

June 13, 2016

Via email: DesignWrittenDescription2016@uspto.gov

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property &
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
Mail Stop Comments—Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Attention: Nicole D. Haines

**Re: Comments on the Application of the Written Description
Requirement to Specific Situations in Design Applications**

Dear Director Lee:

I am submitting the following comments on the United States Patent and Trademark Office's Request for Comments on the Application of the Written Description Requirement to Specific Situations in Design Applications (81 Fed. Reg. 22233) ("Request").

I have been registered to practice before the USPTO (Reg. No. 26,028) for well over 40 years. I have been specializing in design law, with a focus on design patents, for over 25 years. My background and resume can be found at:

<http://www.designlawgroup.com/wp-content/uploads/2015/02/PJS-cv-032315-1.pdf>.



The Honorable Michelle K. Lee
June 13, 2016
Page Two

I co-authored an article entitled “*Describing A Design – When Enough is Enough!, Clarifying the 35 U.S.C. sec. 112 Written Description Requirements for Design Patents*”, (“Article”) that was published on March 17, 2015: <http://www.iptos.org/news/400/80/d,Blog.htm>. The Article was written in reaction to the Roundtable held in March, 2014, that was cited in your Request.

The Article discusses the written description requirement for utility and design patents. In Tables A and B is presented the same example of a wheel for a car that was used by the USPTO during the Roundtable.

In my opinion, as stated in the Article, all of the design patent claims in Table B are clearly supported by the design drawing and specification in Table A in a manner that fully satisfies 35 U.S.C. sec. 112(a).

The foregoing represents my professional opinion only, and not that of any client of the law firm.

Sincerely,

Perry J. Saidman

EDISON

Law + Technology

Describing A Design – When Enough is Enough!

Clarifying the 35 U.S.C. § 112 Written Description Requirement for Design Patents

Perry J. Saidman
Kerry W. Leonard¹

I. Introduction and Summary

In order to “promote the Progress of Science and useful Arts,”² the U.S. Constitution granted Congress the power to create and legislate a federal patent system. The resulting U.S. patent laws were clearly designed with the purpose of incentivizing inventors to share their creations with the public. Specifically, an inventor is granted a limited monopoly on his or her invention provided that he or she publicly discloses his or her new discovery by filing for and obtaining a patent.

This *quid pro quo* exchange is the primary purpose behind U.S. patent law. The ability to temporarily exclude others from making or practicing an invention is one of the best motivators to encourage an inventor to divulge the secrets of his or her invention. Patents help to shield their owners from competition by giving them a time-limited, legal right to exclude others from making, using, importing or selling the patented invention and, as

issued patent claims are presumed to be valid, patents confer a significant advantage whenever infringement proceedings are initiated.

But nothing good is ever free and patents come at a high price. In order for a patent to be issued, the inventor must fully describe his or her invention to the public so that upon the expiration of the patent, the public will have sufficient information to enable them to practice the invention. The *quid pro quo* arrangement is not taken lightly and a patent can be invalidated if it is later determined that the description of the invention submitted in the patent application was insufficient. This is known as the “written description requirement” and it is detailed in the first paragraph of 35 U.S.C. § 112, which states:

“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

¹ Perry J. Saidman is the Principal of SAIDMAN DESIGNLAW GROUP, LLC, a law firm located in Silver Spring, Maryland. Kerry W. Leonard is an associate at the firm. SAIDMAN DESIGNLAW GROUP, LLC specializes in legal issues involving designs and product configurations. The opinions expressed herein are those of the authors only and do not necessarily represent those of the firm or of any client of the firm. This work is licensed under the Creative Commons Attribution-NonCommercial-NoDerivatives 4.0 International License. To view a copy of this license, visit <http://creativecommons.org/licenses/by-nc-nd/4.0/>.

² U.S. CONST. art I, §8, cl. 8.

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.”³

Very few cases from the U.S. Court of Appeals for the Federal Circuit have specifically interpreted this law as it pertains to design patents; the majority of decisions focus on utility patents. However, according to 35 U.S.C. § 171, nearly all of the rules that govern utility patents are applicable to designs. The few exceptions are noted in Chapter 1500 of the Manual of Patent Examination Procedure (MPEP).⁴ In particular, it is clear that § 112 applies to both utility and design patents. It has been left to design patent practitioners to determine just how the written description requirement translates when applied in the design patent realm.

This paper will discuss the written description requirement of § 112 as it applies to both utility patents and design patents in order to draw parallels between the two types of applications and to demonstrate how the written description requirement for utility patents informs and parallels the same requirement for design patents.

II. Written Description Requirement as Applied to Utility Patents

One of the most important considerations when drafting a utility patent application is to determine exactly what information must be presented so that an invention is fully disclosed in the manner required by § 112. It is also critical to consider the manner by which this information is presented. In utility patent applications, one approach is to draft a lengthy written specification presenting as many details as possible so as to capture each and every possible embodiment and feature of the invention. This “everything-but-the-kitchen-sink” approach is neither

necessary nor efficient for inventors and the USPTO. It is also not required by the courts in order to constitute a proper disclosure under the written description requirement.

In *Vas-Cath, Inc. v. Mahurkar*, the Federal Circuit held that “under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by § 112.”⁵ The court further stated that, “Whether the drawings are those of a design application or a utility application is not determinative...”⁶ Therefore, a lengthy written description of a particular feature is not always necessary. A feature shown only in a drawing would be sufficient to prove that it had been disclosed by the applicant in compliance with the written description requirement of § 112. Furthermore, disclosure in either a design or utility patent application is sufficient since both types of patents are held to the same standard and both disclosures satisfy the requirement.

The Federal Circuit stressed that:

“the purpose of the ‘written description’ requirement is broader than to merely explain how to ‘make and use’; the applicant must also convey with reasonable clarity 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*.”⁷

The most important consideration for the written description, therefore, is to ensure that it discloses in some way the features of the invention that are now being claimed. Claims of different scope must individually satisfy § 112. What matters is that the features are disclosed. The manner by which they are disclosed (e.g., written specification or figures) is not that important.

One issue that plagues utility patent applicants is the question of how many embodiments need to be disclosed

³ 35 U.S.C. § 112, ¶ 1 (2012).

⁴ See Manual of Patent Examining Procedure, 9th ed., (Mar. 2014) [hereinafter “MPEP”].

⁵ *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d, 1555, 1565 (Fed. Cir. 1991).

⁶ *Id.*

⁷ *Id.* at 1563-1564.

in order to provide a wholly comprehensive written description. According to the Federal Circuit, this number does not need to be extensive. The Federal Circuit ruled in *Regents of the Univ. of Cal. v. Eli Lilly & Co.* that “every species in a genus need not be described in order that a genus meet the written description requirement.”⁸ Citing the *Utter v. Hiraga*⁹ case, the Federal Circuit stated that “a specification may, within the meaning of § 112 ¶ 1, contain a written description of a broadly claimed invention without describing all species that claim encompasses.”¹⁰ The Federal Circuit further stated that a “description of a genus...may be achieved by means of a recitation of... structural features common to the members of the genus, which features constitute a substantial portion of the genus.”¹¹

With respect to the manner of disclosure, the Federal Circuit affirmed the ruling in *Vas-Cath* in *Lockwood v. Am. Airlines, Inc.*¹² In that case, the Federal Circuit noted that an applicant complies with the written description requirement by describing the invention, with all its claimed limitations, and by using “such descriptive means such as words, structures, figures, diagrams, formulas, etc. that set forth the claimed invention.”¹³

Therefore, the most important consideration for satisfying the written description requirement is that the structural features are clearly described. Any means, including figures, can be used to disclose those features.

In *Ariad Pharms., Inc. v. Eli Lilly and Co.*, the Federal Circuit established the current standard in determining whether or not the written description requirement of § 112 has been met.¹⁴ The court stated that “the test for sufficiency is whether the disclosure of the application

relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.”¹⁵ As in *Vas-Cath*, the standard requires that the inventor show that he or she had *possession* of the claimed subject matter.

While this is the applicable standard, the term “possession” is not particularly defined. The Federal Circuit stated that “possession as shown in the disclosure” is what is actually intended and that the issue as to whether or not a disclosure is sufficient is a question of fact that must be answered considering the situation as a whole. The court found that whether or not a patent complies with the written description requirement will necessarily vary depending on the context. Specifically, the level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.¹⁶ From this, it is clear that possession is an issue of fact, not of law, and that it will need to be evaluated based upon the merits of each individual case.

While the *Regents* case focused on the question of whether or not there was sufficient disclosure in the written specification in order to introduce claim limitations, the question in *ICU Med., Inc. v. Alaris Med. Systems, Inc.* hinged upon whether or not there was sufficient disclosure in order to remove a claim limitation.¹⁷ In *Alaris*, the patents at issue involved medical syringe with a valve that modified the fluid pathway from the syringe and into a patient’s intravenous (IV) line. The question was whether or not the valves claimed in some of the disputed patents had adequate support in the written specifications to not require a spike.

⁸ *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1568 (Fed. Cir. 1997).

⁹ *Utter v. Hiraga*, 845 F.2d 993 (Fed. Cir. 1988).

¹⁰ 119 F.3d at 1568 (citing *Utter*, 845 F.2d at 998).

¹¹ *Id.* at 1569.

¹² *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565 (Fed. Cir. 1997).

¹³ *Id.* at 1572.

¹⁴ *Ariad Pharms., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010).

¹⁵ *Id.*

¹⁶ *Capon v. Eshhar*, 418 F.3d 1349, 1357-1358 (Fed. Cir. 2005).

¹⁷ *ICU Med., Inc. v. Alaris Med. Systems, Inc.*, 558 F.3d 1368, 1377-1378 (Fed. Cir. 2009).

The claims were presented so that while they did not expressly exclude the spike, they did not require one.¹⁸ The Federal Circuit examined the specification and noted that all of the embodiments disclosed in the written specification taught valves having spikes; none of the embodiments taught a valve that lacked a spike.¹⁹ Because of this, the court held that the written description requirement was not met for a spikeless embodiment and rejected “ICU’s contention that the figures and descriptions that include spikes somehow demonstrate that the inventor possessed a medical valve that operated without a spike.”²⁰ Because the specification did not provide any details for the generic valve that was claimed, the “person of skill in the art would not understand the inventor...to have invented a spikeless medical valve.”²¹

Satisfying the written description requirement of 35 U.S.C. § 112 for utility cases does vary somewhat between patent applications. Several factors must be considered when determining whether or not the written description is considered to be enabling. For example, the predictability of the technology at issue in the application is a serious issue to consider. “Predictable” technologies—such as mechanical or electrical arts—do not require the same level of detailed disclosure as the “unpredictable” technologies—such as biotech or chemical arts—in order to provide a fully-enabling written description. Also, newer technologies that are still in the early stages of development will require a more extensive disclosure in order to fully enable the claimed invention. Thus, while the law is the same for both the “predictable” and “unpredictable” arts, it will usually be more difficult to satisfy the written description requirement in the “unpredictable” arts.

III. Written Description Requirement as Applied to Design Patents

While utility patents have a written description that usually takes the form of a detailed specification in words, the written description of design patents normally consists of drawings and a relatively short accompanying description of the drawings. These drawings are scrutinized for their content and the manner in which their content is presented plays a critical part in determining exactly what subject matter has been disclosed by a design patent applicant.

In *In re Daniels*, the Federal Circuit held that the same standards apply for utility and design patents.²² The court stated that “[t]he test for sufficiency of the written description is the same, whether for a design or a utility patent” and that “the drawings of the design patent are viewed in terms of the ‘written description’ requirement of § 112.”²³

The decision in *Daniels* hinged upon whether or not the applicant was entitled to the priority date of a parent application in accordance with 35 U.S.C. § 120.²⁴ According to this statute, the claims in a U.S. patent application are entitled to the benefit of the filing date of an earlier filed U.S. patent application if the claimed subject matter is disclosed in the earlier filed application in accordance with 35 U.S.C. § 112.²⁵

In *Daniels*, the question at issue was whether or not the patentee could claim priority to an original design patent application for a leecher container that originally was disclosed as having perforations and a surface.²⁶ In a continuation application, Daniels removed the surface

¹⁸ *Id.*

¹⁹ *Id.* at 1378

²⁰ *Id.*

²¹ *Id.*

²² *In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998).

²³ *Id.*

²⁴ 35 U.S.C. § 120 (2012) (establishing conditions under which a patent application may gain the benefit of an earlier filing date).

²⁵ *Id.*

²⁶ 144 F.3d at 1454-1455.

decoration to reveal additional perforations.²⁷ The two images at issue are presented below.

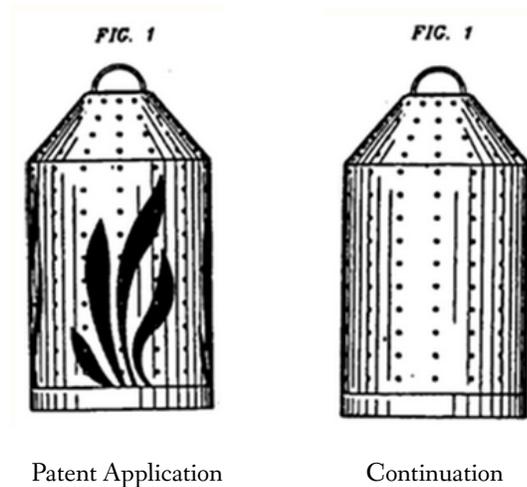


FIG. 1

Here, the drawings in the parent application feature a leecher where the underlying perforations were not clearly disclosed because of the nature of the drawings. The perforations, if any, were obscured by the surface decoration. However, the Federal Circuit determined that the parent application did disclose the underlying perforations even though they were clearly not shown.²⁸ This issue of hidden perforations was not discussed by the Court.

When establishing what is necessary to fulfill the written description requirement so that an applicant can

claim priority in the future, the Federal Circuit in *Daniels* stated that “one looks to the drawings of the earlier application for disclosure of the subject matter claimed in the later application,”²⁹ that “the subject matter of the later application is common to that of the earlier application,”³⁰ and that “the earlier application contains a description of what is claimed in the later application.”³¹

After evaluating the applications and the drawings, the Federal Circuit found that one of ordinary skill in the art would have identified the pattern of perforations claimed in the continuation based upon the disclosure in the parent application, despite the fact that, again, the entire pattern claimed in the continuation was clearly not present in the parent application.

The most recent Federal Circuit case on this issue, *In re Owens*,³² affirmed that the test for sufficiency of the written description, “which is the same for either a design or a utility patent,”³³ has been expressed as “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.”³⁴

The question in *Owens* was whether a newly added disclaimed horizontal broken line in the continuation lacked sufficient support in the parent application.³⁵ The Federal Circuit deemed it to be new matter, claiming that “[i]t does not follow from *Daniels* that an applicant, having been granted a claim to a particular design element, may proceed to subdivide that element in subsequent continuations however he pleases.”³⁶

²⁷ *Id.*

²⁸ *Id.* at 1457.

²⁹ *Id.* at 1456.

³⁰ *Id.* at 1457.

³¹ *Id.*

³² *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013).

³³ *Id.* at 1366.

³⁴ *Id.* (quoting *Ariad*, 598 F.3d at 1351)

³⁵ *Id.* at 1366-1367.

³⁶ *Id.* at 1368.

Regarding the issue as to amendments involving broken lines, the Federal Circuit held that “when an unclaimed boundary line is introduced via amendment or continuation, it is ‘understood that the claimed design extends to the [unclaimed] boundary but does not include the [unclaimed] boundary.’”³⁷

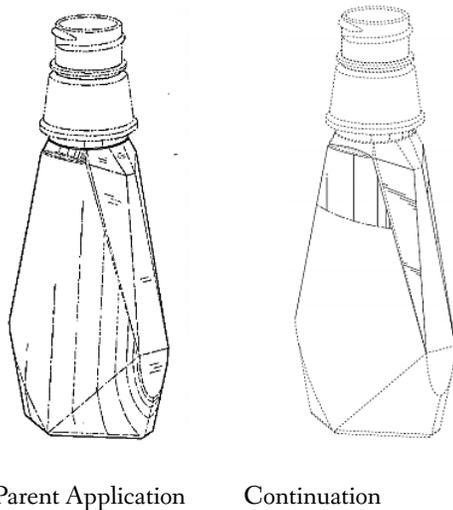


FIG. 2

The concept of disclaiming features of an ornamental design by introducing broken lines is well understood and is common practice in the design patent field. *Owens* further addressed just how critical the written description requirement is with respect to any amendments or continuations, requiring that for “all amendments made during prosecution... [the] lines must comply [with] with the written description requirement.”³⁸ Ultimately, *Owens* required 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.”³⁹

Given the rulings in *Daniels* and *Owens*, the standard for the written description requirement as it applies to

design patents is a bit clearer. What matters is that the illustrations in the application clearly show all of the features of the design in some context so as to prove that the inventor had possession of each feature at the time that the design was originally disclosed.

Even if a design application does not specifically claim a feature (e.g., shows the feature in solid lines), it has still disclosed the feature if it appears in the illustrations as disclaimed (e.g., shows the feature in broken lines). These disclosures must also be viewed from the perspective of one having ordinary skill in the art (i.e., the skilled designer) so that even if a particular feature is not clearly identified (e.g. the perforations of *Daniels*), a designer of ordinary skill in the art would find that the feature was impliedly disclosed.

IV. Comparative Analysis of Utility and Design Patents Under § 112

According to 35 U.S.C. § 171, the same rules are applicable to both utility and design patent applications. Therefore, with respect to the written description requirement, design and utility patents should be held to the same standard—i.e., did the disclosure in the application reasonably convey to those skilled in the art that the inventor had possession of the claimed subject matter? Subjecting design patent applications to a different standard is not only inappropriate, but it is entirely unnecessary as the Federal Circuit has already provided ample analysis of what needs to be disclosed in order to fully satisfy the written description requirement.

First and foremost, it is important that the written description requirement be evaluated on a case-by-case basis⁴⁰ as each individual case needs to be examined with respect to the level of detail necessary to provide a fully enabling written disclosure. Each case must be evaluated

³⁷ *Id.* at 1367 (quoting MPEP § 1503.02).

³⁸ *Id.*

³⁹ *Id.* at 1369.

⁴⁰ See *Ariad*, 598 F.3d at 1351 (stating that the “level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology”) (citing *Capon*, 418 F.3d at 1357-58).

based upon what is disclosed within the “four corners of the specification.”⁴¹

Therefore, the figures of a design patent application, taking into consideration any specific details provided in the written specification (e.g., the broken lines show an unclaimed boundary, the gray shading represents a metallic surface, etc.), will be examined to determine if the disclosure is sufficient. Likewise, the figures and the written specification of a utility patent application will be subjected to the same examination.

The next step is to determine if the disclosure itself, whether it be a written specification or a drawing, clearly shows that the inventor was “in possession” of the claimed material on the priority date.⁴² It is critical that this be considered from the viewpoint of one having ordinary skill in the art because the level of detail of the disclosure will vary depending upon the scope of the claims and the nature of the technology.⁴³

Because the disclosure will inevitably vary in detail, the manner of this disclosure will also vary based upon the technology at issue. As a result, different methods of disclosure (e.g., a written specification, figures, diagrams, formulas, etc.) can and should be used to fully disclose an invention so that it is understood by one having ordinary skill in the art.⁴⁴

However, it is not necessary that each and every single possible embodiment be disclosed and/or claimed. All that is necessary is that the disclosure recites the broadly claimed invention and the common structural features of the different embodiments of that invention.⁴⁵ The disclosure of the common structural features must be

sufficient to show to one having ordinary skill in the art that the inventor had described enough information so as to encompass the claimed subject matter.

Finally, consideration must be given to whether there is anything that is not clearly disclosed but that would be predictable to one having ordinary skill in the art. If the subject is a predictable one (e.g., the obscured perforations at issue in *Daniels*), one having ordinary skill in the art might determine that the subject at issue was fully disclosed.

Based on the Federal Circuit’s guidance on the matter, the written description requirement should be easily understood and easily applied to both utility and design patent cases. However, representatives from the USPTO have indicated that they believe that additional standards need to be imposed for design patent applications. On Design Day 2013, USPTO representatives asserted that there were rare situations where it is questionable as to whether or not an applicant, when filing a design claim of different scope in an amendment or continuation application, satisfied the written description requirement of 35 U.S.C. § 112.⁴⁶ However, examiners were reportedly encountering these rare situations so frequently that the USPTO believed that it warranted further guidance as to the standards that should be applied when determining if the design claim satisfies the written description requirement.

In the Federal Register notice of February 6, 2014, the USPTO proposed a five-factor standard for determining if an amended or continuation design claim satisfied the written description requirement.⁴⁷ They solicited opinions

⁴¹ *Id.*

⁴² *Vas-Cath*, 935 F.2d at 1563-1564 (see also *Ariad*, 598 F.3d at 1351).

⁴³ *Capon*, 418 F.3d at 1357-1358.

⁴⁴ *Lockwood*, 107 F.3d at 1572 (see also *Daniels*, 144 F.3d at 1456).

⁴⁵ *Regents*, 119 F.3d at 1568 (citing *Utter*, 845 F.2d at 998).

⁴⁶ Joel Sincavage, Design Practice Specialist, United States Patent and Trademark Office, presentation at the United States Patent and Trademark Office Design Day 2013: Designs in the New Digital Age – More About the Written Description Requirement of 35 USC 112(a) (Apr. 23, 2013) (see <http://www.aipla.org/learningcenter/library/papers/roadshows/ptodesignday/Pages/default.aspx>).

⁴⁷ Request for Comments and Notice of Roundtable Event on the Written Description Requirement for Design Applications, 79 Fed. Reg. 25,717-73 (Feb. 6, 2014).

regarding the proposed five-factor approach and hosted a roundtable event at the USPTO on March 5, 2014 where design patent practitioners could discuss the proposed changes in an open forum with USPTO personnel. Prior to the March 2014 roundtable event, the USPTO released a set of sample amendments that were to serve as fodder for discussion regarding which of the amendments should be considered acceptable under § 112 and which would be

considered to not fulfill the written description requirement.

A hypothetical example based upon these sample amendments is presented in the table below and shows a comparison between a utility patent application claim and a design patent application claim based upon different features of the original disclosure.

Table A

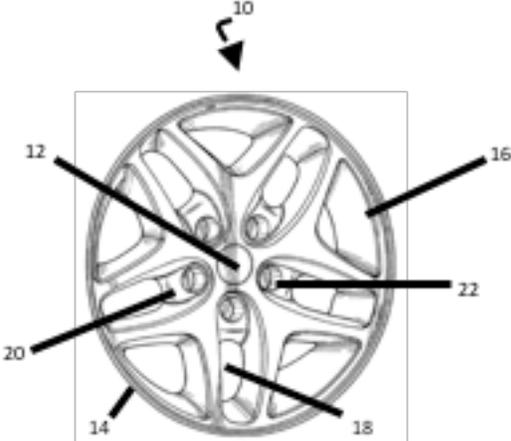
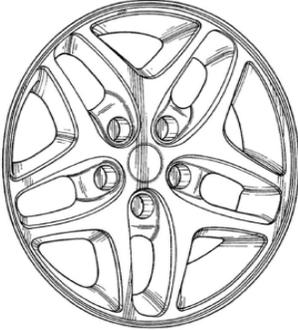
| Utility | Design |
|---|--|
|  |  |
| Specification | Specification |
| <p>As illustrated in the sole drawing figure, my invention is a wheel that includes a front face 10, a center portion 12, and an outer rim 14. Five triangular apertures 16 are positioned evenly about the periphery thereof. There are also five elongated apertures 18, one of each of which is positioned between adjacent triangular apertures 16. In addition, there are five curved portions 20, one located within each of the elongated apertures at one end thereof, and five bolt holes 22 that are each positioned on a respective one of the curved portions 20. My invention may include all of the elements as illustrated in the sole drawing figure, e.g. triangular apertures 16, elongated apertures 18, curved portions 20, and bolt holes 22, as well as any individual element or a plurality of the elements in any combination.</p> | <p>My design may include all of the elements as illustrated in the sole drawing figure, e.g., triangular apertures, elongated apertures, curved portions, and bolt holes, as well as any individual element or a plurality of the elements in any combination.</p> |

Table B

| Utility | Design |
|--|--|
| <p>1. A wheel, comprising:</p> <ul style="list-style-type: none"> a. a front face having a center portion and an outer rim; b. a plurality of triangular apertures positioned adjacent to said outer rim; c. a plurality of elongated apertures, each located between adjacent ones of said plurality of triangular apertures; d. a plurality of curved portions, one located within each of the elongated apertures at one end thereof; and e. a plurality of bolt holes, each positioned on a respective one of said curved portions. |  |
| <p>2. A wheel, comprising:</p> <ul style="list-style-type: none"> a. a triangular aperture located on the periphery of said wheel; b. an elongated aperture located adjacent to said triangular aperture; c. a curved portion positioned within said elongated aperture at one end thereof; and d. a bolt hole positioned on said curved portion. |  |
| <p>3. A wheel, comprising:</p> <ul style="list-style-type: none"> a. a pair of triangular apertures positioned adjacent to each other on the periphery of said wheel; b. an elongated aperture located opposite to said pair of triangular apertures; and c. a curved portion positioned within said elongated aperture at one end thereof. |  |

| | |
|---|--|
| <p>4. A wheel, comprising:</p> <ol style="list-style-type: none"> a. a triangular aperture on the periphery of said wheel; b. an elongated aperture spaced from said triangular aperture; and c. a bolt hole spaced from said triangular aperture and said elongated aperture. |  |
|---|--|

The original disclosure featured a wheel that possessed several triangular apertures, bolt holes, curved portions, etc. Subsequent figures in the design example introduced selected features in broken lines, i.e., removing the features shown in broken lines from the claimed design. Broadening claims is common practice when prosecuting utility patent applications. It is considered good prosecution practice to try to obtain a claim that is as broad as possible while still being supported by the specification. The same should be true for design patent applicants.

The example above seeks to compare the same amendments in utility and design patent claims, based upon the original specifications and the original figures shown in Table A. In Table B, utility patent claims and design patent claims are shown side-by-side to illustrate how the identical features can be claimed in both types of applications. It compares several claims of differing scope, ranging between broad and narrow.

It is contended by the authors that all of the claims in both the utility and design patent examples are clearly supported by the written specifications and drawings presented in Table A. The claims speak for themselves.

The authors believe that there is no question that each of the utility and design patent claims presented above is fully supported by the respective written description in the specifications. Each claimed element is clearly described in the respective specifications as being part of the claimed invention/design in any combination. In other words, the inventor/designer regarded his

invention/design as including all elements either collectively or in any combination.

The wording of the utility patent claim defines the subject matter in which the inventor has exclusive rights. This does not necessarily mean that the claim must be drawn to cover all of the subject matter that is disclosed in the written description of a specification. Despite the very specific and detailed structural description of the invention and its components, it is not necessary that the inventor claim this specific arrangement and only this specific arrangement. In a utility application, the inventor may obtain a patent having the broadest claim allowable by the prior art. If an applicant later finds that his claims are too narrow, he has the opportunity to broaden them during prosecution, in continuing applications, and, in the case of reissue applications, even after prosecution. This is, in fact, good procedural practice and is encouraged.

Similarly, it is not necessary that a designer claim a specific arrangement shown in the drawings and only that specific arrangement. Just as in a utility application, the designer may obtain a patent having the broadest claim allowable by the prior art. If an applicant later finds that his claim is too narrow, he has the opportunity to broaden it during prosecution, in continuing applications, and, in the case of reissue applications, even after prosecution. Just as with utility patents, that is good procedural and strategic practice and is clearly allowed by the rules.

As noted above, the claim in a design patent is defined by the drawings that illustrate the ornamental design. A design patent claim covers the features of the design that are shown in solid lines and colorable variations thereof.⁴⁸

⁴⁸ 35 U.S.C. § 289 (2012).

Features not being claimed are defined by broken lines. However, this does not mean that such unclaimed features are not “described” in the application; the broken line features are shown, but they are just not part of the claimed subject matter.

Given that a design patent application is held to the same standard as a utility patent application, there is no reason why an inventor/designer should not be able to claim any of the designs shown in Table B if he originally disclosed his design with the specification shown in Table A. Likewise, there is sufficient support in the drawings of Table B to show that the designer had sufficiently described all of the features shown in Table A even though many of those features are disclaimed in subsequent claims or drawings.

V. Conclusion

The foregoing examples clearly satisfy written description case law handed down by the Federal Circuit.

Regarding the specifications and claims in Tables A and B, *Vas-Cath*⁴⁹ is certainly satisfied in that the invention/design in all of the claimed embodiments is set forth in the original specifications, including the words and figures thereof. The *Regents*⁵⁰ holding is not at issue since all species are clearly set forth in Table A, and the disclosures are in compliance with *Ariad*⁵¹ in that the disclosures of the applications reasonably convey to those skilled in the art that the inventor/designer pretty clearly had “possession” of all claimed subject matter. Moreover, there is no issue in Tables A and B about removing claimed elements as in *Alaris*⁵² since the written specifications and drawings pretty clearly do not require the entire combination of disclosed elements for the respective claimed invention/design.

Regarding design patent case law, *Daniels*⁵³ is satisfied in that the original specification contains a clear description of what the designer regards as his design.

And no issue is raised under *Owens*⁵⁴ since no new boundary lines are introduced at any time, and the solid lines of all claimed embodiments are visually apparent in the original specification and drawing.

In any new guidelines proposed by the USPTO, the first principle should be simplicity. One must simply determine what has been described or shown in the specification. And as the standard for utility patent applications and design patent applications is the same, all that is necessary is to look within the “four corners of the specification” to determine what subject matter has been disclosed.

Because the written description for a design patent consists primarily of its drawings, all that is needed is for a designer of ordinary skill in the art to consider all of the features shown in the drawings and any accompanying description of the drawings. And for each particular design and feature thereof, the designer needs to simply see what they look like. In the realm of design patents, design features illustrated in the drawings are always predictable, and it is far easier to determine whether or not an amendment or continuation has sufficient support than a more unpredictable chemical or biotech utility patent application. And in those rare situations where there is a question as to whether an amendment in a design patent application satisfies the written description requirement, it would be far more prudent to leave the question to the established case law.

For nearly a century the JOURNAL OF THE PATENT & TRADEMARK OFFICE SOCIETY has been at the forefront of developments in American intellectual property law. Subscribe today and receive \$5 off our yearly subscription rate using coupon code EDISON02.

⁴⁹ See 935 F.2d at 1555.

⁵⁰ See 119 F.3d at 1559.

⁵¹ See 598 F.3d at 1336.

⁵² See 558 F.3d at 1368.

⁵³ See 144 F.3d at 1452.

⁵⁴ See 710 F.3d at 1362.