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## Subject Matter Support in Design Continuation Applications: *In re Owens* Decision Provides New Guidance

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On March 26, 2013, the U.S. Court of Appeals for the Federal Circuit affirmed the U.S. Patent Office's rejection of the claim of a design patent continuation application, bringing some degree of clarity to the practice of claiming a *portion* of a previously-claimed design while seeking priority to the filing date of the previously-claimed design. *In re Owens*, No. 2012-1261 (Fed. Cir. March 26, 2013).

In the case, Timothy S. Owens et al. ("Owens") filed a design patent application claiming the design of a bottle (the "parent application"), and then filed a continuation design patent application claiming only a portion of the bottle (the "child application"). To indicate a boundary of the claimed portion of the bottle in the child application, Owens added a broken, and thus unclaimed, line that was *not* illustrated in the parent application. The examiner in charge of the child application rejected the claim under the written description requirement of 35 U.S.C. §112, first paragraph, because there was no evidence that Owens originally possessed the claimed portion as bounded in part by the added broken line. The U.S. Patent Office Board of Patent Appeals and Interferences affirmed the rejection, as did the Federal Circuit.

In its opinion, the Federal Circuit indicated that an applicant, having been granted a previously-claimed design, may not proceed to subdivide that previously-claimed design in subsequent continuation applications however the applicant pleases.

Additionally, the Federal Circuit addressed the question of when *could* an unclaimed boundary line (in the form of a broken line) be added to a previously-claimed design, without running afoul of 35 U.S.C. §112, first paragraph, so that the portion bounded by an unclaimed boundary line would be entitled to the benefit of the filing date of the previously-claimed design? Characterized as "the best advice for future applicants," the Federal Circuit answered that an unclaimed boundary line should satisfy the written description requirement only if it makes explicit a boundary that already exists, but was unclaimed, in the previously-claimed design. In doing so, the Federal Circuit frowned on § 1503.02 of the Manual of Patent Examining Procedure ("MPEP"), which provides that unclaimed boundary lines "may" be acceptable when "connecting the ends of existing full lines." For example, if an applicant files a design patent application for a baseball diamond that includes home plate and first, second, and third bases, the Federal Circuit has now signaled that the applicant should *not* be able to file a subsequent continuation application having a newly added unclaimed boundary line connecting the first and third bases, in an attempt to claim only the triangular portion of the diamond that includes the first, second, and third bases. According to the Federal Circuit, such a triangular portion would *not* be entitled to the benefit of the filing date of the previously-claimed baseball diamond. Thus, one can

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infer that the Federal Circuit believes that the MPEP misleads applicants regarding the support for certain design claims.

As always, but especially in light of *In re Owens*, when preparing an initial design patent application, applicants should attempt to identify which portion(s) of the design should be initially claimed, as well as which portion(s) may be subsequently claimed later in the prosecution or in a continuing application. Failure to provide proper support will prevent certain later modifications to a design claim, such as by adding a previously unidentified line to a claimed drawing. Moreover, identification of portion(s) of a design for future claiming helps ensure that the initial application includes enough solid and/or broken lines delineating different portions of the design to provide meaningful patent protection. Such identification eliminates the need to attempt claiming unsupported boundary lines in a continuing design patent application.