

Comments on the Written Description Requirement for Design Patent Applications

The type of amended/continuation design claim identified in the Federal Register notice of February 6, 2014, that only includes a subset of the originally claimed design has typically been referred to in design patent practice as a broadening of the original design claim. Case law holds that “applicant is entitled to claims as broad as prior art and his disclosure allow.” *In re Rasmussen*, 211 USPQ 323. This holding applies to design patent applications as well as utility patent applications. A broadening of a design patent claim typically involves the submission of an amendment after the application is filed, or the filing of a continuation application, in which certain parts of the originally claimed design are reduced to broken lines so that only those portions that remain in solid lines are now claimed as the new design. In order for the amended/continuation design claim directed to those portions that remain in solid lines to be considered to satisfy the written description requirement of 35 U.S.C. 112(a), i.e. no new matter added, case law holds that a designer of ordinary skill in the art must be able to recognize the newly claimed design in the original disclosure, *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013). Therefore, the only factor necessary to determine whether an amended/continuation design claim directed to a subset of the originally claimed design satisfies the written description requirement of § 112(a), is if it is clearly recognized in the original disclosure without the introduction of new matter. That is, applicant was in possession of the later claimed design at the time of filing the original claimed design. This is true whether the subset has a common theme, (factor 1), or shares an operational and/or visual connection, (factor 2), or is self contained within the original design, (factor 3), or has a fundamental relationship of elements by the context in which they appear, (factor 4), or gives the same overall impression as the original design claim, (factor 5).

So how does one determine whether a designer of ordinary skill can recognize an amended/continuation design claim directed to a subset of the originally claimed design in the original disclosure? Typically, in order to be recognized, the subset comprising the newly claimed design would have to be defined by some form of boundaries within the originally claimed design in the original disclosure. The three sets of examples included in the “Roundtable” notice on the PTO Web site can assist in illustrating whether the subset is defined by boundaries or not. However, the best example to illustrate this point is the disclosure in the continuation application resulting in the *Owens* decision.

As filed, the *Owens* continuation application reduced to broken lines much of the originally claimed design for a bottle leaving only the small crescent-shaped area on the front and rear of the bottle near the cap and the narrow triangular areas along the shoulder regions of the bottle in solid lines as the newly claimed design. Both the PTO and later the CAFC had no problem with the newly claimed design, as filed, directed to just a subset of the originally claimed design since this subset of elements were clearly defined by boundary lines in the original drawing allowing a designer of ordinary skill to recognize the new design claimed in the original disclosure. Hence, the newly claimed design as filed complied with the written description requirement of 35 U.S.C 112(a). It was not until *Owens* submitted an amendment adding a broken line boundary to define a trapezoidal shaped surface at the upper portion of the front and rear panels of the bottle

that the PTO initiated a rejection under 35 U.S.C. 112(a) for failing to comply with the written description requirement thereof. It was the PTO's position that the broken line boundary and the trapezoidal shaped surface defined thereby introduced new matter into the claim holding that there was nothing in the original drawing disclosure to evidence that Owens was in possession of the trapezoidal shaped surface at the time the first application was filed. The CAFC affirmed the PTO's rejection.

What's clear from the Owens decision is that if an amended/continuation design claim directed to a subset of an originally claimed design is clearly defined by boundaries in the original drawing a designer of ordinary skill will be able to recognize what is now claimed in the original disclosure. However, if an amended/continuation design claim directed to a subset of an originally claimed design is not defined by boundaries in the original drawing a designer of ordinary skill will not be able to recognize what is now claimed in the original disclosure.

Turning to the example included in the "Roundtable" notice on the PTO Web site directed to the 5 proposed factors identified in the Federal Register notice, the amended claim in all 5 examples directed to each of the proposed factors is clearly defined by boundary lines in the original drawing. Specifically, in the first example, the 5 oblong openings forming the amended claim for a vehicle wheel front face are clearly defined by boundary lines in the original drawing such that a designer of ordinary skill in the art would recognize what is now claimed in the original disclosure. Hence the amended design claim complies with the written description requirement of 35 U.S.C. 112(a). Next, in the second example, the three components forming the amended claim for a telescope are all clearly defined by boundary lines in the original drawing such that a designer of ordinary skill in the art would recognize what is now claimed in the original disclosure. Again, the amended design claim complies with the written description requirement of 35 U.S.C. 112(a). In the third example, the 5 separate elements forming the amended claim for a remote control and cradle assembly for a ceiling fan and light fixture are all clearly defined by boundary lines in the original drawing such that a designer of ordinary skill in the art would recognize what is now claimed in the original disclosure. Hence the amended design claim complies with the written description requirement of 35 U.S.C. 112(a). In the fourth example, the two independent components forming the amended claim for an ice skate are both clearly defined by boundary lines in the original drawing such that a designer of ordinary skill in the art would recognize what is now claimed in the original disclosure. Hence the amended design claim complies with the written description requirement of 35 U.S.C. 112(a). In the fifth example, the amended claim for a computer network assembly is clearly defined by boundary lines in the original drawing such that a designer of ordinary skill in the art would recognize what is now claimed in the original disclosure. Hence the amended design claim complies with the written description requirement of 35 U.S.C. 112(a). The five proposed factors identified in these examples is unnecessary since the only factor needed to determine if the written description requirement of § 112(a) is complied with is whether the subset forming the amended design claim was clearly defined by boundaries in the original drawing so that a designer of ordinary skill could recognize what was now claimed in the original disclosure.

Turning now to the “Additional examples” included in the “Roundtable” notice on the PTO Web site, in all six examples of the electronic measurement instrument the amended claim directed to just portions thereof is clearly defined in the original drawing such that a designer of ordinary skill in the art would recognize what is now claimed in the original disclosure. Hence the amended design claim complies with the written description requirement of 35 U.S.C. 112(a). Additionally, in the four examples of a vehicle wheel front face, the amended claim directed to independent elements is clearly defined by boundary lines in the original drawing. Specifically, in example 7, the 5 oblong openings forming the amended claim are clearly defined in the original drawing. In example 8, the single oblong and single triangular openings forming the amended claim are clearly defined in the original drawing. In example 9, the single oblong and 2 triangular openings forming the amended claim are clearly defined in the original drawing. And in example 10, the single oblong, single triangular and bolt hole openings forming the amended claim are clearly defined in the original drawing. Therefore, in each of these examples a designer of ordinary skill in the art would recognize what is now claimed in the original disclosure. Hence the amended design claim complies with the written description requirement of 35 U.S.C. 112(a). Again, the only factor needed to determine if the written description requirement of § 112(a) is complied with is whether the subset forming the amended design claim was clearly defined by boundaries in the original drawing so that a designer of ordinary skill could recognize what was now claimed in the original disclosure.

Finally, looking at the examples in the presentation from Design Day 2013, the first example includes three different amendments all of which are considered to be disclosed in the original drawing. However, because the particular arrangement of the squares as amended cannot be clearly defined in the original drawing a designer of ordinary skill would not recognize what is now claimed in the original disclosure. Hence the amended design claim does not comply with the written description requirement of 35 U.S.C. 112(a). In the second example, the 5 rectangles forming the amended claim for a display screen with a graphic user interface are all clearly defined by boundary lines in the original drawing such that a designer of ordinary skill in the art would recognize what is now claimed in the original disclosure. Hence the amended design claim complies with the written description requirement of 35 U.S.C. 112(a). In the third example, the amended claim includes a broken line boundary added to define the upper and right surface of the strap fastener for travel goods as a separate design from the originally claimed design for the entire strap fastener. This example is similar to the facts in the Owens case since the broken line boundary introduces new matter not supported in the original disclosure. Therefore, the amended claim fails to comply with the written description requirement of 35 U.S.C. 112(a), due to the introduction of new matter in the original drawing. Furthermore, in the absence of the broken boundary line in the original drawing a designer of ordinary skill would not be able to recognize what is now claimed in the original disclosure. Finally, in example 4, the claim for a baby bottle strap as amended is clearly defined in the original drawing such that a designer of ordinary skill in the art would recognize what is now claimed in the original disclosure. Hence the

amended design claim complies with the written description requirement of 35 U.S.C. 112(a).

In view of all the examples described above it is clear that only two factors need to be considered in determining whether an amended/continuation design claim complies with the written description requirement of 35 U.S.C. 112(a):

- 1) Has new matter been added? if not;
- 2) Is the amended claim clearly defined by boundaries in the original drawing so that a designer of ordinary skill can recognize what is now claimed in the original disclosure?

If no new matter is added to an amended claim and if the amended claim is clearly defined in the original drawing then it must be considered to comply with the written description requirement of § 112(a). No other factors other than the two identified above need to be considered in determining whether an amended design claim complies with the written description requirement of § 112(a).

If an applicant wants to reserve the right to claim at a later date a subset(s) of the originally claimed design that is not clearly defined or recognizable in the original drawing, such as a portion of a surface as in the Owens case, then the PTO should allow an applicant to submit an appendix showing and/or describing those subsets of the originally claimed design at the time the original design patent application is filed. Such an appendix should be described in the specification. Only in those situations where a subset of an originally claimed design is not clearly defined or recognizable in the original disclosure should an appendix be necessary. In all other cases where the subset of an originally claimed design is clearly defined and recognizable in the original drawing any later filed amendment/continuation design claim should be considered to satisfy the requirements of § 112(a).

Respectfully submitted,
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