

Design Day 2013

Designs in the New Digital Age



More About the Written Description Requirement of 35 USC 112(a)

United States Patent and Trademark Office





Designs in the New Digital Age

“...[I]t is possible for a specification to enable the practice of an invention as broadly as it is claimed, and still not describe that invention.”

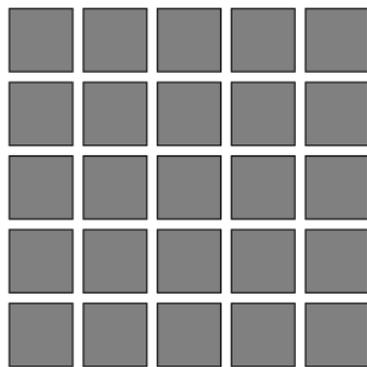
In re DiLeone, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (C.C.P.A. 1971)



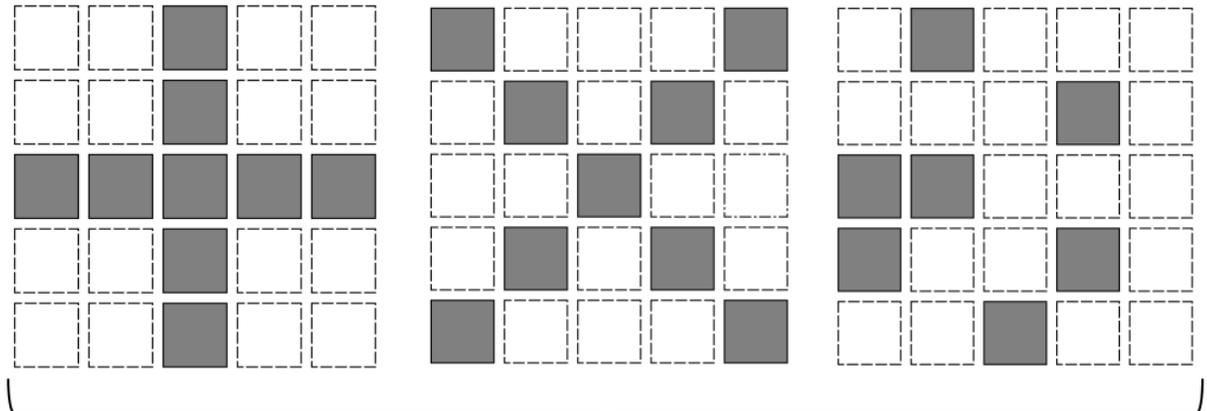


Designs in the New Digital Age

Disclosed but not described



Original
Drawing



Amendments that are enabled in the original
drawing but not described.

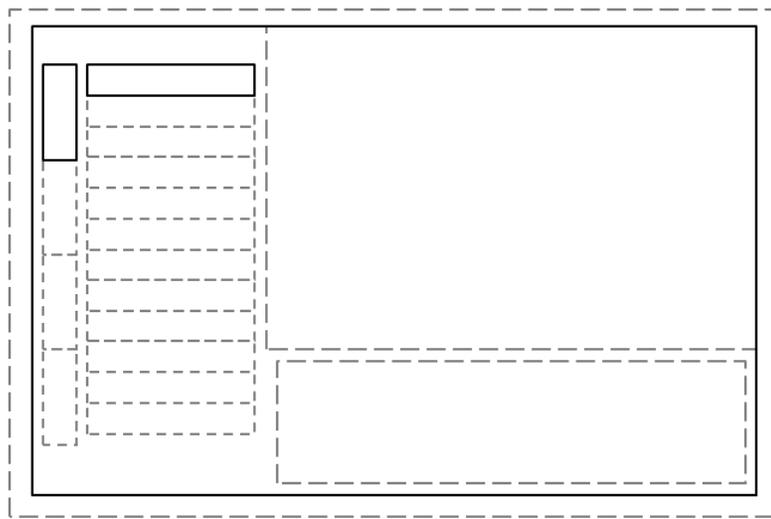




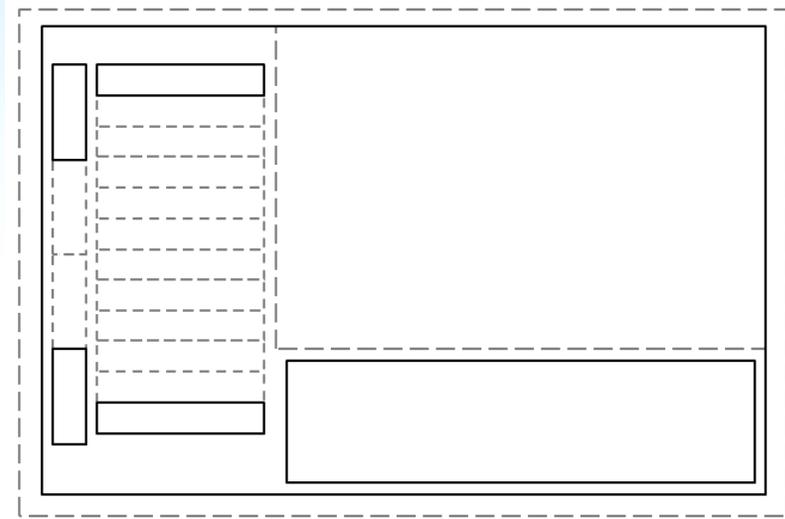
Designs in the New Digital Age

Disclosed but not described

Display Screen with a Graphic User Interface



Original



Amended

The question is whether the specification discloses the design, specifically, as something applicant actually invented.

See *In re Ruschig*, 379 F.2d 990, 995, 154 USPQ 118, 123 (C.C.P.A. 1967)





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“Adequate description of the invention guards against the inventor's overreaching by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.”

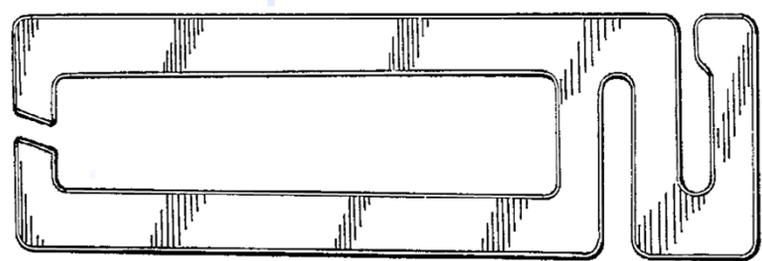
Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1561, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991) (citing *Rengo Co. v. Molins Mach. Co.*, 657 F.2d 535, 551, 211 USPQ 303, 321 (3d Cir. 1981), *cert. denied*, 454 U.S. 1055 (1981))



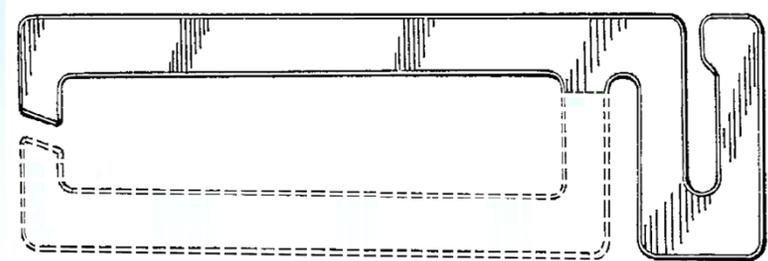


Designs in the New Digital Age

Strap fastener for travel goods



Original



Amended

The amended design looks different from the original. Nothing in the original would lead one to recognize the amended design was also invented along with the original creation.





Designs in the New Digital Age

- “[I]t should be readily apparent from recent decisions of this court involving the question of compliance with the description requirement of §112 that each case **must be decided on its own facts.**”

In re Driscoll, 562 F.2d 1245, 1250, 195 USPQ 434, 438 (C.C.P.A. 1977).

- “By the very nature of this inquiry, **each case turns on its own specific facts.**” *In re Edwards*, 568 F.2d 1349, 1352, 196 USPQ 465, 467 (C.C.P.A. 1978).

- “Precisely how close the description must come to comply with §112 **must be left to case-by-case development.**”

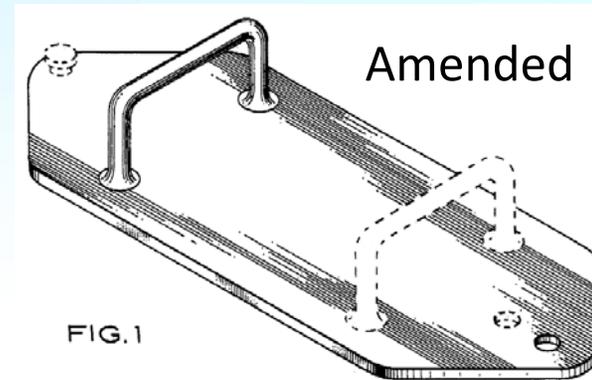
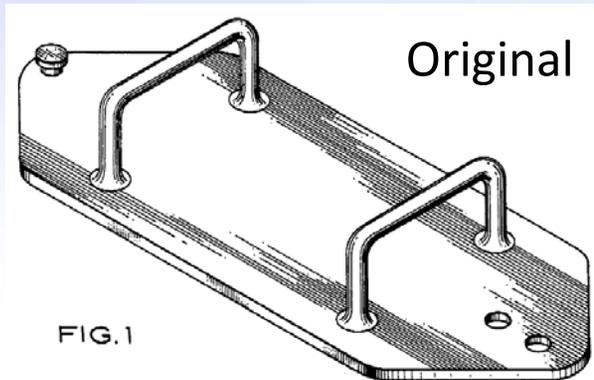
In re Smith, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (C.C.P.A. 1972).





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Baby bottle strap



The design left over, after the amendment, was not recognizable prior to the amendment.

Does the description clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed?

See *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).





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Thank you

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