Design Practice and Procedure

New Matter—35 USC §112, First Paragraph

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

MEMORANDUM

DATE: April 18, 1995
TO: All Primaries & Examiners on the Temporary
Full Signatory Authority Program, Group 2900
FROM: John Kittle, Director, Group 1100/2900
Director, Group 1100/2900

SUBJECT:
Policy Meeting

Attached find the final draft of our summary of certain policies regarding amendment of design claims, determination of new matter, continuing application procedures and trademark policy.

We will have a meeting Thursday, April 20th at 3:00 pm in the 8th floor conference room to answer any questions and entertain further constructive input.

All previous input has been carefully considered in the formulation of these procedures. Further input accompanied by supporting authority is welcomed.

New Matter—35 USC 112, First Paragraph

The following statutes, rules and case law are the legal basis for permitting amendment of a design claim before final rejection:

35 USC 132 and the subordinate regulations of 37 CFR 1.111, 1.115 and 1.119 as well as 35 USC 171, second paragraph.
Ex parte Hanback, 231 USPQ 739, on page 741, first column, second paragraph from bottom, the Board of Appeals holds:

“As stated in 35 USC 171, second paragraph, ‘[t]he provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.’ It follows that a design patent applicant may amend the claim in his application before final rejection and, is entitled to have the amended claim reconsidered and reexamined.”

An amendment to the claim must have antecedent basis in the original disclosure. The disclosure encompasses the specification, including the claim, and the drawings. An amendment to the claim which has no antecedent basis in the specification and drawings as originally filed introduces new matter, 35 USC 132; 37 CFR 1.118.

I—Amendment to an Original Application
A. Permissible Amendments Filed With Application

1) A preliminary amendment filed simultaneously with the application papers, that is specifically identified in the original oath/declaration as required by 37 CFR 1.63 and MPEP 608.04(b).

EXAMPLE:

Original Disclosure

Amended Disclosure

Preliminary amendment converting solid line depiction of emblem to broken lines.

2) The inclusion of a disclaimer in the original specification or on the drawings/photographs as originally filed.

EXAMPLE:

Original Disclosure

Preliminary amendment indicated on photograph deleting chess pieces.

Amended Disclosure

DELETE

DELETE

The form of the disclaimer is not necessarily limited to the above examples.
B. Permissible Amendments Submitted After Filing Of Application

1) An amendment may broaden/narrow the scope of the claim if it does not involve either a departure from or an addition to the appearance or configuration of the original disclosure.

Example: broadening of claim

Original Disclosure

Amendment converting solid line depiction of rim to broken lines and amending title to correspond.

Amended Disclosure

Example: narrowing of claim

Original Disclosure

Amendment converting broken line depiction of sidewall to solid lines and amending title to correspond.

Amended Disclosure

Insofar as there is antecedent basis in the original disclosure “teaching” the change in scope, the above amendments are considered to be permissible broadening/narrowing of the claim as set forth in In re Rasmussen, 211 USPQ 323. Specifically, the Court held that “[b]roadening a claim does not add new matter to the disclosure. Disclosure is that which is taught, not that which is claimed. An applicant is entitled to claim as broad as the prior art and his disclosure will allow.”

While these amendments have changed the scope of the original claim, they do not exceed “what is shown in the application drawings”. In re Mann, 8 USPQ2d 2030. These changes in scope do not change the appearance or configuration of the original disclosure or of the amended claim.
C. Impermissible Amendments Which Introduce New Matter

1) An amendment to the claim without antecedent basis which would change the appearance or configuration of the original disclosure by the deletion or reduction to broken lines of a portion thereof.

**EXAMPLE:**

<table>
<thead>
<tr>
<th>Original Disclosure</th>
<th>Amended Disclosure</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Amendment removing surface indica/pattern.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Original Disclosure</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image1" alt="Original Disclosure" /></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Amended Disclosure</th>
</tr>
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<tbody>
<tr>
<td><img src="image2" alt="Amended Disclosure" /></td>
</tr>
</tbody>
</table>

| Amendment deleting solid line depiction of emblem/or reducing it to broken lines. |
| ![Amendment deleting solid line depiction of emblem/or reducing it to broken lines.](image3) |

These amendments change the appearance of the original disclosure and “create newness by the difference achieved”. Ballew v Watson, 129 USPQ 48; Ex parte Grasselli, 231 USPQ 393; In re Mann, supra.

An amendment reducing a portion of the claimed design to broken lines is tantamount to deleting the portion entirely.
2) An amendment to the claim without antecedent basis which would change the appearance or configuration of the original disclosure by the addition of previously undisclosed subject matter.

EXAMPLE:

Amendment adding surface treatment to claimed design, e.g.—color, etc.

EXAMPLE:

Amendment adding broken line depiction of emblem to claim.

EXAMPLE:

Amendment adding broken line depiction of mat to disclosure.
The addition of previously undisclosed subject matter is prohibited. In re Berkman, 209 USPQ 45.

The above amendments introduce new matter since there is no antecedent basis in the original disclosure teaching the change in the appearance of the claimed design. This is considered a “departure from or an addition to the original disclosure” [37 CFR 1.118(a)].

D. An amendment to the drawing in a design application removing or reducing to broken lines a word describing a type of surface in general terms, i.e., “adhesive”, is permissible. Similarly an amendment to the drawing in a design application removing or reducing to broken lines a generic term such as “indicia” indicating that a surface can be ornamented, is also permitted. In both of the examples set forth above, it is evident that applicant’s claim is not limited to any particular type of “adhesive” surface or surface “indicia”, respectively. Ex parte Requa, 1892 C.D. 148.

THE “D” TYPES OF AMENDMENTS MUST BE REVIEWED BY YOUR SPE

II—Continuity Practice Under 35 U.S.C. 120

A. Types Of Continuing Applications

1) 37 CFR 1.53—Continuations, divisions and continuations-in-part may be filed as separate applications claiming priority based on an earlier filed application.

2) 37 CFR 1.60—Continuations and divisions only may be filed utilizing copies of the earlier application.

3) 37 CFR 1.62—Continuations, divisions and continuations-in-part may be filed which incorporate the previous application in the file wrapper.


In all continuation and divisional applications, examiners must make a determination as to whether the conditions for priority have been met. That is the disclosure of the claimed design in a continuation and divisional application must be the same as that of the original application. Note MPEP 201.07 and 201.06, Racing Strollers Inc. v TRI Industries Inc., 11 USPQ2d 1300. In a divisional application, “there may be no departure therefrom in substance or variation in the disclosure that would amount to ‘new matter’ if introduced by amendment into the parent case”. Note MPEP 201.06.

If these conditions are not met, examiners must deny the benefit of the earlier filing date and specify the reasons therefor by use of form paragraphs 2.09 and 2.10.

In continuation-in-part applications only, there is no need for the examiner to make a determination as to whether the requirements of 35 U.S.C. 120 are met unless the filing date of the earlier application is actually needed, for example, in the case of an interference or to avoid an intervening reference. Note MPEP 201.08 and In re Corba, 212 USPQ 825. However, examiners are reminded that a C-I-P may never be used to complete a fatally defective disclosure in the earlier application. Note MPEP 201.11 and Hunt Co. v Mallinckrodt Chemical Works, 83 USPQ 277.

An application filed as a C-I-P which only involves either a departure from or an addition to the appearance or configuration of the disclosure of the earlier application does not satisfy the requirements of 35 U.S.C. 120 as set forth in the decision of In re Salmon et al., 217 USPQ 981.
An application filed as a C-I-P repeating the design claimed in the earlier application and adding embodiments not disclosed in said earlier application would satisfy the requirements of 35 U.S.C. 120.

EXAMPLE:

Examiners are reminded that reference to the parent application in the specification must either immediately precede or follow the figure descriptions. Note MPEP 1504.20.