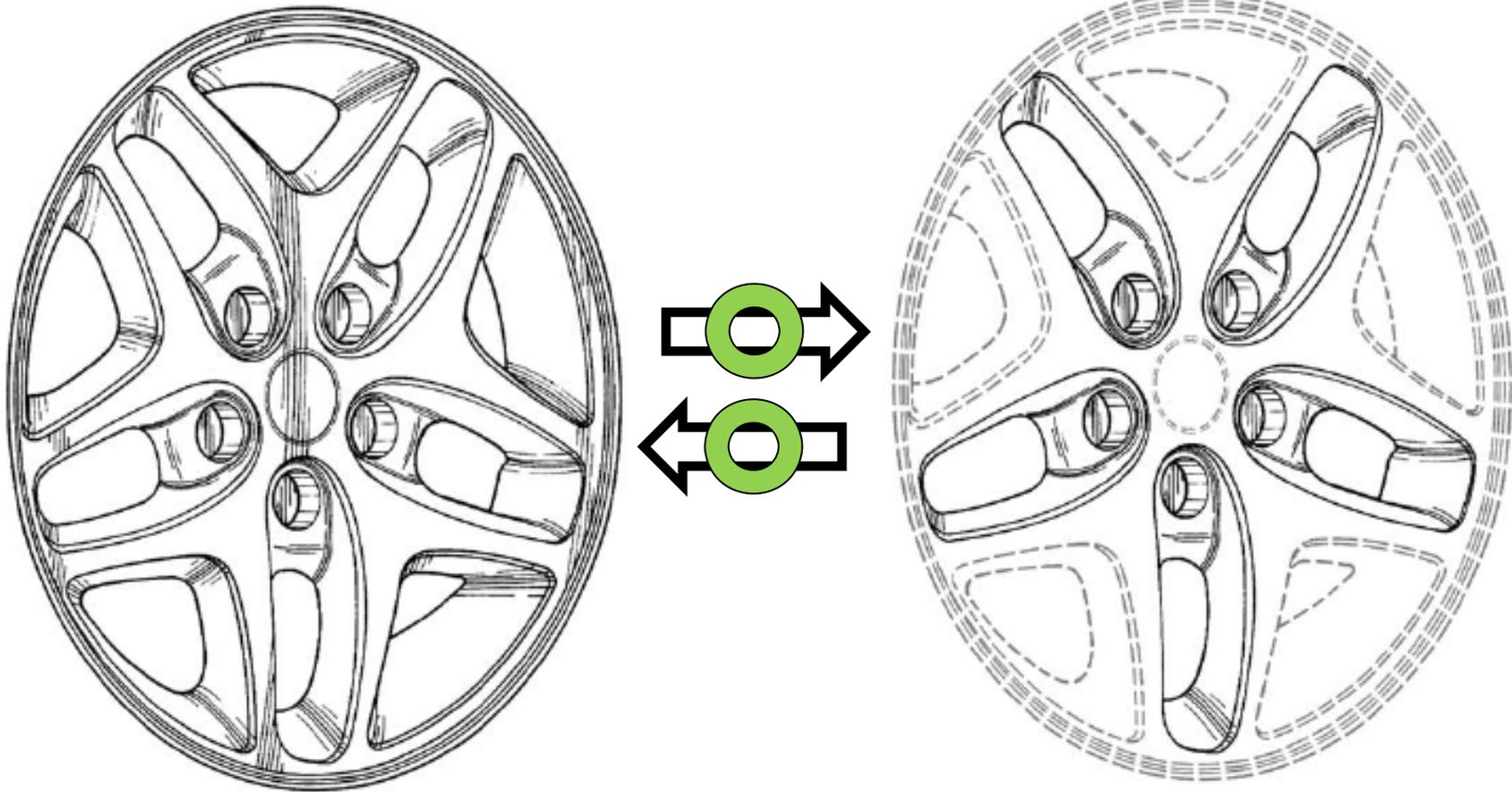
(source: Dictionary.com)

- Rare means rare
- Require clear explanation why an amendment presents a “rare situation,” including alleged randomness

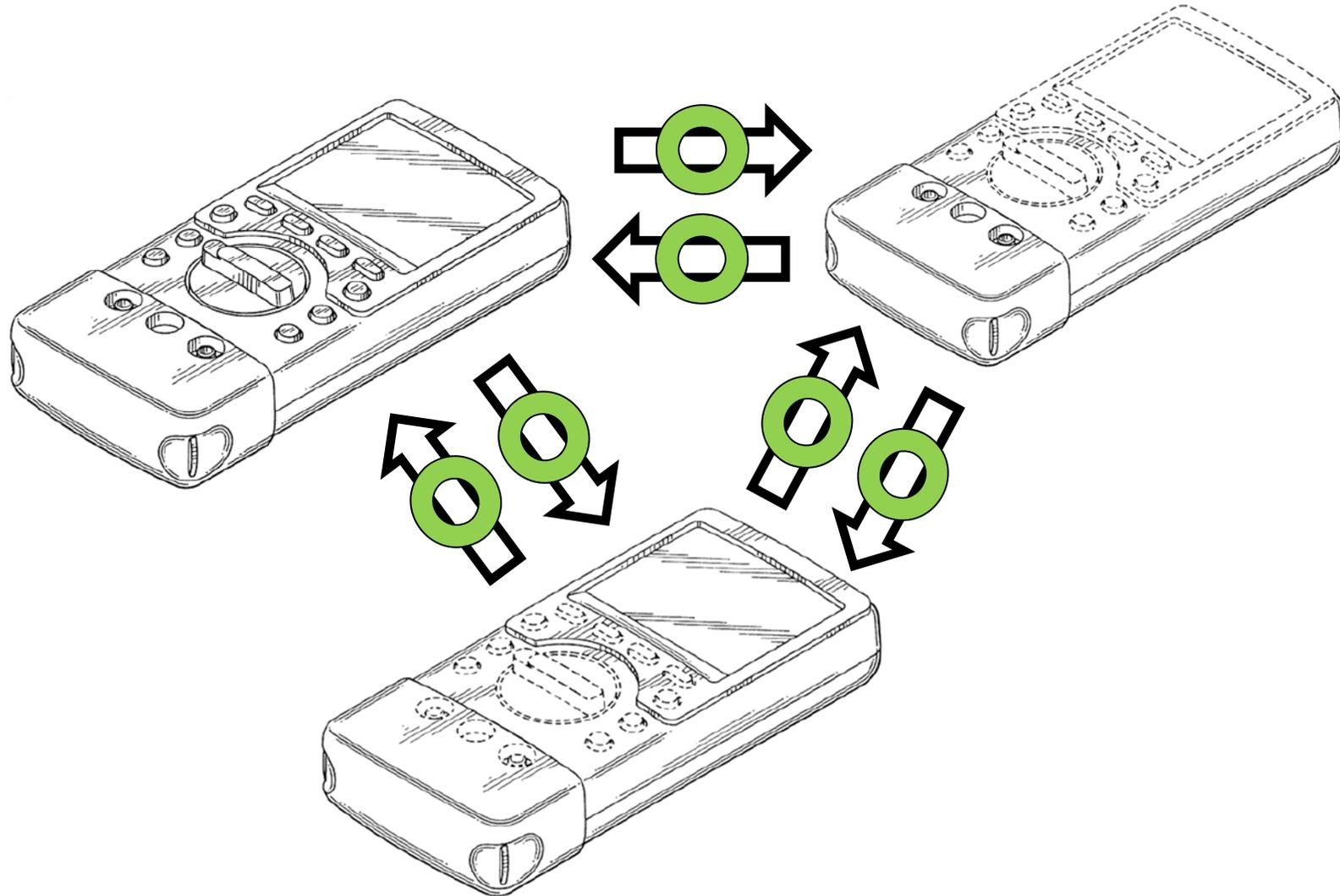
Avoiding “Factor Infusion”: Non-“Rare” Examples

Provide clear USPTO 112(a)-
OK™ examples for applicants
and examiners to rely upon

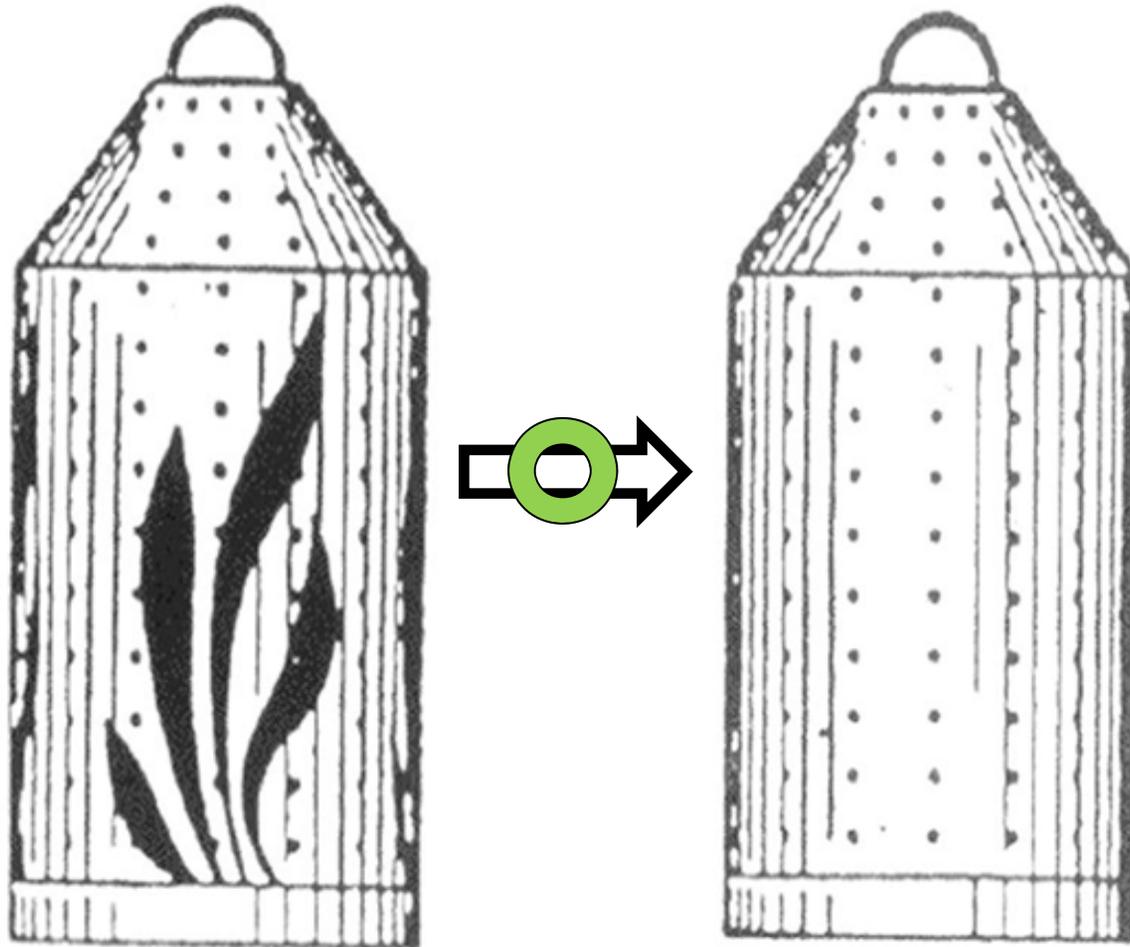
112(a)-OK™ Example #1



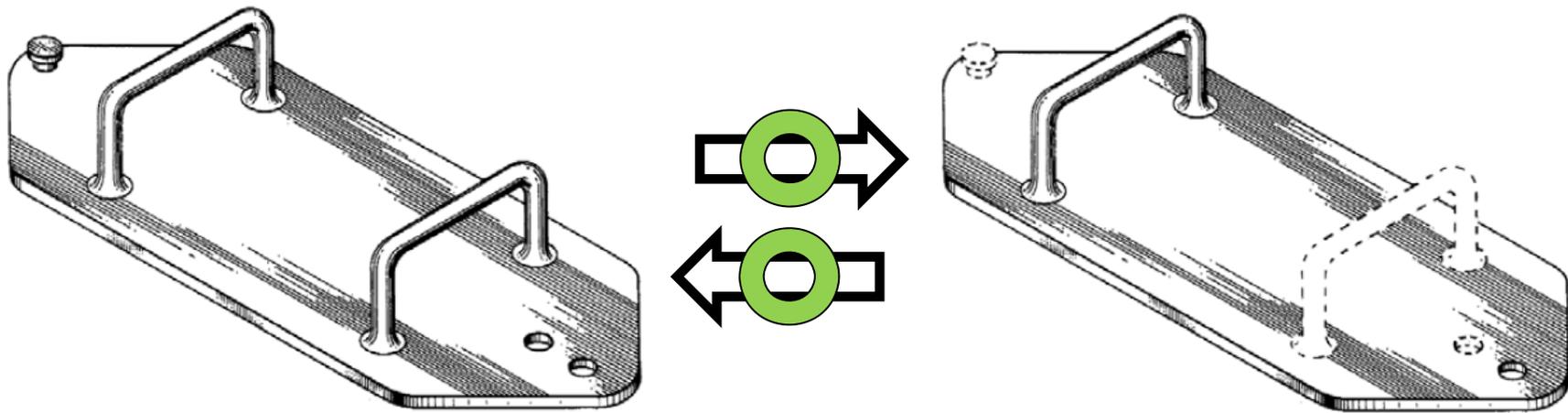
112(a)-OK™ Example #2



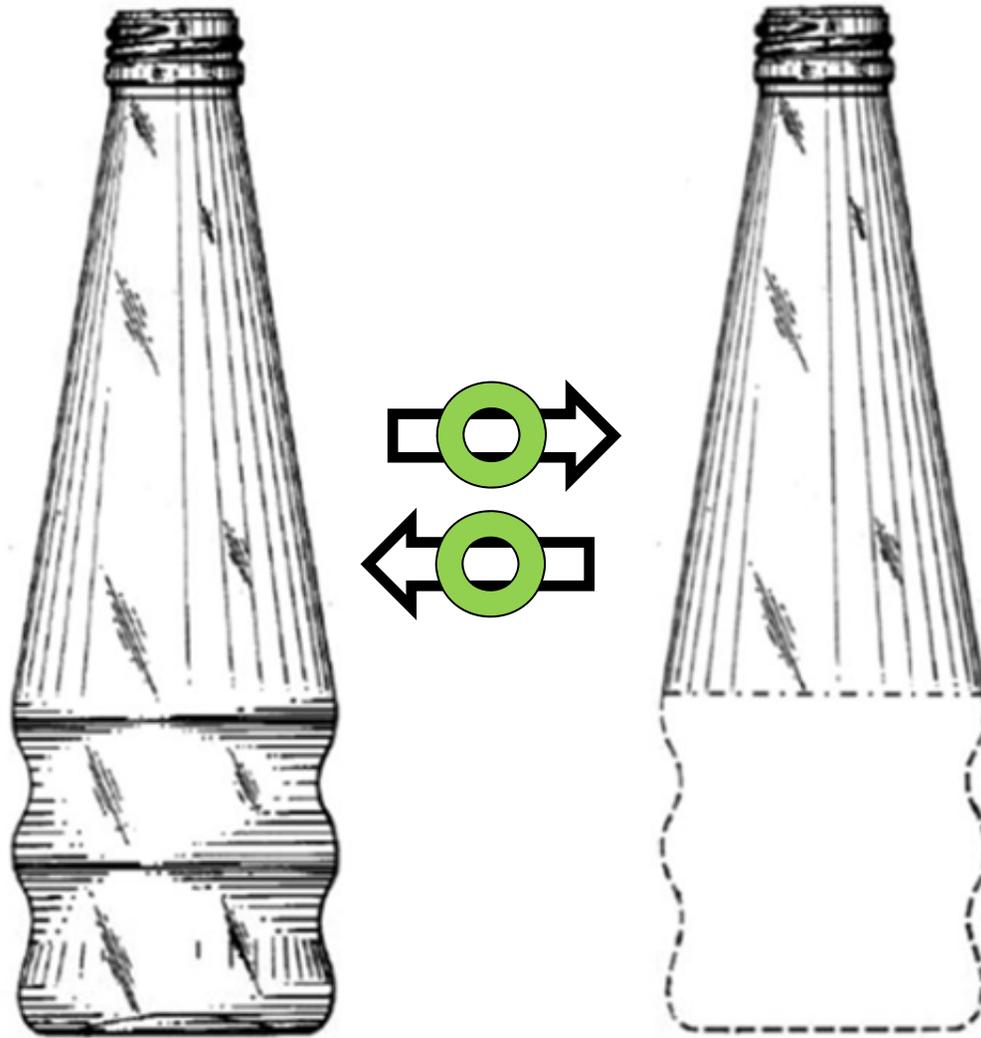
112(a)-OK™ Example #3



112(a)-OK™ Example #4



112(a)-OK™ Example #5



Avoiding “Factor Infusion”: MPEP Supplement

“In our view, the best advice for future applicants was presented in the PTO’s brief, which argued that unclaimed boundary lines typically should satisfy the written description requirement only if they make explicit a boundary that already exists, but was unclaimed, in the original disclosure. Although counsel for the PTO conceded at oral argument that he could not reconcile all past allowances under this standard, he maintained that all future applications will be evaluated according to it.”

In re Owens, 106 USPQ2d 1248, 1252 (Fed. Cir. 2013)

Thank you! Questions?

**Richard Stockton
Principal Shareholder
Banner & Witcoff, Ltd.
Ten S. Wacker Dr. Ste. 3000
Chicago, IL 60606**

**+1-3124635414
+1-3123990401 (mobile)**

rstockton@bannerwitcoff.com