



## IP Insight

By Michael P.F. Phelps

# Broadening Design Patents to Disclaim Subject Matter: How Little Is Too Much?

### Reining in knockoffs is a difficult and necessary

challenge for any company that produces distinctive items to establish and maintain its market share. Imitation products can range from simple carbon copies to more subtle likenesses that capture only some of the most characteristic aspects of the original.

To address the gamut of potential knockoffs, manufacturers often obtain a portfolio of design patents that separately claim the product's overall design and the its individual elements. Such portfolios are commonly developed by filing a series of continuation applications, each claiming less than the original design. Despite the industry's reliance on this kind of continuation practice, the United States Patent and Trademark Office (PTO) recently announced that it is more critically evaluating whether amendments and continuations that claim smaller portions of the originally claimed design would be invalid for lacking "written description" support under 35 U.S.C. § 112(a). Given the dangers presented by the PTO's new approach, practitioners must reevaluate their strategies for developing their clients' comprehensive design patent portfolios and be prepared to face a spate of written description challenges.

The concern arises from the manner in which design patent applications are illustrated to claim or disclaim different parts of a design. Solid lines depict the claimed design, whereas broken lines indicate unclaimed environmental structure or define the boundary of the claimed design.<sup>1</sup> For practical reasons, it is common to file a parent application that narrowly claims most or all of the design by rendering it in solid lines, and later file continuations that more broadly claim only distinct portions of the overall design. For example, the first design patent for an automobile may claim the entire body by depicting it in solid lines and a subsequent application may claim only the hood by depicting it in solid lines, disclaiming the remainder of the car by rendering it with broken lines. The former patent could effectively prevent competing overall automobile designs, while the latter could prevent the sale of unlicensed replacement hoods. The need for this kind of practice arises, in significant part, from two factors: first, each design patent is permitted to claim only a single design; and, second, it is often impossible to know in advance which of the unique features of the design will be

imitated by a competitor to produce a knockoff product.

The PTO's Manual of Patent Examining Procedure (MPEP) appears to condone the practice of filing amendments or continuations to disclaim parts of an original design where it states: "[t]he claim may be amended by broadening or narrowing its scope within the bounds of the disclosure as originally filed."<sup>2</sup> Furthermore, while an applicant is not permitted to change the design's "configuration" by removing three-dimensional surface treatments integral to the design, amendments that change the claim scope by "reducing certain portions of the drawing to broken lines" are not prohibited.<sup>3</sup> The PTO also permits an applicant to remove two-dimensional surface treatment, such as printing, provided it is clear the applicant was in possession of the underlying design configuration.<sup>4</sup> Finally, the M.P.E.P. also suggests that portions of a design that are too poorly drawn to fully define the invention may simply be disclaimed by rendering them as broken lines.<sup>5</sup>

Despite decades of commercial reliance on the PTO's permission to file amendments and continuation applications that subdivided the original design into its component subdesigns, the office has recently cast some doubt on the merits of this custom. On April 23, 2013, the PTO held its annual "Design Day," during which a PTO representative presented "More About the Written Description Requirement of 35 U.S.C. § 112(a)."<sup>6</sup> In this presentation, the PTO directly addressed the practice of rendering solid lines as broken lines and provided several examples of drawing amendments that disclaimed subject matter by changing solid lines to broken lines.<sup>7</sup> In each example, the presenter suggested that the amendment may fail the written description requirement. Particularly troubling was the final example, which illustrated an amendment to disclaim three of the six distinct features of an ornamental design.<sup>8</sup> While this kind of amendment would be commonplace in past and current practice, the Design Day 2013 presentation indicated that the amended design "was not recognizable prior to the amendment."<sup>9</sup>

The PTO's Design Day 2013 presentation suggests a new, and potentially problematic, emphasis on applying the written description requirement of 35 U.S.C. § 112(a) to design applications.<sup>10</sup> Perhaps spurred by the federal circuit's *en banc* reaffirmation

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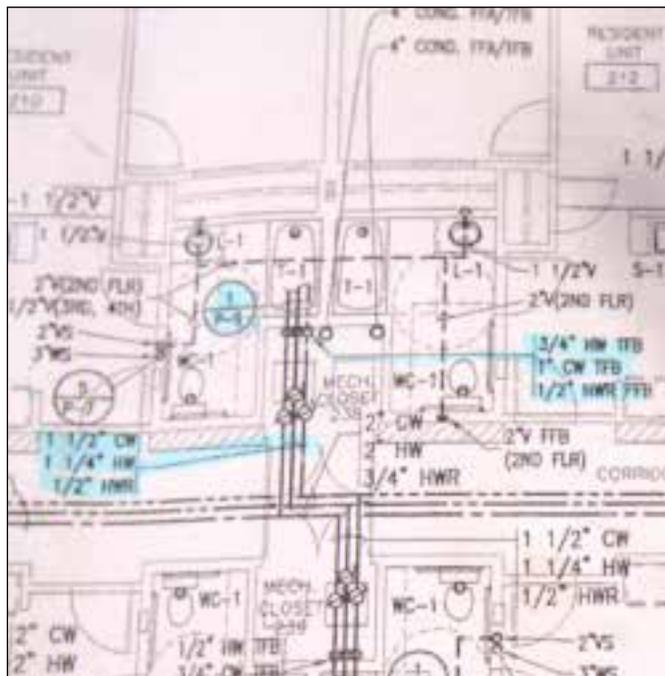
in *Ariad*<sup>11</sup> that 35 U.S.C. § 112, ¶1 includes a separate “written description” requirement, the presentation relies on a host of cases arising from the chemical arts and seems to analogize the broadening of a design application claim to cover a single element of the design to claiming a particular chemical species in an application that discloses only a chemical genus. Notably, the Design Day 2013 presentation does not mention either *In re Salmon* or *In re Daniels*; the two cases currently identified in MPEP § 1504.04 that seemingly condone the practice of disclaiming portions of a design. In fact, none of the cited cases actually address the specific issue of disclaiming part of a disclosed design, and none are found in the current version of MPEP Chapter 1500, which deals with examination of design patents.

The PTO’s reliance on cases in the chemical arts to explain the written description requirement for design patents should come as no surprise following the federal circuit’s recent opinion in *In re Owens*.<sup>12</sup> In *Owens*, the federal circuit considered whether a newly added boundary line lacked written description support under 35 U.S.C. § 112, ¶1. The *Owens* application continued an earlier-filed parent application that depicted a bottle entirely in solid lines.<sup>13</sup> In the continuation, the applicant disclaimed the top and bottom portions of the original bottle design by changing solid lines to broken lines and also added a new boundary line where no line previously existed.<sup>14</sup> Relying primarily on *Ariad*, the panel in *Owens* affirmed the PTO’s determination that the newly added line in the claimed design did not satisfy the written description requirement of 35 U.S.C. § 112, ¶1.<sup>15</sup>

Notably, the PTO did not invalidate the *Owens* application on the grounds that the continuation disclaimed portions of the original design, and the question of whether that disclaimer was proper was not at issue on appeal. However, one could readily argue that the changes to the *Owens* design are more extreme than at least some of the examples in the Design Day 2013 presentation. Indeed, more than half of the original *Owens* design was disclaimed in the continuation application. One must wonder whether the PTO would have raised additional rejections against the *Owens* claim, following the explanation of the written description requirement it provided at Design Day 2013.

The PTO’s recent discourse on the written description requirement represents a possible shift in examination procedures that can have tremendous implications for the traditional design patent continuation practice. Following Design Day 2013, one cannot simply assume that a continuation that disclaims part of an originally filed design will be granted priority under 35 U.S.C. § 120 or that an amendment to do the same will not be rejected as new matter under Section 112(a). However, there still is hope that applicants will be able to maintain the flexibility to modify the scope of their design patent claims to keep copycats at bay while still satisfying a more stringent application of 35 U.S.C. § 112(a) foreshadowed during Design Day 2013.

Proactive drafting is, and always has been, the best defense against written description challenges. In an ideal world, the applicant can predict all the ways in which infringers will modify a product design while still retaining enough similarity to induce the consumer into thinking their knockoff is an original and has the budget to prepare drawings and file applications to cover each variation. But budget constraints, and the ironic creativity of the determined knockoff artist, both collude to prevent this approach in many situ-



ations. Nevertheless, the PTO does permit the applicant to submit drawings of multiple embodiments in an application, and specifically condones the practice of prophetically disclaiming portions of the claimed design to provide antecedent basis for later filings or amendments.<sup>16</sup> Thus, for critical designs, it may be helpful and cost effective to supplement the original filing with a written explanation and an abbreviated or informal set of additional drawings to provide support for variations on the original. Such alternatives may not ultimately provide the design equivalent of *in haec verba* support for a later claim, but they may be close enough to avoid or overcome a rigorous application of the written description requirement.

Where proactive drafting is insufficient, or simply too late, a written description rejection is not necessarily insurmountable. An application satisfies the written description requirement when “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.”<sup>17</sup> When challenged, an applicant should be prepared to argue or demonstrate that the portion of the design sought to be claimed would be considered by a person skilled in the art to stand alone as a separate invention. Of course, when deciding how much or what parts of an original design to disclaim, one should proactively consider the merits of proving that the subdivision would be understood as a separate invention in anticipation of the possible written description challenge.

Finally, before filing an amendment or continuation that expands the scope of a claimed design, one should consider whether the existing claimed design has sufficient scope to adequately protect against knockoff products. If a knockoff does not exactly match the claimed design, there may be a strong temptation to hone the claimed subject matter to firm up an infringement case. But if making the amendment provokes a written description challenge that cannot be overcome during prosecution, the enforcement action may be seriously impaired. In such cases, it may be wise to heed the old admonition, “Perfect is the enemy of good.” The test for infringement provides some latitude to protect against imperfect copies, and the likelihood of winning a litigation without making any change

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at all should be weighed carefully against the risks of provoking a problematic written description issue.

The PTO's recent focus on the written description requirement should not be overlooked. While it remains to be seen whether the PTO and the individual examiners will take a hard line against broadening amendments, the groundwork has been laid for challenges during both prosecution and litigation.<sup>18</sup> With the issue highlighted, the design patent bar should prepare for a new era of heightened written description scrutiny. Whenever an amendment is made to disclaim subject matter, the practitioner should be mindful that claiming too little of the original design may be too much for the written description requirement to allow. ☉

## Endnotes

<sup>1</sup>See, e.g., *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980).

<sup>2</sup>MPEP § 1504.04.

<sup>3</sup>See *id.*, citing *In re Salmon*, 705 F.2d 1579 (Fed. Cir. 1983).

<sup>4</sup>See *id.*, citing *In re Daniels*, 144 F.3d 1452, 1456-57 (Fed. Cir. 1998).

<sup>5</sup>See *id.*, at form paragraph 15.20.02.

<sup>6</sup>See Joel Sincavage, *More About the Written Description Requirement of 35 U.S.C. §112(a)*, AIPLA.ORG, [www.aipla.org/learningcenter/library/papers/roadshows/ptodesignday/Documents/2013/SincavageDesignDay2013%20%5bSincavage%5d.pdf](http://www.aipla.org/learningcenter/library/papers/roadshows/ptodesignday/Documents/2013/SincavageDesignDay2013%20%5bSincavage%5d.pdf) (last visited June 26, 2013).

<sup>7</sup>No public record has been found to support any of the examples, and therefore they appear to be hypothetical.

<sup>8</sup>Sincavage, *supra* note 6. The final example was for a "Baby Bottle Strap" as illustrated in U.S. Patent No. D255,716. The features that were rendered in broken lines were one of the two identical handles, one of two identical holes, and a button.

<sup>9</sup>*Id.*

<sup>10</sup>The America Invents Act relabeled 35 U.S.C. §112, ¶1 as "§112(a)," but did not amend the relevant substance of this law.

<sup>11</sup>*Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 94 U.S.P.Q.2d 1161 (Fed. Cir. 2010).

<sup>12</sup>*In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013).

<sup>13</sup>*Id.* at 1363.

<sup>14</sup>*Id.* at 1364-65.

<sup>15</sup>See *Id.* at 1368.

<sup>16</sup>See, M.P.E.P. § 1503.01(II) (disclaiming portion of a design not permitted in issued design patent, but permitted in application as originally filed to provide antecedent basis for future amendments).

<sup>17</sup>*Ariad*, 598 F.3d at 1351.

<sup>18</sup>At the time of writing, the PTO has acknowledged that the Design Day 2013 presentation has raised concerns in the design patent community. It is the author's understanding that the PTO plans to hold a "town hall" meeting to address the bar's concerns.